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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1883. 4

No. ~~1282.~~ 838

BENJAMIN BUTTERWORTH, COMMISSIONER OF PATENTS, PLAINTIFF IN ERROR,

vs.

THE UNITED STATES, EX REL. RICHARD H. HOE, ROBERT HOE, PETER S. HOE, STEPHEN D. TUCKER, ROBERT HOE, JR., THEODORE H. MEAD, AND STEPHEN S. HOE, TRADING AS R. HOE & CO., AND GEORGE C. GILL.

IN ERROR TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

FILED APRIL 23, 1884.

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INDEX.

	Original.	Print.
Petition for mandamus	1	1
Rule to show cause	12	5
Return to rule	13	5
Exhibit A. (Decision of Commissioner of Patents in case of Gill *vs.* Scott)	20	7
B. (Appeal of Walter Scott to Secretary of Interior, June 12, 1883)	37	13
C. (Rules governing appeals to Secretary of Interior in patent cases)	40	14
D. (Decision of Secretary of Interior reversing decision of Commissioner of Patents in Gill *vs.* Scott)	43	15
E. (Letter of Secretary of Interior to Commissioner of Patents, February 26, 1884)	47	17
Proceedings in general term	49	17
Order for mandamus	49	17
Writ of mandamus	50	18
Writ of error and citation	58	20
Clerk's certificate	59	21

1 *Petition for mandamus.—Filed March 17th, 1884.*

In the supreme court of the District of Columbia.

THE UNITED STATES OF AMERICA EX REL. Richard M. Hoe, Robert Hoe, Peter S. Hoe, Stephen D. Tucker, Robert Hoe, jr., Theodore H. Mead, and Stephen S. Hoe, trading under the firm-name of R. Hoe & Co., and George C. Gill.	At law. No. 25184.
vs.	
BENJAMIN BUTTERWORTH, COMMISSIONER OF Patents.	

To the honorable judges of the supreme court of said District:

Your relators, Richard M. Hoe, Robert Hoe, Peter S. Hoe, Stephen D. Tucker, Robert Hoe, jr., Theodore H. Mead, and Stephen S. Hoe, citizens of the State of New York, residing and doing business in the city of New York, in said State, under the name and style of R. Hoe & Co., and George C. Gill, a citizen of the United States, and a resident of the city of Brooklyn, in said State, respectfully show to your honors:

2 That on or about the 12th day of March, 1881, your relator, George C. Gill, made application in due form of law to the Commissioner of Patents for letters patent for certain new and useful improvements in printing machines, numbered 28100, of which your relator, George C. Gill, believes himself to be the original and first inventor; that said application was made in writing, and therewith said relator, George C. Gill, did file in the Patent Office a written description of the same, and the manner of making, constructing, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most clearly connected, to make, construct, and use the same, and did explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from all other inventions, and did particularly point out and distinctly claim the part, improvement, and combination which he claims as his invention; that said specification and

3 claims were duly signed by said relator, George C. Gill, as such inventor, and were duly attested by two witnesses.

That your relator, George C. Gill, did further furnish drawings of said invention, signed by the attorneys of relator, George C. Gill, and attested by two witnesses.

That your relator, George C. Gill, did further make oath that he verily believed himself to be the original and first inventor and discoverer of the same, for which he solicited a patent; that he did not know and did not believe that the same was ever before known or used, and did state the country whereof he was a citizen.

That your relator, George C. Gill, did further, at the time of making such application, pay to the said Commissioner of Patents the fees required therefor by law.

That upon the filing of such application and the payment of the fees required by law, the said Commissioner of Patents did cause an examination to be made of the alleged new invention set forth, contained, and described in said application, description, and drawings; that on said exam-

4 ination it was the opinion of the Commissioner of Patents that said application would interfere with an unexpired patent, namely, the patent No. 238720, granted to Walter Scott, March 8th, 1881, and thereupon said Commissioner did give notice thereof to your relator, George C. Gill, the applicant aforesaid, and did direct the primary examiner to proceed to determine the question of priority of invention; that thereupon such proceedings were had that a declaration of interference was duly made of and in respect to the claims of the said relator, George C. Gill, and the said Walter Scott, and the said relator, George C. Gill, and Walter Scott aforesaid did proceed to make their respective statements, in accordance with the rules and regulations of the Patent Office, and did present and submit in due form their testimony and proofs in support of their respective claims; and thereupon the examiner of interferences did decide that Walter Scott was the original and first inventor of said improvements in printing machines, and entitled to letters patent therefor, and

5 thereupon the said George C. Gill did appeal from the decision of the said examiner of interferences to the examiners-in-chief, and that said question of interference was heard and decided by the said examiners-in-chief, who held and decided that the said Walter Scott was the original and first inventor thereof, and entitled to said patent.

That thereupon the said George C. Gill did appeal to the Commissioner of Patents from the decision of the said examiners-in-chief, and the said Commissioner did hear and determine such appeal, and did decide that the said George C. Gill was the original and first inventor of said improvements, and was entitled to receive a patent for the same.

That thereupon the said Commissioner did complete the examination of said claim of your relator, George C. Gill, and that upon said examination it did appear to the said Commissioner of Patents that your relator, George C. Gill, is justly entitled to a patent under the law, and that the same is sufficiently useful and important, and the said Commissioner did, on the 4th day of June, 1883, finally decide and adjudge that

6 said patent should issue in manner and form as follows:

That is to say, that the said Commissioner did decide and adjudge that your relator, George C. Gill, was the original and first inventor of said improvements in printing machines No. 28100, and was entitled to receive a patent therefor, covering the following claims, viz:

1st. The combination, with the reciprocating bed, pistons, and cylinder, of air passages communicating with said cylinders at a point beyond that to which the piston enters, which passages are governed by a cock or cocks, that are controlled by the belt-shifting mechanism of the machine, substantially as described.

2d. The combination, with the bed, pistons, cylinders, cocks, rod and rock-arm, of means connecting said rock-arm with the lever of the belt-shifter, all substantially as described.

That your relator, George C. Gill, did, by an instrument in writing, for a good and valuable consideration, convey, sell, and set over unto the

7 other relators, under their firm name of R. Hoe & Co., all his right, title, and interest in and to said invention and improvements, and did reques tthe Commissioner of Patents to issue the letters patent therefor wheh granted to your relators, under their firm name of R. Hoe & Co., which assignment was duly recorded in the Patent Office of the United States.

That thereupon it became the duty of the said Commissioner of Patents

upon the payment of the final fee to him of $20, which your relators have tendered to him, but which he has refused to accept, to prepare or cause to be prepared letters patent of the United States, in accordance with the said rights and claims of your relators as aforesaid, and to present the same for signature to the Secretary of the Interior, and to countersign the same; nevertheless, the said Commissioner has wrongfully failed and neglected so to do.

That your relators are informed and believe, deriving their information from a communication made to them by the Commissioner of Patents, in answer to an inquiry put by them to the Commissioner, that the only
8 ground on which the Commissioner refuses to issue the patent has heretofore been the pendency of an appeal before the Secretary of the Interior, said appeal being taken by the said Walter Scott from the said decision of the Commissioner of Patents in favor of your relator, the said George C. Gill, and that the said Commissioner has not denied and does not deny that the said patent is entitled to issue to the said George C. Gill, unless the Secretary of the Interior has the right to suspend the issuing thereof by reason of the appeal pending before him. The relators are further informed from the source aforesaid that said appeal to the Secretary of the Interior has been recently decided, it being held thereby that Walter Scott was the original and first inventor of the said improvements, and entitled to a patent therefor.

Your relators pray that the communication from the Commissioner of Patents hereto annexed, marked A, may be taken as a part of their petition.

They allege, as they are advised and believe, that the Secretary of
9 the Interior has no authority to entertain appeals from the Commissioner of Patents upon questions involving the right of inventors to a property in their inventions, and that he has no right under the law to hear or decide said appeal, and that his decision thereon was ultra vires. That by reason of the premises and of the great delay the relators have sustained damage and injury.

Your relators therefor pray that a writ of peremptory mandamus may issue from and under the seal of this honorable court directed to Benjamin Butterworth, Commissioner of Patents, and commanding him that he receive the final fee of $20, and cause letters patent of the United States to your relators, assignees of record as aforesaid, in manner and form as aforesaid, to be prepared and sealed according to law, and presented to the Hon. H. M. Teller, Secretary of the Interior, for the signature thereto of the said Secretary of the Interior, and that he should be required to appear before this honorable court on a day named by your honors, to show
10 cause why the said writ should not issue.

RICHARD M. HOE,
ROBERT HOE,
PETER S. HOE,
STEPHEN D. TUCKER,
ROBERT HOE, JR.,
THEODORE H. MEAD, and
STEPHEN S. HOE,
Company, the firm of R. Hoe & Co.,

And— GEORGE C. GILL,

By MUNSON & PHILIPP,
Their Attorneys.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, March 11th, 1884.

Hon. A. J. WILLARD,
Of counsel for George C. Gill, Washington, D. C.:

SIR: I have your communication of this date making inquiry touching the status of the case of Gill vs. Scott.

In reply I have to say that since your former demand upon me to issue a patent to your client in pursuance of the adjudication had before the Commissioner, and my reply thereto, the honorable Secretary has
11 decided said case, reversing the decision of the Commissioner of Patents and adjudging priority of invention to Scott, and remanded the case for issue of a patent in accordance with said decision.

If the decision of the Commissioner adjud'ing priority to your client is final and not subject to review and reversal by the honorable Secretary of the Interior, then your client is entitled, on payment of final fee, to have his patent prepared and issued. But if the honorable Secretary has, under the law, jurisdiction on appeal to hear and determine the cause, then your client is not so entitled.

The decision of the Commissioner of Patents is that your client, Gill, is entitled to a patent as prayed for. On appeal from that decision the honorable Secretary decided that your client is not so entitled.

In view of the facts recited, I refuse to issue a patent to your client, or to prepare a patent for issue, or to take any steps whatever in that direction. I do this not because I want further to consider or examine
12 the case, but because the honorable Secretary has, on hearing the cause, reversed the decision of the Commissioner of Patents, as hereinbefore stated.

Very respectfully,

BENJ. BUTTERWORTH,
Commissioner.

DISTRICT OF COLUMBIA, *ss:*

M. B. Philipp, being duly sworn, deposes and says that he is one of the attorneys of the above-named relators, and that the facts as stated in the above petition are true.

M. B. PHILIPP.

Subscribed and sworn to before me this 15th day of March, 1884.
[NOTARIAL SEAL.] PHILIP MAURO,
Notary Public, D. C.

Proceedings before the supreme court of the District of Columbia in general term, commencing on the 4th Monday, it being the 28th day of January, A. D. 1884.

Present: Chief Justice Cartter and Justices MacArthur and James.

MONDAY, *March 17th, A. D.* 1884.

13 Session resumed pursuant to adjournment; present, Chief-Justice Cartter and Justices Cox and James.

THE UNITED STATES OF AMERICA, EX REL. Richard M. Hoe, Robert Hoe, Peter S. Hoe, Stephen D. Tucker, Robert Hoe, jr., Theodore H. Mead, and Stephen S. Hoe, trading under the firm-name of R. Hoe & Co., and George C. Gill
vs.
BENJAMIN BUTTERWORTH, COMMISSIONER OF Patents.
At law. No. 25184.

Upon reading the petition for the writ of mandamus in the above-entitled case, and upon considering the same, it is this 17th day of March, A. D. 1884, ordered that the respondent appear before this court, sitting in general term, on the 24th day of March, A. D. 1884, at 10 o'clock a. m., to show cause why the said writ of mandamus should not issue as prayed by the said relators, and that a copy of this order be served upon the said respondent.

Return of the Commissioner.—Filed March 27th, 1884.

14 Supreme court of the District of Columbia, general term.

U. S., EX REL. HOE & CO.,
vs.
BENJAMIN BUTTERWORTH, COMMISSIONER OF Patents.
At law. No. 25184.

And now comes Benjamin Butterworth, Commissioner of Patents, the respondent in the above-entitled cause, and answering the allegations and complaint of the relator, says:

That it is true, as stated in the petition, that the said George C. Gill did file an application for letters patent, and that the proceedings had and the several steps set forth in said petition were taken to secure the same; he further admits that it is true that the Commissioner of Patents did decide and adjudge that the said George C. Gill was entitled to receive a patent, as set forth by the relator herein, as appears by a copy of said decision hereto annexed, marked A; and that said decision has not been reversed or modified by the Commissioner of Patents.

15 Your respondent further says that upon the rendition of said decision, awarding priority of invention to George C. Gill, and adjudging that he was entitled to have issued to him a patent for the invention in his said application mentioned and described, an appeal was taken (a copy of which is hereto attached and made part hereof, marked B) on, to wit, the 14th day of June, 1883, from said decision to the honorable the Secretary of the Interior, by Walter Scott, who was a party to the interference proceedings mentioned and described in the relator's petition, said appeal being prosecuted under rules prescribed by the honorable the

Secretary of the Interior, dated May 17th, 1883 (a copy of which is hereto attached and made part hereof, marked C). That thereupon said cause was heard in pursuance of said appeal, and in the decision of the Commissioner of Patents was on, to wit, the 7th day of March, 1884, reversed, and the said Walter Scott, as is indicated in the said decision, adjudged to be the first inventor, and that said George C. Gill was not entitled to have issued to him a patent. (A copy of said decision is hereto attached
16 and made part hereof, for reference, and is marked D.)

Your respondent further says that it is true, as alleged by the relator, that pending the hearing of said cause on appeal, to wit, on the 4th day of March, 1884, the relator did demand of your respondent that he prepare a patent for issue to the said George C. Gill, in pursuance to the decision of the Commissioner of Patents, made as hereinbefore set forth, and that your respondent did refuse to prepare said patent, or to take any steps in that behalf.

Your respondent further says that it is true, as alleged by the relator, that subsequently to said demand and refusal the decision reversing that of the Commissioner of Patents was rendered as hereinbefore set forth, and that thereafter the said relator again demanded that your respondent prepare for issue a patent in accordance with the judgment of the Commissioner, tendering at the same time the final fee due; that your respondent refused to accept said fee, and also refused to prepare said pat-
17 ent, or to do anything, or to take any steps in that direction; that he so refused, not because he desired to make further inquiry, or to be further advised in that behalf, no motion or other proceeding for rehearing or review had been taken, or was pending before him in that behalf; but that he based his refusal, and does so still, solely upon the ground that the honorable the Secretary of the Interior had entertained the appeal taken to him from said decision, under the rules aforesaid, and had in pursuance of said appeal entered a decision reversing that of the Commissioner of Patents, and awarded priority of invention to Walter Scott.

Your respondent further says that for many years, and until 1881, it was held, in pursuance of decisions and opinions of the honorable Attorney-General made in that behalf, that the honorable the Secretary of the Interior had, and therefore has, no legal authority to review on appeal a decision of the Commissioner of Patents, wherein the Commissioner has finally adjudged an applicant to be entitled to a patent as prayed
18 for in his application; in other words, that the judgment of the Commissioner of Patents upon the right of an applicant to have and receive a patent is final and conclusive, subject only to review by the supreme court of the District of Columbia, and such other courts as have jurisdiction in that behalf, and by the Commissioner; and the practice of the Patent Office and the honorable the Secretary of the Interior conformed thereto. This question, however, was again raised in the cases of Nicholson v. Edison, and Le Roy v. Hopkins, and the honorable the Attorney-General of the United States, to whom the question was again referred, in an opinion signed on the 20th day of August, 1881, held that the honorable the Secretary of the Interior had and could, on appeal to him, exercise the jurisdiction to review the decision of the Commissioner of Patents, and control his action in that behalf; and later on, to wit, the 26th day

of February, 1884, the honorable Secretary, in an official letter (a copy of which is hereto attached, marked E), advised your respondent that he, the honorable Secretary, had, in pursuance of the opinion of the hon-
19 orable Attorney , exercised jurisdiction on appeal from the judicial action of the Commissoner in determiining questions devolved upon him by the statute.

In deference to that opinion and the action of the honorable the Secretary of the Interior in the case under consideration your respondent refused, and does refuse, to accede to the demand of the relator. That in view of the decisions and the uniform practice of the Commissioners of Patents and the heads of the Department of the Interior prior to 1881, doubt and uncertainty have arisen touching the legal obligations devolving upon your respondent in the case under consideration, and those of like character.

Your respondent further says that if the judgment of the Commissioner of Patents, which is, that the relator is entitled to receive his patent as prayed for, sis final, and if upon such judgment it is the lawful duty of the respondent to accept said final fee and take the necessary and proper steps to prepare said patent for issue, as prayed, then your respondent has improperly refused, and does improperly refuse, to prepare said patent for
20 issue; but if his decision is subject to review and reversal on appeal to the honorable the Secretary of the Interior, then such refusal on the part of your respondent to accept said fee and prepare said patent for issue is right and proper.

And having fully answered he prays judgment.

BENJ. BUTTERWORTH,
Commissioner of Patents.

EXHIBIT A.

U. S. PATENT OFFICE.

GILL
vs.
SCOTT.

Printing machine.

Appeal from the examiners-in-chief.

Application of George C. Gill, filed March 12th, 1881.
Patent No. 238720 granted to Walter Scott, March 8th, 1881.
Messers Munson & Philipp for Gill.
Mr. L. W. Serrell for Scott.

The matter in controversy in this case has been defined as follows, viz:

21 "1. The combination with the reciprocating bed, pistons, and cylinders, of air-passages communicating with said cylinders at a point beyond that to which the piston enters, which passages are governed by a cock or cocks that are controlled by the belt-shifting mechanism of the machine, substantially as described.

"2. The combination withe the bed, pistons, cylinders, cocks, rod, and rock-arm with the lever of the belt-shifter, all substantially as described."

The evidence submitted in the case shows that Scott conceived of the invention in controversy in January, 1874, and soon thereafter made a

drawing illustrating the same. This drawing was shown to several persons and explanations given of the way and manner in which the devices thereon shown would work.

Scott applied for a patent for his invention January 7th, 1881, which was granted March 8th following. From the time he made the drawing illustrating the invention until his application for patent was filed nothing
22 seems to have been done by him to bring his invention to the notice of the public, except that he applied to the superintendent of the job department of the Inter Ocean Printing Company's printing establishment in Chicago, where he was employed, to have the same attached to one of the presses therein, and also made like application to the manager of the same. Receiving no encouragement from either he thereafter made no efforts to reduce his invention to practice. The reason he gives for finally applying for a patent is that he heard C. Potter, sr., & Co., his employers, and others were about to build presses with air-cushioning chambers and he thought it advisable to protect his invention by patent. Since the patent was granted the invention has not been used by him.

Gill conceived of the invention in January, 1880, and in July following had the same in practical use. Subsequently, the latter-mentioned date and prior to December 31st of that year, the invention was put upon a number of presses—fifteen or more.

23 The facts above stated are undisputed, and the question, therefore, arises which of the parties is entitled to be considered the prior inventor of the matter in controversy.

In the case of Aganam Company v. Jordan (7 Wall., 583), Mr. Justice Clifford said:

"The settled rule of law is that whoever first perfects a machine is entitled to the patent, and is the real inventor, although others may have previously had the idea and made some experiments towards putting it in practice. He is the inventor and is entitled to the patent who first brought the machine to perfection and made it capable of useful operation."

In Kendall et al. v. Winsor (21 How., 322), Mr. Justice Daniel, in delivering the opinion of the court, said:

"It is the unquestionable right of every inventor to confer gratuitously the benefits of his ingenuity upon the public, and this he may do either by express declaration or by conduct equally significant with lan-
24 guage, such, for instance, as an acquiescence with full knowledge in the use of his invention by others, or he may forfeit his rights as an inventor by a wilful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced by others. Whilst the remuneration of genius and useful ingenuity is a duty incumbent upon the public the rights and welfare of the community must be fairly dealt with and effectually guarded. Considerations of individual emolument can never be permitted to operate to the injury of these."

In the case of the Consolidated Fruit Jar Company v. Wright (12 Blatch., 149), Judge Woodruff said:

"If an inventor, without substantial reason or excuse, abandons the use of his invention, and for nine years sleeps on his rights, and in the mean time others, in good faith, employ their industry, skill, and money

in producing the same thing, and give the public the benefit thereof,
25 putting it into extensive use and on sale, such a state of facts not only warrants the inference of abandonment by the first inventor, but it also creates, as between him and the others, the same equity as would arise if such others had gone further and taken out a patent. Whether the device be patented or has gone into use without a patent should make no difference."

Mr. Commissioner Paine, in the case of Farmer v. Brush (C. D., 1880, p. 5), said:

"The inventor may involuntarily keep his invention secret as long as he sees fit to do so, provided he applies for a patent before another invents the device. He may abandon or forget his invention provided he resumes or recalls it before another makes the invention. But his rights do not in either case relate back through the intermediate "vacu'm" to the original invention, so as to give him the benefit of its date as against a rival inventor."

In the case of Reed v. Cutter et al. (1 Story, 590), Judge Story says:

"In a race of diligence between two independent inventors, he
26 who first reduces his invention to a fixed, positive, and practical form seem' to be entitled to a priority of right to a patent therefor. The clause of the fifteenth section now under consideration seems to qualify that right by providing that in such cases he who invents first shall have the prior right, if he is using reasonable diligence in adopting and perfecting the same, although the second inventor has, in fact, first perfected the same, and reduced the same to practice in a positive form. It thus gives full effect to the well-known maxim that he has the better right who is prior in point of time, namely, in making the discovery or invention."

The rule indicated by Judge Story that the first inventor should receive a patent provided he was using reasonable diligence in adapting and perfecting the same, although the second inventor might first perfect it, has been accepted and adopted, so far as I have been able to learn.

The question, therefore, arises in this case, has Scott used reasonable diligence in perfecting and adapting his invention, and bringing it into
27 use. His own testimony on this point seems to furnish the most satisfactory answer. It is as follows:

"C. Q. 31. You have stated that since you made this invention you have applied for more than twenty patents. Could you not have applied for this earlier?

"A. I have a great many inventions not yet applied for, and I apply for those first which I think most valuable.

"C. Q. 32. Were not many of the inventions shown and described in those twenty or more applications of which you have spoken made subsequent to this one?

"A. Yes, sir.

"C. Q. 33. How many of them?

"A. I couldn't tell without considerable study and search.

"C. Q. 34. Were not a' least three quarters of them so made?

"A. No; not even half of them.

"C. Q. 35. Will you state positively that half of them were not subsequent to this?

"A. I could not state positively how many of them; but it is my opinion that more than half of them were made previous to that time.

"C. Q. 36. Among those twenty or more applications is there no
28 one showing an invention which you regard of less importance than this?

"A. Those inventions in connection with web printing machinery are applied for when the parties assisting me financially, at their discretion, desire me to do so; yet I do not think that any application made is of less value than the one in question.

"C. Q. 37. Am I to understand you, then, as saying that all of these previous applications have been made at the suggestion of the parties assisting you?

"A. All those applications in connection with the web printing-press business have been applied for with the knowledge and consent of those parties assisting me.

"C. Q. 38. This one you have stated is made upon your own account, have you not?

"A. Yes, sir.

"C. Q. 39. From what you stated, Mr. Scott, I infer that you regard this invention as of comparitively little value.

"A. I think it of less value than some of the others of my invention. The value of a patent cannot be well ascertained until it is worked."

* * * * * * *

29 "C. Q. 42. Have you ever practically applied this invention since taking out letters patent?

"A. I have not."

* * * * * * *

"C. Q. 49. What led you, Mr. Scott, to make application, at the time you did, for the patent which is involved in this interference?"

"A. Because the firm of C. Potter, Jr., & Co., commenced to apply air-cushioning chambers to their printing machinery. And as several persons connected with the company and employed by them had a knowledge of my invention in connection with such devices, I thought it prudent to make applications for these inventions before they might take the opportunity to put them into practice."

Being further interrogated upon this subject, in answer to cross-question 55, he says:

"A. Other makers of printing presses had or were about to adopt the air-cushioning system; and I thought it would be as good a time as any to make the application, because it would thereby be of more value.

Whether I would have made the application if C. Potter, Jr., &
30 Co., did not anticipate adopting *this air-cushioning system* it is impossible for me to say. In determining the matter for myself I took in the whole situation.

"C. Q. 56. What other makers of printing-presses do you refer to, Mr. Scott, as having applied, or being about to apply, the air-cushioning system?

"A. Nearly all of the drum-cylinder press manufacturers, including Cotrell & Babcock, Taylor Printing Press Company, Campbell Printing Press Company, R. Hoe & Co., S. P. Rounds (or what was formerly known as Chicago Taylor Press Company.)"

In relation to his efforts to have the invention put into use he states as follows:

"C. Q. 20. Why, Mr. Scott, did you not apply this invention to the Taylor press in question at the time you devised it and made these drawings?

"A. Because the superintendent of the job department thought he could do without it.

"C. Q. 21. Who was this superintendent?

"A. Mr. Foote.

"C. Q. 22. Did you explain the invention to him, and make any
31 special effort to have him adopt it?

"A. I tried to explain it to him and to show that it might be a saving in the end, but he didn't know much about machinery, and didn't want to bother with it."

* * * * * * *

"C. Q. 24. Did you explain the invention to any one else with a view to having it applied and tested?

"A. Yes; I tried to get permission from Mr. Ingham, the general manager of the establishment. He did not want to incur any expense in the job department, as they could not make it pay, and wished to dispose of it.

"C. Q. 25. Did you make any further efforts to have it tested; and, if so, what were they?

"A. I made no special effort, as I had been refused assistance in other and more valuable inventions which I had at that time.

"C. Q. 26. Why did you not apply it to one of the presses under your charge, at your own expense, if you had any confidence in its utility?

"A. I had every confidence in its utility, but had no money to
32 spend on other and more valuable inventions than this, and consequently did not apply the device.

"C. Q. 27. What would have been the probable costs of applying this device to a Taylor press in the manner illustrated in Exhibit A?

"A. About seventy-five dollars."

In relation to his income he says:

"C. Q. 61. What was your income from your salary and other sources in January, 1881?

"A. Probably I received about forty dollars a week at that time; I had not received my full salary or an income from any other source.

"C. Q. 62. For how long previous to this time had you been receiving forty dollars a week?

"A. About three years.

"C. Q. 63. Were your necessary expenses in January, 1881, any less than they had been during the previous year?

"A. I don't know that they were.

"C. Q. 64. Were they any less during the year preceding January, 1881, than during the year before?

"A. No; I had always enough of applications for patents to make, and interferences pending, which took all I could spare."

From the testimony thus cited, it appears that Mr. Scott did not
33 consider the invention in question of great value, and hence gave his time and means to other inventions; that his incentive in applying for a patent was simply because he learned that his employers and others

were about to build presses containing air-cushioning chambers; that his efforts to have his invention adopted by his employers were not strenuous, and that he received sufficient compensation for his services not only to have applied for a patent for the invention at an earlier date, but also to have had it put into actual use, if he had so desired.

Instead of doing this he seems to have considered it more to his advantage to file applications for other inventions, and to litigate the controversies into which he was thrown.

On the other hand, Mr. Gill, soon after he conceived of the invention put it in practical use, and before Scott applied for a patent had it in use, in different parts of the country.

While it may be true that Scott is an original inventor and has the right for the purpose of establishing the date of his invention to
34 refer to his drawings as held by the court in the case of Reeves v. Keystone Bridge Company et al. (1 O. G., 466), and in Webster Loom Company v. Higgins (21 O. G., 2031), it is still a question whether by his negligence in not reducing his invention to practice he can be considered the prior inventor.

This is not a race between two equally diligent inventors; but a case where one of the parties has shown great diligence in reducing his invention to practice, and bringing it to the attention of the public, while the other did nothing but make a drawing illustrating the invention until his competitor had the invention in general use, then he applied and obtained patent therefor.

The law gives to inventors in consideration of something valuable being conferred upon the public, the exclusive right for a definite term to make, use, and sell their inventions, but where they with'old their inventions and confer no benefits there is no reason why protection should be afforded them if other more diligent inventors produce the same thing and do confer such benefits.

Gill was the first to introduce the invention here in controversy
35 to the public, and although Scott says he had no knowledge that such invention was in use before he filed his application for a patent, I am at loss to understand how he could be in ignorance of such fact when so many others seem to have had knowledge of it, and manufacturers were about building presses with the air-cushion chambers. That his employers had knowledge of this particular invention appears by his answer to cross-question 55 above quoted. It is not shown how they obtained that kn*kn*owledge, but it can hardly be supposed they obtained it from Scott, because it does not appear that he had any conversation with any officer of said company other than as above mentioned, and those conversations, according to his statement, must have occurred long prior to the time his employers were about to adopt this system; they, as well as others, had full opportunity to learn of the utility of this invention from the presses which had been sent forth containing it by Hoe & Co., the employers of Gill.

If, as held by the courts in the cases above mentioned, he is the first
36 inventor, and entitled to a patent who first reduces the invention to practice, embodying it in practical form, as against one, although prior in time in making it, by negligence allows it to remain unknown, Gill must be awarded priority of the invention in controversy. There is no doubt of

the production of the invention by Gill, nor in Scott's negligence in properly making known his invention for seven years, and until after Gill had the same in successful and general use; and if, as held by my predecessor, a person, who has been negligent, cannot go back and claim an invention made by him prior to the time his competitor made it and put it in public use, Scott cannot in this case be considered the prior inventor as against Gill. Undoubtedly the filing of the application of Scott was evidence that he had the invention at that time, and that he desired to secure protection thereof; but if the courts will not protect him in his right thereto, although he has a patent, on account of his negligence, and will treat his claim as forfeited, because another and more diligent inventor has made the same invention and given it to the public, there is no reason
37 why Gill should not have a patent for that to which he is justly entitled.

The rule is well established that an applicant cannot have a patent for that which has been patented to another unless he shall make out such a case as would defeat that patent; but in the view I take of the testimony in this case, under the decisions cited, such a case has been here made out, and on the facts presented the court would declare void the patent issued to Scott.

Gill, therefore, being the inventor, who, under the law, is recognized as the prior inventor of the matter in controversy, is entitled to receive a patent for his invention.

The decision of the examiner-in-chief is therefore overruled.

June 4, 1883.

E. M. MARBLE,
Commissioner.

Ex'd M. McK.—J. A. W.

EXHIBIT B.

NEW YORK, *June 12th*, 1883.

To the Hon. SECRETARY OF THE INTERIOR:

SIR: In the matter of interference of George C. Gill vs. Walter
38 Scott, improvements in printing presses, the present is to petition that the matter may be heard on appeal by your honor in person.

The following are assigned as reasons for such appeal:

That the Commissioner of Patents erred in deciding in favor of Gill, when the two decisions of the lower tribunals had been in favor of Scott, and no new facts are assigned or errors mentioned by him on which to reverse such prior action as required by the previous rulings of the Patent Office.

The Commissioner erred in overlooking the fact that Gill does not apply for a patent on his original invention, but adopts the device of Scott in making his application.

The device upon which Gill applies for a patent was not made by him until Dec. 22ond, 1880, and Scott's application was filed within seventeen days, viz, Jan. 8th, 1881.

The burden of proof rests on Gill to present reasons sufficient to overcome the patent of Scott, Scott's patent having been granted March 8th, 1881, four days before Gill makes his application.

39 The law requires the Commissioner of Patents to determine the question of priority of invention, and gives no authority to grant a second patent except to a prior inventor.

The Commissioner finds that Scott was the first inventor and made his invention in 1874, and that Gill did not make the invention until January 8th, 1880, and to decide under this state of facts that Gill should have a patent is contrary to law.

Mere delay in applying for a patent or in introducing an invention is not a ground on which an invention that has been reduced to a tangible form and explained fully to others can be forfeited.

A drawing is as available in laying a claim to priority of invention as a machine, if the drawing is sufficiently plain to enable those skilled in the art to understand it (see decision of U. S. Supreme Court, O. G, v. 21, p. 2035), and the Commissioner erred in not accepting the original drawing of Scott, made in 1874, and fully explained to others as establishing his claim to priority of invention.

40 There is nothing in the present invention requiring actual test to demonstrate its availability. The utility and efficiency is apparent on mere suggestion and the Commissioner erred in giving any weight to the evidence of use on the part of Gill for the purpose of endeavoring to outweigh Scott's prior invention and actually-issued patent.

To give Gill a patent would be to issue an illegal and invalid instrument that would never be sustained by the courts.

WALTER SCOTT,
Per LEMUEL W. SERRELL,
Att'y.

EXHIBIT C.

DEPARTMENT OF THE INTERIOR,
Washington, D. C., May 17, 1883.

Rules governing appeals to the Secretary of the Interior in patent cases:

1. Appeals from the action of the Commissioner of Patents in uncontested cases where the construction of the rules of practice is involved, and in contested cases, will not be entertained by the Secretary of
41 the Interior unless the petition therefor be filed with the Commissioner of Patents within ten days after the date of the action to which it relates.

2. Upon receipt of the appeal *of* the Commissioner will make a report to the Secretary embodying the material facts of the case, and the grounds of his action therein, or referring to such of the papers in the case as set forth such facts and action. He will also notify the appellant that his report has been submitted to the Secretary. Upon a proper showing by a party in interest that the report of the Commissioner is deficient as to material facts the Secretary will call upon the Commissioner for a further report.

3. Within twenty days after the receipt of the papers by the Secretary the appellant shall file a printed brief with the Secretary, and in contested cases the written acknowledgment of the appellee that he has been furnished with a *a* copy of the appellant's brief, showing the date it was received.

4. The appellee, or any party opposing the appeal to the Secretary, may, within twenty days after the receipt of appellant's brief, file a printed brief in reply.

42 5. No oral hearing will be allowed until the rule relating to the filing of printed briefs is complied with, and then only on the suggestion of the Secretary that he desires to hear the parties.

6. Where "appeal" is mentioned in these rules it refers to both an appeal in its ordinary sense in a case at law and an application for the exercise of the Secretary's supervisory authority.

H. M. TELLER,
Secretary.

DEPARTMENT OF THE INTERIOR,
Washington, October 26, 1883.

SIR: The rules of the Department governing appeals to the Secretary of the Interior in patent cases are hereby amended by the addition of the following:

7. Appeals from decisions of the Commissioner of Patents upon interlocutory motions or orders will not be considered by the Secretary of the Interior before the final determination of the proceedings in the course of which they are made. Objections to decisions upon such motions or orders may be noted in the record, and will be considered by the

43 Secretary if appeal be taken from such final determination.

You will please cause this rule to be published in the Official Gazette.

Very respectfully,

H. M. TELLER,
Secretary.

The COMMISSIONER OF PATENTS.

DEPARTMENT OF THE INTERIOR,
Washington, November 14, 1883.

Ordered: Oral hearings in cases on appeal to the Secretary from decisions of the bureau officers of this Department, when permitted, will hereafter be limited to one hour for each side of the case.

H. M. TELLER,
Secretary.

The COMMISSIONER OF PATENTS.

EXHIBIT D.

E. M. D. J. K. McC.

DEPARTMENT OF THE INTERIOR,
Washington, March 19th, 1884.

The COMMISSIONER OF PATENTS:

44 SIR: I have considered the appeal of Walter Scott, by his attorney, from the decision of your predecessor in the matter of the interference between the application of George C. Gill and the patent of Scott, for improvement in printing presses.

It appears that Scott conceived the invention in controversy in January, 1874, and about the same time prepared drawings and a description of it, which he exhibited to several persons. His application was filed January 7th, 1881, and a patent issued to him March 8th, 1881. Gill conceived of the invention in January, 1880, and between July and December of that year it was applied to a number of printing presses. He filed his application March 12, 1881, four days after the issue of the patent to Scott.

The examiner of interferences awarded priority to Scott and this action was affirmed by the board of examiners-in-chief, but, upon appeal to the Commissioner he reversed these concurrent decissions and decided that Gill was the first inventor, mainly upon the ground that Scott, by rea-
45 son of his negligence and failure to seasonably apply for a patent, had forfeited his right to priority as against Gill, who had shown greater diligence. It is from this decision the present appeal is taken.

Scott was the first to conceive of the invention. The drawings he made at that time and the accompanying description were so full, clear, and exact as to enable one skilled in the art to construct a machine therefrom.

He was diligent in completing the invention so far as to demonstrate its practical utility, reaching a point where no further invention was required, but only the necessary capital to bring it into actual use. He was not able, out of his own means, to procure a machine to which he could apply his invention, but he endeavored, without success, to obtain the permission of the superintendent and again of the manager of the printing establishment in which he was employed to attach it to their machinery.

During the period between his conception of the invention and the date of his application for a patent he was in receipt of a moderate sal-
46 ary, his only source of income. He had applications for other patents pending and was involved in interferences which he states took all the means he could spare. The evidence does not warrant the presumption of abandonment of the invention by Scott or that he designedly concealed it or withheld it from the public with a view of applying it indefinitely and exclusively to his own use. After it came to his knowledge that others were using the same improvement, he filed his application without unreasonable delay, and a patent was granted to him before any one had appeared to contest his right to it.

The patent issued to Scott must be regarded as prima facie evidence that he is the first original inventor of the subject-matter involved in the interference, and this evidence must have full force and effect unless rebutted by countervailing proof. I do not regard the testimony sufficient to overcome his claim to priority.

The decision of the Commissioner is hereby reversed, and priority of invention awarded to Walter Scott. The papers belonging to your
47 office are herewith returned.

Very respectfully,

H. M. TELLER,
Secretary.

EXHIBIT E.

J. K. McC.

DEPARTMENT OF THE INTERIOR,
Washington, February 26, 1884.

The COMMISSIONER OF PATENTS:

SIR: Referring to your letter of the 13th instant, forwarding the appeal in the case of Straight vs. Brown vs. Reichle vs. Wood, in which you express the opinion that no appeal lies from the Commissioner of Patents to the Secretary of the Interior from any judicial decision of the former, and that the supervising power conferred upon the Secretary by statute relates only to administrative functions, I have to state in reply that at the request of my predecessor, Mr. Kirkwood, in connection with the case of Nicholson vs. Edison and Le Roy vs. Hopkins, the At-
48 torney-General considered the question as to the extent of the supervisory authority of the Secretary over the acts of the Commissioner, and in an opinion dated August 20, 1881, reached the conclusion that the final discretion in all matters relating to the granting of patents is lodged in the Secretary of the Interior. Secretary Kirkwood concurred in this opinion, and from that time to the present appeals from the judicial action of the Commissioner of Patents have been considered by the Secretary of the Interior. The attention of Congress was particularly directed to this new practice in the annual report of the Secretary of the Interior for 1881, and there has not since been any legislative expression of dissent from the interpretation the existing law had received.

With due regard for your opinion in the matter, I do not feel justified in discontinuing a practice established by my predecessor, in conformity with the opinion of the law officer of the Government, and to which Congress, after due notice, has failed to interpose any objection.

49 Very respectfully,

H. M. TELLER, *Secretary.*

Proceedings before the supreme court of the District of Columbia, in general term commencing on the 4th Monday, it being the 28th day of January, A. D. 1884.

Present, Chief-Justice Cartter and Justices MacArthur and James.

MONDAY, *April 14th*, A. D. 1884.

Session resumed pursuant to adjournment. Present, Chief-Justice Cartter and Justices Cox and James.

THE UNITED STATES OF AMERICA, EX REL. Richard M. Hoe & others,
vs.
BENJAMIN BUTTERWORTH, COMMISSIONER OF Patents.
} At law. No. 25184.

Mr. Justice James delivers the opinion of the court, holding that the relators are entitled to a peremptory mandamus, for which there is to be a judgment, which is to be formally submitted to the court.

50 FRIDAY, *April 18th*, 1884.

Session resumed pursuant to adjournment. Present, Chief-Justice Cartter and Justices MacArthur and Cox.

THE UNITED STATES OF AMERICA, UPON THE relation of Richard M. Hoe, Robert Hoe, Peter S. Hoe, Stephen D. Tucker, Robert Hoe, jr., Theodore H. Mead, and Stephen S. Hoe, trading under the firm name of R. Hoe & Co., and Geo. C. Gill,
vs.
BENJAMIN BUTTERWORTH, COMMISSIONER OF Patents.
} At law. No. 25184.

Whereas it appears to us by the relation and complaint of the said Richard M. Hoe, Robert Hoe, Peter S. Hoe, Stephen D. Tucker, Robert Hoe, jr., Theodore H. Mead, Stephen S. Hoe, and Geo. C. Gill—

That on or about the 12th day of March, 1881, the relator, George C. Hill, made application in due form of law to the Commissioner of Patents for letters patent for certain new and useful improvements in printing machines, numbered 28100, of which said relator, George C. Gill,
51 believing himself to be the original and first inventor, the said application was made in writing, and therewith said relator, George C. Gill, did file in the Patent Office, a written description of the same, and the manner of making, constructing, and using it in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, and use the same, and did explain the principal thereof, and the best mode in which he had contemplated applying that principal, so as to distinguish it from all other inventions, and did particularly point out and distinctly claim the part improvement and combination which he claims as his invention; that said specification and claims were duly signed by said relator, George C. Gill, as such inventor, and were duly attested by two witnesses; that said relator, George C. Gill, did further furnish drawings of said invention signed by the attorney of said relator,
52 George C. Gill, and attested by two witnesses; that said relator, George C. Gill, did further make oath that he verily believed himself to be the original and first inventor and discoverer of the same, for which he solicited a patent, that he did not know and did not believe that the same was ever before known or used, and did state the country whereof he was a citizen; that said relator, George C. Gill, did further, at the time of making such application, pay to the said Commissioner of Patents the fees required therefor by law; that upon the filing of such application and the payment of the fees required by law, the said Commissioner of Patents did cause an examination to be made of the alleged new invention set forth, contained, and described in said application, description, and drawings; that on said examination it was the opinion of the Commissioner of Patents that said application would interfere with an unexpired patent, namely, the patent No. 238720,
53 granted to Walter Scott, March 8th, 1881, and thereupon said Commissioner did give notice thereof to said relator, George C. Gill, the

applicant aforesaid, and did direct the primary examiner to proceed to determine the question of priority of invention; that thereupon such proceedings were had, that a declaration of interference was duly made of and in respect to the claims of the said relator, George C. Gill, and the said Walter Scott, and the said relator, George C. Gill, and Walter Scott aforesaid did proceed to make their respective statements in accordance with the rules and regulations of the Patent Office; and did present and submit in due form their testimony and proofs in support of their respective claims, and thereupon the examiner of interferences did decide that Walter Scott was the original and first inventor of said improvements in printing machines, and entitled to letters patent therefor, and thereupon the said George C. Gill did appeal from the decision of the said examiner of
54 interferences to the examiners-in-chief, and that said question of interference was heard and decided by the said examiners-in-chief, who held and decided that the said Walter Scott was the original and first inventor thereof and entitled to said patent.

That thereupon the said George C. Gill did appeal to the Commissioner of Patents from the decision of the said examiners-in-chief, and the said Commissioner did hear and determine such appeal, and did decide that the said George C. Gill was the original and first inventor of said improvements and was entitled to receive a patent for the same.

That thereupon the said Commissioner did complete the examination of said claim of said relator, George C. Gill, and that upon said examination it did appear to the said Commissioner of Patents that said relator, George C. Gill, is justly entitled to a patent under the law, and that the same is sufficiently useful and important, and the said Commissioner did, on the 4th day of June, 1883, finally decide and adjudge that said patent should issue in manner and form as follows:

That is to say, that the said Commissioner did decide and adjudge
55 that said relator, George C. Gill, was the original and first inventor of said improvements in printing-machines, No. 28100, and was entitled to receive a patent therefor covering the following claims, viz:

1st. The combination with the reciprocating bed, pistons, and cylinder, of air passages communicating with said cylinders at a point beyond that to which the piston enters, which passages are governed by a cock or cocks that are controlled by the belt-shifting mechanism of the machine, substantially as described.

2nd. The combination, with the bed, pistons, cylinders, cocks, rod, and rock-arm, of means connecting said rock-arm with the lever of the belt-shifter, all substantially as described.

That said relator, George C. Gill, did by an instrument in writing, for a good and valuable consideration, convey, sell, and set over unto the other relators, under their firm-name of R. Hoe & Co., all his right, title, and interest in and to said invention and improvements, and did request the Commissioner of Patents to issue the letters patent therefor when granted to said relators, under their firm-name of R. Hoe & Co., which as-
56 signment was duly recorded in the Patent Office of the United States.

That thereupon it became the duty of the said Benjamin Butterworth, Commissioner of Patents, upon the payment of the final fee to him of $20, to prepare or cause to be prepared letters patent of the United States in accordance with the said rights and claims of said relators as aforesaid,

and to present the same for signature to the Secretary of the Interior, and to countersign the same.

That the said relators have tendered to the said Commissioner of Patents the said sum of $20 for the final fee aforesaid. And whereas it further appears that you have unjustly refused to accept said final fee of $20, and to cause letters patent of the United States to the said relators, assignees of record as aforesaid, in manner and form aforesaid, to be prepared and sealed according to law, and to be presented to the Hon. H. M. Teller, Secretary of the Interior, for the signature thereto of the said Secretary of the Interior, as appears by the said relations of the said relators.

57 Now, therefore, we command you that you do receive the final fee of $20, and cause letters patent of the United States to the said Richard H. Hoe, Robert Hoe, Peter S. Hoe, Stephen D. Tucker, Robert Hoe, jr., Theodore H. Mead, and Stephen S. Hoe, assignees of record as aforesaid, under their firm-name of R. Hoe & Co., to be prepared and sealed according to law and to be presented to the Hon. H. M. Teller, Secretary of the Interior, for the signature of the said Secretary of the Interior.

And in what manner this our command is executed make appear to our said supreme court at its general term, to be held at the City Hall in the city of Washington, an the 21st day of April, 1884, then and there returning this our writ.

By the court.

D. K. CARTTER,
Chief Justice.

58 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the chief justice and justices of the supreme court of the District of Columbia, greeting:

Because in the record and proceedings, as also in the rendition of a judgment in a plea which is in the said court before you, between the United States ex rel. Richard H. Hoe, Robert Hoe, Peter S. Hoe, Stephen D. Tucker, Robert Hoe, jr., Theodore H. Mead, Stephen S. Hoe, trading as R. Hoe & Co., and Geo. C. Gill, and Benjamin Butterworth, Commissioner of Patents, No. 25184, law, a manifest error hath happened to the great damage of the said respondent, as by his complaint appears; and it being fit that the error, if any hath happened, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf: Therefore, you are hereby commanded, if judgment be therein given, under your seal, distinctly and openly, to send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at Washington, on the second Monday of October next, in the said Supreme Court to be then and there held, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and according to the law and custom of the United States should be done.

Witness the honorable Morrison R. Waite, Chief Justice of the United States, this 18th day of April, in the year of our Lord 1884, and of the Independence of the United States the one hundred and eighth.

[SEAL.] R. J. MEIGS, *Clerk.*

DISTRICT OF COLUMBIA, *to wit:*

To R. HOE & Co. and GEO. C. GILL:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States to be holden at Washington on the second Monday of October next, pursuant to a writ of error filed in the clerk's office of the supreme court of the District of Columbia, wherein Benjamin Butterworth is plaintiff, and you are defendant, to show cause, if any there be, why the judgment in the said writ of error mentioned should not be corrected, so that speedy justice be done the parties in that behalf.

Witness D. K. Cartter, chief justice of the said supreme court of the District of Columbia.

D. K. CARTTER, *Chief Justice.*

I hereby acknowledge to service on behalf of relators.
April 18, 1884.

MUNSON & PHILIPP,
Relators' Atty's,
By A. J. WILLARD.

59 *Authentication of record.—Clerk's certificate.*

Clerk's office, Supreme Court of the District of Columbia.

I, Return J. Meigs, clerk of the said court, do hereby certify that the writings annexed to this certificate are true copies of originals on file and of record in said office, and that said originals, together, constitute the record of the proceedings of said court in this cause.

Witness my hand and the seal of said court this 19th day of April, 1884.

[SEAL.] R. J. MEIGS, *Clerk,*
By J. JAY CAMP,
Assistant Clerk.

Justice's certificate.

I, David K. Cartter, chief justice of said court, do certify the foregoing attestation by Return J. Meigs, clerk of the said court, to be in due form.

Witness my hand and seal this 19th day of April, 1884.

D. K. CARTTER, [SEAL.]
Chief Justice.

Clerk's certificate to justice's official character.

I, Return J. Meigs, clerk of said court, hereby certify that David K. Cartter, whose genuine signature is subscribed to the foregoing certificate, was, at the time of signing and attesting the same, chief justice of said court, duly commissioned and qualified.

Witness my hand and the seal of said court this 19th day of April, 1884.

[SEAL.] R. J. MEIGS, *Clerk,*
By J. JAY CAMP,
Assistant Clerk.

(Indorsement on cover:) No. 1282. Benjamin Butterworth, Commissioner of Patents, plaintiff in error, *vs.* The United States ex rel. Richard H. Hoe, Robert Hoe, Peter S. Hoe, Stephen D. Tucker, Robert Hoe, junior, Theodor H. Mead, & Stephen S. Hoe, trading as R. Hoe & Company, & George C. Gill. District of Columbia supreme court. Filed 23d April, 1884.

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112-50

In the Supreme Court of the United States.

OCTOBER TERM, 1884.

THE COMMISSIONER of Patents *vs.* THE UNITED STATES, ex rel. Hoe &c. } No. 1282.

BRIEF FOR THE COMMISSIONER.

In the Supreme Court of the United States.

OCTOBER TERM, 1884.

THE COMMISSIONER of Patents *vs.* THE UNITED STATES, ex rel. Hoe &c. } No. 1282.

BRIEF FOR THE COMMISSIONER.

This is a writ of error upon a judgment in mandamus ordering the Commissioner to issue certain letters-patent, in an *interference* case.

The record shows that one Gill (the assignee of the relators) in March, 1881, applied for a patent upon an improvement in printing machines; that an *interference* was declared in respect to a patent to one Scott, issued March 8, 1881; that such further proceedings were had that upon the 4th of June, 1883, the then Commissioner ordered a patent to issue to Gill; that Scott thereupon (June 12), *appealed* to the Secretary of the Interior, and that the latter upon the 19th of March, 1884, overruled the aforesaid order, and directed that a patent should issue to Scott. Upon this a demand for a patent in accordance with his

own decision was made upon the Commissioner, who made return that the existence of the Secretary's judgment upon the appeal was all that prevented his compliance.

The question intended to be presented by the parties and the Government is whether, *in a case of interference*, that which is *virtually an appeal* (by whatever name called) lies as above from the judgment of the Commissioner to that of the Secretary, upon the matter of issuing a patent.

It is, of course, a question of mere statutory construction.

For this purpose it seems that a conspectus of all the successive statutory provisions upon the subject of issuing such patents at any time since 1789 may be of advantage.

These are as follows:

(1.—Act of 1790, Ch. 7, 1 Stat., 109.)

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That upon the petition of any person or persons to the Secretary of State, the Secretary for the Department of War and the Attorney-General of the United States, setting forth that he, she, or they, hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or

used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said Secretary of State, the Secretary for the Department of War, and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States, to bear teste by the President of the United States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery; which letters patent shall be delivered to the Attorney-General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and indorsed on the patent by the said Secretary at the time of granting the same.

This statute made no special provision for interferences.

(2.—Act of 1793, Ch. XI, 1 Stat., 318 and 322.)

SECTION 1. * * * That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters patent thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed; and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

* * * * *

SEC. 9. *And be it further enacted*, That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State; and the decision or award of such arbitrators, delivered to the Secretary of State, in writing and subscribed by them, or any two of them, shall be final as far as respects the granting of the patent; and if either of the applicants shall refuse or fail to choose an arbitrator, the patent shall issue to the opposite party. And where there shall be more than two interfering applications and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose.

(3.—Act of 1836, Ch., 357; 5 Stat., 117, &c.)

SECTION 1. That there shall be established and attached to the Department of State an office to be denominated the Patent Office, the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform, all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be by law directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office. And said Commissioner shall receive the same compensation as is allowed by law to the Commissioner of the Indian

Department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

SEC. 2. [After providing for a chief and an examining clerk, and other subordinates of the Patent Office, concludes as follows:] And said Commissioner, clerks, and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be, granted.

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SEC. 5. *And be it further enacted*, That all patents issued from said office shall be issued in the name of the United States and under the seal of said office, and be signed by the Secretary of State, and countersigned by the Commissioner of the said office, and shall be recorded, together with the descriptions, specifications, and drawings, in the said office, in books to be kept for that purpose. Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design, and in its terms grant to the applicant or applicants, his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery, referring to the specifications for the particulars thereof, a copy of which shall be annexed to the patent, specifying what the patentee claims as his invention or discovery.

SEC. 6. *And be it further enacted*, That any person or persons having discovered or invented any new and useful art, machine, manufacture, or composition

of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application in writing to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of any machine, he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing, or drawings, and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the inventor and attested by two witnesses, shall be filed in the Patent Office; and he shall moreover furnish a model of his invention, in all cases which admit of a repre-

sentation by model, of a convenient size to exhibit advantageously its several parts. The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths.

SEC. 7. *And be it further enacted*, That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the

propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claim for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains, who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commisioner of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts

and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter to the matter under consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application; *Provided, however*, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the Treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SEC. 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled

to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

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SEC. 16. *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity, and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions

of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act: *Provided however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

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(4. Act of 1839, Ch. 88, Sections 10 and 11, 5 Stat., 354.)

[The first section provides for "two assistant examiners" besides the clerk mentioned in the act of 1836, Sec. 2.]

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Sec. 10. *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act [of 1836, above], shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the chief justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor, or otherwise.

Sec. 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the chief justice [or "to either of the assistant judges," by act of 1852, Ch. 107], of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of $25. And it shall be the duty of said chief justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the Commissioner and the examiners in the Patent Office, may be examined under oath, in explanation of the principles of the machine or other thing for which a patent in such case, is prayed for. And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered

of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case; *provided however*, That no opinion or decision of the judge in any such case, shall preclude any person interested in favor or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court, in any action in which its validity may come in question.

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(5.—Act of 1842, Ch. 263, Sec. 3, 5 Stat., 543.)

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SEC. 3. *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woolen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas-relief, or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive

property or right therein to make, use, and sell, and vend the same, or copies of the same, to others, by them to be made, used and sold, may make application in writing to the Commissioner of Patents expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent: *Provided*, That the fee in such cases which by the now existing laws would be required of the particular applicant shall be one-half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.

* * * * *

(6.—Act of 1849, Ch. 108, Sec. 2, 9 Stat., 395.)

[This, act, by its first section, created the Department of the Interior, and in assigning various bureaus thereto provided as to the Patent Office:]

SEC. 2. That the Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents, now exercised by the Secretary of State; and the said Secretary of the Interior shall sign all requisitions for the advance or payment of money out of the Treasury on estimates or accounts, subject to the same adjustment or control now exercised on similar estimates or accounts by the First or Fifth Auditor and First Comptroller of the Treasury.

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(7.—Act of 1861, Ch. 88, sections 2 and 3; 12 Stat. 246.)

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SEC. 2. That, for the purpose of securing greater uniformity of action in the grant and refusal of letters patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners-in-chief, at an annual salary of three thousand dollars each, to be *composed* of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners-in-chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents.

SEC. 3. That no appeal shall be allowed to the examiners-in-chief from the decisions of the primary examiners, except in interference cases, until after the application shall have been twice rejected; and the second examination of the application by the primary examiner shall not be had until the applicant, in view of the references given on the first rejection, shall have renewed the oath of invention, as provided for in the seventh section of the act entitled "An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose."

8. The provisions of the act of 1870, Ch. 220, so far as these are important here, are repeated in those of the Revised Statutes given below:

SEC. 441. The Secretary of the Interior is charged with the supervision of public business relating to the following subjects:

* * * * *

Fifth. Patents for inventions.

SEC. 480. All officers and employés of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the office.

SEC. 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

SEC. 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not incon-

sistent with law, for the conduct of proceedings in the Patent Office.

* * * * *

SEC. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose.

* * * * *

SEC. 4893. On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

SEC. 4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

* * * * *

SEC. 4903. Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the

applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case.

SEC. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

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SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief, having once paid the fee for such appeal.

SEC. 4910. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person.

SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the District of Columbia, sitting in banc.

SEC. 4912. When an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commis-

sioner shall appoint, his reasons of appeal, specifically set forth in writing.

SEC. 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia upon

appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

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SEC. 4918. Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

The following are all of the express statutory provisions as regards *appeals*, *superintendence*, *direction*, and the like, operating *within* the various Departments, that I have been able to find.

Rev. Stat., Section 161, authorizes the head of each Department to prescribe regulations for the government thereof, "the conduct of its officers and clerks, the distribution and performance of its business," &c.

Section 191 provides that the balances which may from time to time be stated by the Auditor, and certified to the heads of Departments by the Commissioner of Customs or the Comptrollers of the Treasury upon the settlement of public accounts shall not be subject to be changed or modified by the heads of Departments, but shall be conclusive upon the executive branch of the Government, and be subject to revision only by Congress or the proper courts.

Sections 202 and 206 provide that the Secretaries of State and of War "shall conduct the business of the Department in such manner as the President shall direct." Section 417, that "the Secretary of the Navy shall execute such orders as he shall receive from the President relative to the procurement of naval stores," &c., "as well as all other matters connected with the naval establishment."

The duties of the other Cabinet officers are defined in detail, and upon a different principle, perhaps for obvious reasons.

In no Department other than those of the Interior and and the Treasury do I find *any appearance* of powers in

a subordinate officer that are *independent* of those of the heads. In general, therefore, the language of sections 161 and 191, above, is full and accurate in disposing of the duties arising out of official subordination within the Departments, all official work within them being by law attributed to their respective heads.

1. As regards the Treasury Department, however—

Section 191 expressly excepts certain important conclusions made by the Auditors, Comptrollers, and Commissioner of Customs, from the control as well of their own official head as of all others.

As for the *assistant secretaries*, section 245 defines their duty to be that of examining letters, contracts, and warrants prepared for the signature of the Secretary, and such other matters as may be prescribed by him. So far, therefore, there can be no collision of jurisdiction betwixt them and the Secretary.

The Treasurer is a bonded officer expressly ordered to disburse the public money "not otherwise" than according to a particular warrant (sec. 305). This of course limits the effect of section 161 above, which seems to be the only provision for general superintendence of the Department by the Secretary.

The duties of *the Register* are defined by law, and upon the face of them are not controllable, the office being one of *check*. (Sects. 312, &c.)

The Commissioner of Internal Revenue, "under the direction of the Secretary of the Treasury," has "general superintendence of the assessment and collection of all duties, &c. (Section 321.)

I find under Title XXXV R. S. (Internal Revenue), no provision for *appeals* from the Commissioner to the Secretary. In a number of cases action by the former must have *approval* or *consent* of latter. (Sec. 3208, 3215, 3229, 3255, 3315, 3330, 3386, 3445, 3463.

The Comptroller of the Currency "performs his duties under the general direction of the Secretary." He is a bonded officer. (Sections 324 and 326.)

The Director of the Mint is "under the general direction of the Secretary." (Section 343.)

2. In regard to the Interior Department:

The Assistant Secretary performs such duties as "shall be prescribed by the Secretary, or may be required by law." (Section 439.)

The Secretary "is charged with the supervision of public business relating to" the census, the public lands, Indians, pensions, patents, publications, education, &c. (Section 441.)

He exercises *supervisory* and *appellate* powers in relation to all acts of marshals, &c., as to the census. (Section 443.)

The Commissioner of the General Land Office performs, "under the direction of the Secretary," all executive duties in the survey and sale of the public lands, or otherwise respecting them, and the issuing of patents for land grants (see Snyder *v.* Sickles, 98 U. S., 203; and Maguire *v.* Tyler, 1 Black, 195; S. C., 8 Wall, 650); and in enforcing by regulations Title XXXII, sections 453 and

2478. *Appeals* in contests about preemptions lie to the Secretary from the decision of the Commissioner. (Section 2273.)

The Commissioner of Indian Affairs, "under direction of the Secretary," manages all Indian affairs. (Section 463.)

The Commissioner of Pensions, "under the direction of the Secretary," performs such duties as to pension laws as may be prescribed by the President. (Section 471.)

The Commissioner of Patents is a bonded officer. (Section 479.)

[In other respects his statutory relations to the Secretary are given first-above.]

The Superintendent of Public Documents is charged, "subject to the general direction of the Secretary," with the duty of collecting, preserving, packing and distributing publications. (Section 508.)

The duties of *the Commissioner of Education* are not specially subjected to the control of the Secretary. (Section 517.)

This is true also of *the Commissioner of Agriculture*. (Section 520.)

Upon the whole, it appears upon the face of the above statutes that "appeals," *eo nomine*, do not exist betwixt the subordinate officers of the Treasury and its head, and that in the Interior they exist in two cases only, viz, over marshals in census matters (sec. 443), and from the Commissioner of the Land Office in contests about preemption. (Sec. 463.)

Inasmuch as "appeal" is a common term of art, which conveys a distinct legal idea, it seems that where neither it nor any synonym of it is employed as regards a quasi-judicial act occurring within an Executive Department, the proceeding thereby denoted is intentionally excluded.

The rule of decisions in Cleveland Insurance Company *v.* Globe Insurance Company, 98 U. S., 366, may serve to illustrate the present contention. There the expression "general superintendence and jurisdiction of all cases and questions in the district court," in bankruptcy, was held to allow the circuit court upon which that "superintendence" had been conferred authority to exercise it, even were a case brought before it by writ of error; the reason being that if the subject-matter of the dispute was within the jurisdiction of the circuit court, and no particular form (technical or other) of invoking that jurisdiction had been specified, any (even a technical) form would be competent.

So, if the subject-matter of *allowing* a patent be subject in its essence to the *direction* of the Secretary, it is to be admitted that its having in this case been brought before him *by appeal* is immaterial. The true point of objection to the appeal here is that *such subject-matter is not within the Secretary's jurisdiction;* that assertion in turn being based upon the proposition that where an act substantially *judicial* is by statute assigned to an official within an *Executive* Department, *general words* indicating his subordinacy therein to certain executive superiors, words usual in Executive Departments as regards action of a merely executive character, confer no control over the exceptional, *i. e.*, the judicial element in such acts. Their or-

dinary operation upon the action of their subordinates is all that is proper here, and to that sort of action they will be confined.

Such limitation of effect appears to give full operation, as well to the particular word employed as to the significant absence of the familiar word of art not employed.

That "direction" is not *nomen generale* including "appeal," seems evident from the circumstance that the former is a part of the sovereign prerogative in the hands of a superior officer, exercisable wholly at *his* will and for the *public* good as understood *by him*; whilst the latter is a right vested in a litigant, and not exercisable without *his* pleasure, based no doubt upon what he conceives to be his *particular* interest.

Therefore, that which Congress would have given here, if it had not intended that the private contest involved in an *interference* should, so far as the Interior Department is concerned, be bound by the decision of the Commissioner, is a right of the latter sort, *not* of the former; it being a thing wholly anomalous in our system that a superior tribunal shall as regards a matter of litigation interfere with a decision below *sua sponte*, irrespective of the wish of any party thereto—which is the full force of the statutory expression that must be availed of here for the present claim.

This doubt is not diminished by the fact that an "appeal" was once allowed in these cases to the judges of the District court, &c., having existed (as then and still in ordinary applications) after 1836, for thirty-four years, and being done away with, without a substitute, in 1870.

However, it is to be added that so far as official executive action is under the *direction* of another, such directions as are actually given and remain operative, *are final*. Therefore, if a resort to the courts is required to control an act done according to such directions, that control must be applied to the director, not to the person directed. In obeying competent *direction*, the latter does his full duty to the law, leaving all legal responsibility therefor to him whom he obeyed.

The application of this principle to the present instance is the more proper, because *the Secretary* is required to sign the letters patent before they issue. It would be peculiar if a mandamus to a subordinate could *proprio vigore* compel positive official action by a superior.

To pursue the above suggestions more closely in their connection with this matter of granting letters patent office from its earliest origin—

1. The Secretaries and Attorney-General who passed upon claims for patents under the act of 1790, performed in that respect actions both discretionary and ministerial. The word *deem* appropriately denotes the former class of action in passing upon the right to a patent, while official action in transmitting the letters from one to another, the affixing the seal, and the recording and delivery, is plainly ministerial.

It seems that the *doom* pronounced by the Secretaries and Attorney-General as to the invention was final; that there was no appeal. And if for any reason (a claim of

right to rehear or what-not) the President had declined to have the seal affixed, the mandamus thereupon must have been directed to him.

The act of 1793, which displaced the cumbrous machinery of that of 1790, committed the whole matter of judging and issuing in ordinary cases (except as to regularity, &c.) to the Secretary of State. It seems that there was no appeal of any sort from him. The provision in the the act of 1790 (R. S., sec. 202), for a control by President over his *conduct of the business* of the Department cannot be construed to have intended that.

The same principle of finality in the action of officials in passing upon a claim for a patent attaches expressly by the same act to the *arbitrators* to whom are assigned the right to decide upon interferences.

This law continued in force for forty-three years, at the end of which a Commissioner of Patents was created within the Department of State.

The character of the action of this Commissioner in passing upon the claim—sufficiently clear from its nature—is also marked by the word "*appear*": "If it shall appear," or "shall not appear" to the Commissioner, appearance in such case involving judgment.

That there was no appeal from him to the Secretary is evident, not only by the silence of the statute as to its existence, but also by the circumstance that one was given

expressly (section 7) to a board of examiners, whose opinion was to *govern* the Commissioner.

So in respect to an *interference*, there was (section 16) to be a like *appeal*, with a right however to one or other party to go into equity, before or after this, the *adjudication* wherein should *authorize* (a *peremptory* word, by the rule of interpretation familiar in cases where citizens are interested in the thing *authorized*) the Commissioner to issue such patent.

The act of 1839 (amended in 1852) transferred these appeals to some one of the judges of the District court, the Commissioner to be *governed* as before by his decision.

It seems plain then that the act of 1849, so far as it transferred to the Secretary of the Interior the exercise of all *such* rights of *appeal* as theretofore had been exercised by the Secretary of State, in fact transferred nothing, the words being used by Congress, as is probable, out of caution merely.

The act of 1870 (reproduced in the Revised Statutes) provides that every application for patents, whether ordinary or attended by an interference, shall in the first instance be passed upon by the *examiners* from whom an appeal lies to the *examiners-in-chief*, and from these to the Commissioner. From the Commissioner an appeal lies to the supreme court of the District in ordinary cases only, *interferences* being expressly excepted. (Sections 4893,

4903, 4904, 4909, 4911, 4914.) This exception creates a distinction as to appeals from the Commissioner that has not existed heretofore. The statute, however, does not expressly provide any other appeal for cases of interference; appeals, I mean, from the Commissioner.

Upon this résumé of the statutory provisions upon this matter it seems plain that in cases of ordinary applications for patents there is no appeal from the Commissioner to the Secretary of the Interior upon the principal matter, *i. e.* the allowance of letters patent.

In *interferences* also, to which class the present case belongs, I doubt if the same rule does not apply.

As regards the latter it is true that there is not given, as for the former, *an express appeal directed to another quarter*. But it is to be observed that the act required of the Commissioner in passing upon a claim for a patent, has, as already suggested, a *quality* which, by the general principles of our law, secures for it specific effect in the way designed by its author, unless the supreme power have subjected it by apt words to that well-known subsequent process which in law has the speciffe effect of suspending or reversing it. An act having that quality is not in so far subject to *direction*. The quality which is required by such act is defeated by direction. If the officer having it be so subject, it is only as regards incidental matters concerning the form and *regularity* of his action, and not its judicial quality. If an "appeal"

lie *because* "direction" here is *nomen generale* including appeal as well as other sorts of supervision, then the sort of "appeal" that is given by the word direction may be exercised in its special likeness, *i. e.*, as *direction*, and so the Commissioner be *directed* by the Secretary *in the first instance* to give a particular decision upon the application. The special force of the word employed in the statute must be allowed to it, and although that force might authorize an *appeal* as heretofore known, it would equally authorize the Secretary to *direct* the Commissioner to give a particular decision upon the application of A. B.; just as now it authorizes him perhaps to direct that such application shall be heard in a certain room of the Interior within certain convenient hours, and with such and such publicity, and that after it has been made that he himself shall be certified thereof in a certain way and within a certain time.

Again, a Secretary coming nearest the *ideal* that is to be gathered from the statutes which concern his duties, by no means needs to have that special turn of mind or technical information, the one or other of which must enter into an ideal of a Commissioner. The generality of his functions forbids that, and so far goes to forbid its being "good form" to vest in him an appeal from the Commissioner upon such technical matters, and consequently to contradict an implication of such appeal.

To the same effect is the force of more immediate parts of the statute. The word "appeal" is often used therein, but in no case in connection with the Secretary. It might have been supposed that within the Patent Office

the existence and also the number of subordinate decisions and appeals might have been left to be regulated by the Commissioner, or at all events by the Secretary. It is otherwise, however. The first hearing of an interference and the gradations of appeal are provided for by the statute minutely. There is the express statutory hearing by the examiner,—"appeal" to examiners-in-chief,—and "appeal" again to the Commissioner, followed by silence for anything further within the Department, excepting the *issue* of letters patent signed by the Secretary and countersigned by the Commissioner, acts which in cases otherwise regular are as merely ministerial as *execution* after a court judgment. That silence seems significant, for wherever Congress has thought an appeal proper, it seems to have expressly given it. It has not left the discretion required for a hearing to be vested (as it is suggested that the statute in effect does) *by an order of the Secretary* "primarily" in an examiner, &c., and presumptively it has not left so serious a matter as a rehearing by the Secretary, *at his option*, as is evident it must be if it lie in a "direction" by him, for he may *direct* that the decision of the Commissioner shall be final.

However, leaving this question of *appeal* involved in the present case to the judgment of the court, without taking further part in the contention, I submit that the correction of whatever miscarriage there may have been by *mandamus* should have been addressed to the Secretary of the Interior, and not, as here, to the Commissioner.

Upon the general question I append the considerate and important opinion of Attorney-General McVeagh, referred to in the return of the Commissioner (record, p. 6) in which he advised that an appeal does lie from the Commissioner to the Secretary.

S. F. PHILLIPS,
Solicitor-General.

DEPARTMENT OF JUSTICE,
Washington, August 20, 1881.

Hon. S. J. KIRKWOOD,
Secretary of the Interior:

SIR: Your letter of the 3d instant states that you have before you on appeal, or on petition in the nature of appeal, from decisions of the Commissioner of Patents, the cases of Henry C. Nicholson *vs.* Thomas A. Edison (duplex telegraph) and F. V. Le Roy *vs.* D. A. Hopkins (journal bearings). From the papers transmitted by you I learn that the status of the cases is as follows:

In March, 1879, an interference was declared between Edison and Nicholson, and during that month Edison filed a preliminary statement under oath showing the date of the original conception of his invention, of its illustration by model or drawing, of its disclosure to others, of its completion, and of the extent of its use. In September, 1880, testimony in the case was commenced. In the following November Edison moved for leave to amend his preliminary statement by adding a reference to a certain caveat accompanying his motion, with affidavits explanatory of its omission from the preliminary statement and of his delay in making the motion.

This motion was successively refused by the examiner in charge of interferences and by the Commissioner. From the decision of the latter Edison has appealed or petitioned in the nature of an appeal. The case of Le Roy *vs.* Hopkins is not materially different so far as it gives rise to the questions upon which you request my opinion.

Your first inquiry is whether you have the power to allow this amendment.

This question of how far the Secretary of the Interior has controlling or appellate power over the Commissioner of Patents is one which has assumed greater importance and received more and more attention as the expansion of the business of that office and of the other Bureaus of the Department has rendered less and less practical the personal exercise by the head of the Department of the powers vested in him by law. Secretary Chandler (9 Official Gazette, 403) disclaimed any appellate powers; Secretary Schurz (13 *Ibid.*, 771, 16 *Ibid.*, 220) concurred in this view, but the latter directed the Commissioner to prepare for issue (12 *Ibid.*, 478) certain letters patent which the Commissioner had decided shoul not be issuedd until a bill in equity then pending in the supreme court of the District should be disposed of.

I shall not attempt to distinguish the cases before me from the ones considered by these eminent Secretaries, but will state my opinion and the reasons therefor.

I think the key to the whole question is found in Sections 441 and 481 of the Revised Statutes. By the former "the Secretary of the Interior is charged with the supervision of the public business relating to (*inter alia*) patents for inventions," and by the latter it is provided that "the Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform *all* duties respecting the granting and issuing of patents directed by law." To my mind every section imposing a duty or conferring a power on the Commissioner of Patents should be read as if the words "under the direction of the Secretary of the Interior" were inserted.

It is not necessary to the validity of all acts of the Commissioner that the direction of the Secretary should be expressed. That will always be presumed except in the cases which require his express approval, to wit, the adoption of regulations (Sec. 483 R. S.), the refusal to recognize a person as patent agent (Sec. 487), and the actual granting of a patent. (Sec. 4883.)

The latter section requires the patent to be signed by the Secretary of the Interior while the name of the Commissioner appears only by way of counter-signature.

Lexicographers unite in defining countersign to mean "to sign what has already been signed by a superior, to authenticate by an additional signature."

This distinction between the duties of the two officers palpably means that the Secretary's signature is not for mere purpose of authentication. It would be absurd in face of Sections 441, 481, and 4883 to say that the act of the Secretary in issuing the patent is purely ministerial, the act of a clerk of a court registering the decree delivered by some tribunal. I find no clause or section relieving the Commissioner from the directing powers of the Secretary, and I am irresistibly led to the conclusion that the final discretion in all matters relating to the granting of patents is lodged in the Secretary of the Interior. In the case of a collision between himself and the Commissioner (as in Sargent's case, 12 Off. Gazette, 475), he may direct the latter to prepare letters patent for his signature, and may further direct him to attach his counter-signature.

From the right and power of the Secretary to withhold his signature from the patent unless he is satisfied of the claimant's title thereto plainly follows an equal right to direct the Commissioner while the proceedings are pending, to receive an amendment which will open up a line of evidence that may throw light on that title.

Considerable confusion has arisen from the use of the word appeal in describing the applications made to the Secretary by persons dissatisfied with the acts of the Commissioner, and because Congress has expressly provided in sections 4909, 4910, and 4911 for appeals to the board of examiners-in-chief, to the Commissioner, and to the supreme court of the District of Columbia, it is argued that there are no rights of appeal except those given by statute, and no power of review except by appeal. The

latter proposition came before the supreme court of the District on the application of Hull for a mandamus to compel the Commissioner to grant him a patent (2 McArthur, 90). The board of examiners-in-chief decided in favor of his claim, but the Commissioner refused to issue the patent, contending that there rested in him a discretion in determining whether the patent should issue, and that in his judgment it should not. The relator insisted that the only right to appeal from the examiners-in-chief was in him, and that he was satisfied with their decision. The court held that the Commissioner by virtue of his supervisory power might refuse to issue a patent although the examiners-in-chief decided that it should be granted. The principles there laid down seem especially applicable to the supervisory powers of the Secretary over the whole business of patents for inventions, his directory power over the Commissioner of Patents, and his right to withhold his signature from the letters patent. The language of Judge Olin (p. 108), if for "Commissioner" be substituted "Secretary of the Interior," and for "examiners-in-chief" be substituted "Commissioner of Patents," I adopt as my own. He says:

> "I think the right of appeal was omitted because it was unnecessary to confer it; for the Commissioner's supervisory power over acts of the subordinates in the office is such as to preclude any necessity of 'appealing' from the examiners-in-chief. He can refuse to grant the patent."

Edison, therefore, is not appealing to you from a decision of the Commissioner, but is invoking the exercise of your directory and supervisory powers.

It is also argued that a dual right of appeal should not exist; that because an appeal from the Commissioner to the supreme court of the District of Columbia (in cases not of interference) is provided by statute (Section 4911), the Secretary of the Interior has no control over the Commissioner and his subordinates. I have already shown

that an application for your interference is not an appeal in the sense in which the word is used in the laws providing for the Patent Office. The right of appeal to the supreme court of the District in no way conflicts with the directory and supervisory powers of the Secretary, and Sections 481 and 4911 may easily be read together without any inconsistency.

As I have already observed, every act of the Commissioner is presumed to be done with the knowledge and by the direction of the Secretary until or unless the contrary appears. By the decision of the Commissioner in Section 4911 is meant not his personal opinion, but the act of deciding in accordance with the direction of the Secretary. It would not be the entertainment or expression by the commissioner of views hostile to the issue of a patent that would furnish grounds for an appeal to the court, but it would be the act of deciding which, theoretically, is the act of the Secretary. Two supposed cases will illustrate my meaning. The Commissioner is of opinion that A should not have a patent, and declines to prepare letters patent until the Secretary, entertaining a different view, directs him to do so. The Secretary affixes his signature, and directs the Commissioner to authenticate them by his counter-signature. His refusal to do this would not entitle A to an appeal to the court, whatever might be A's rights to a mandamus.

On the other hand the Commissioner considers B entitled to a patent, prepares and countersigns the letters, but the Secretary manifests his disapproval of the Commissioner's act by refusing to sign. Persistence in this refusal would be tantamount to a direction to the Commissioner to cancel the counter-signature. No mandamus would lie against the Secretary, and B would be entitled to appeal to the supreme court of the District of Columbia, although as a matter of fact he would be appealing from the decision of the Secretary, and asking the court to maintain that of the Commissioner.

It is admitted that the responsibility of seeing that the

work is properly done by the Commissioner of Patents is with the Secretary of the Interior, but an effort is made to draw a line between the ministerial or administrative duties of the Commissioner and those requiring the exercise of discretion, and to confine the directory and supervisory power of the Secretary to the former class. But the directory power of the Secretary by statute comprehends all duties of the Commissioner, and to say the least the Secretary is invested with powers of discretion equal to those of the Commissioner.

The Commissioner of the General Land Office (Sec. 445), of Indian Affairs (Sec. 463), of Pensions (Sec. 471), and of Patents (Sec. 481), perform their respective duties "under the direction of the Secretary of the Interior," while the Superintendent of Public Documents (Sec. 508) whose duties are mainly mechanical is "subject to the general direction of the Secretary of the Interior."

I do not see why, if the directory power of the Secretary over patents is to be confined to the ministerial or administrative duties of the Commissioner, it should not by a parity of reasoning be equally circumscribed in the Land, Indian, and Pension Offices, and the Secretary become only nominally the head of the Interior Department.

It is true that within the bounds of the discretion reposed in these several Commissioners their decisions are accepted as final by the courts, and they will not interfere by mandamus to direct how that discretion shall be exercised. This, however, is because the act of the Commissioner is constructively the act of the Secretary, and not because the Commissioner may exercise his discretion independent and in defiance of the head of the Department.

These observations I think sufficiently answer your first inquiry, which is as follows:

> "Has the Secretary of the Interior jurisdiction to review decisions of the Commissioner of Patents, rendered under Rule 110, Rules of Practice of the Patent Office, overruling motions to amend preliminary statements in interference cases?"

I am not unaware of the vast amount of labor which must result if you personally review all the acts and decisions, discretionary as well as administrative, of the Commissioner of Patents. Indeed it would be physically impossible for you to do this. The argument *ab inconvenienti*, however, addresses itself rather to you when you prescribe regulations under Section 161, Rev. Stat., for the performance of the business of the Department.

It by no means follows that you are required to exercise in every case the directory power invested in you, and from the nature of things you must sign many papers and do many acts in confidence that your subordinates have acted honestly and wisely. In order that the business of the Department may be accomplished, and that it may be conducted in an orderly manner, it will be perfectly proper for you by regulations to define the class of cases or disputes in which you will specially exercise your directory powers, leaving all others to your general directions; you may also describe the state of the proceedings at which they may be invoked.

I have confined myself in this opinion to your first inquiry; the other three will form the subject of a subsequent communication.

I return herewith all inclosures except the pamphlets containing the patent laws of the United States and the Rules of Practice of the Patent Office.

Very respectfully, your obedient servant,

WAYNE MacVEAGH,

Attorney-General.

112-30

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IN THE

Supreme Court OF THE United States.

OCTOBER TERM, 1884.

BENJAMIN BUTTERWORTH,
Commissioner of Patents,

vs.

THE UNITED STATES, *Ex rel,*
RICHARD M. HOE, *et al.*

No. 838.

BRIEF FOR SCOTT.

IN THE

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BRIEF FOR SCOTT.

STATEMENT.

It appears by the record, that George C. Gill, one of the relators, filed his application for letters-patent in the Patent Office, March 12, 1881; and that upon an examination thereof, it was found that said application would interfere with an unexpired patent granted to Walter Scott, March 8, 1881; that an interference was thereupon declared between the said application and said patent, and the Commissioner directed the examiner to proceed to determine the question of priority of invention. That proceedings were had in accordance with the practice in such matters, which resulted in a decision by the examiner of interferences, in favor of Scott, the said patentee. That from such decision Gill appealed to the examiners-

in-chief, who affirmed the decision of the examiner of ineerferences, and from their decision he appealed to the Commissioner of Patents. That the Commissioner, the predecessor of the plaintiff in error, reversed the action of the examiners-in-chief, and awarded priority of invention to Gill, on the ground that Scott, although in fact the first inventor, had been guilty of laches in prosecuting his invention and seeking a patent therefor, which amounted to abandonment; and he decided that Gill was entitled to receive a patent.

From this decision, under and pursuant to rules in such cases made by the Secretary of the Interior, Scott appealed to the secretary, who, after arguments in behalf of both Gill and Scott, decided that Scott was the first inventor and reversed the action of the commissioner. After the submission of the matter to the secretary, the relators tendered the final fee to the plaintiff in error and demanded that letters-patent be prepared and issued to them, basing their demand upon the action of his predecessor, which demand he refused on the ground that the Secretary of the Interior had reversed the action of the Commissioner of Patents, and decided that Gill was not entitled to a patent. This is a writ of error upon a judgment in *mandamus* ordering the plaintiff to receive the final fee, to cause letters-patent to the relators to be prepared and sealed, and presented to H. M. Teller, Secretary of the Interior, for his signature.

POINTS.

The principal question presented, is, whether the Secretary of the Interior has the power, under the law, to control the action of the Commissioner of Patents and to revise or reverse his decision in the matter of grant-

ing and issuing a patent in an interference proceeding.

The following extracts from several sections of the Revised Statutes, U. S., conclusively indicate that power.

Sec. 441. The Secretary of the Interior is *charged with the supervision* of the public business relating to the following subjects:

First. The census. Second. The public lands, including mines. Third. The Indians. Fourth. Pensions and bounty lands. *Fifth. Patents for Inventions.* Sixth. The custody and distribution of publications. Seventh. Education. Eighth. Government Hospital for the insane. Ninth. Columbia Asylum for the deaf and dumb.

Sec. 475. There shall be in the *Department* of the Interior an *office* known as the Patent Office.

Sec. 476. All the officers except the Commissioner and assistant Commissioner of Patents and the examiner-in-chief, shall be appointed by the Secretary of the Interior upon the nomination of the Commissioner of Patents.

Sec. 481. The Commissioner of Patents, *under the direction of the Secretary of the Interior*, shall superintend or perform all duties respecting the granting and issuing of patents directed by law, (which herein, are or may hereafter be by law directed to be done—1836, 1870.

Sec. 483. The Commissioner of Patents, *subject to the approval of the Secretary of the Interior*, may from time to time, establish regulations, not inconsistent with law for the conduct of proceedings in the Patent Office.

Sec. 487. For gross misconduct, the Commissioner of Patents may refuse to recognize any person as a patent agent, either generally or in any particular case, but the reasons for such refusal shall be duly recorded, and be *subject to the approval of the Secretary of the Interior.*

Sec. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and *shall be signed by the Secretary of the Interior* and countersigned by the Commissioner of Patents.

It is apparant from these sections, and others that might be referred to, that the Commissioner of Patents is subordinated to the Secretary of the Interior, and that all of his acts in superintending or performing the duties directed by law, respecting the granting and issuing of patents, are subject to the "supervision," "direction," and "approval" of the Secretary. The Secretary may interfere and exercise this power at any time that he *elects so to do.* The power of supervision and direction, gives jurisdiction to the Secretary, upon application made to him in any form that he may prescribe, by appeal or ortherwise, to affirm, reverse, or modify the action of the Commissioner.

The power to approve includes the power to disapprove. A rule of practice has been made to apply to appeals from the Commissioner to the Secretary, but it needed no such rule to bestow the right to invoke such revisory and supervisory power. The statute gives the right by imposing upon him the duty of supervision and direction.

Unrestricted, and unless in duty bound blindly to sign every patent placed before him for signature, the responsibility of signing such instruments would carry with it the right of refusal of signature by the Secretary, in any case in which it should come to his knowledge that the applicant was not entitled to a patent.

By reason of his power of direction and supervision, although no appeal be provided by law, and although

none should be actually taken, it would be his right, and his duty, *sua sponte*, to reverse the action of the Commissioner of Patents awarding a patent, upon any facts in the record, which showed that the applicant was not entitled to a patent—such as, for example, the disclosure made by the record in the interference between Scott and Gill, that Scott was and Gill was not the first inventor.

Hull v. Comm'r of Patents, 2 McA., 105-6.

The section of the Revised Statutes relating to interferences, and prescribing "*priority of invention*" as the sole subject of inquiry and determination is as follows:

Sec. 4904. Whenever an application is made for a patent which in the opinion of the Commisioner would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed and *determine the question of priority of invention.* And the Commissioner may issue a patent to the party who is adjudged the prior inventor, &c.

If the Commissioner of Patents, misconceiving his power and his duty under this section, determines an inference upon some other ground than priority of invention, and decides that a party who is conceded not to have been the first inventor, is entitled to a patent, is it not absurd to contend that the head of the department, who, under the law, exercises supervisory direction, and control over the issuing of patents, and upon whom is imposed the responsibility of giving them vitality by his signature is powerless to arrest and reverse the illegal judgment.

In this matter between Gill and Scott, the decision of the Commissioner is plainly based upon the question of abandonment by Scott, the patentee, a matter that under the law he had no right to consider.

Ex rel Bigelow vs. Comm'r of Patents 2, Mac A. 31, 32, 33.

Upon his theory and premise, that Scott's patent would be avoided by the courts because of abandoment, he concludes, that, although he was in fact the first inventor, Gill is the first meritorious inventor, and therefore entitled to a patent. The Secretary of the Interior, in the exercise of his supervisory power under the law, in accordance with a practice established in 1881 after an opinion of the Attorney General of the United States in that behalf rendered, a practice reported by the Secretary to Congress in that year, as to which there has been no legislative dissent, (see Exhibit E page 17 of the record) and in the performance of his duty to see that the law is faithfully executed, has ascertained that Gill one of relators, was not the prior inventor, and is not entitled to a patent, and he has reversed the decision of the Commissioner. This should be final and conclusive, so far as this proceeding is concerned, for he "really controls the issuing."

Opinion of Olin J. in Hull v. *Commissioner* 2, Mc A 108.

U. S. ex rel Kecklin v. Marble 2, Mackey 12, 14, 17.

Except these earlier outgivings of the Supreme Court of the District of Columbia, so at variance with its decision in this cause, no adjudicated case has apparently defined the relative powers of the Secretary of the In-

terior and the Commissioner of Patents, in the matter of granting and issuing letters-patent. It is submitted however, that the power claimed for and exercised by him in this instance, under the language used in the law, and the relations of chief and subordinate in an executive department of the government, is fully warranted and justified by the following cited cases.

Barnard's heirs *v.* Ashley's heirs, 18 How 44.
Maguire *v.* Tyler, 1 Black, 202, 203.
Snyder *v.* Sickles, 98 U. S. 209.
Patterson *v.* Tatum, 3 Sawyer, 169.
and see Johnson *v.* Towsley, 13 Wall, 82.
The Secretary *v.* McGarrahan, 9 Wall, 314.
U. S. *v.* Schurz, 102 U. S. 378.

As against the existence of this power, it is claimed tnat the function of the Commissioner of Patents in granting patents, either in *ex parte* proceedings, or in contested matters of "Interference" is judicial, subject to review only in the specific manner of appeals authorized by the law; that these provisions of relief and appeal constitute a system in which no place is assigned to the Secretary of the Interior, and that, therefore, all of the *decisions* of the commissioner under the law, are final and conclusive upon the Secretary.

His decisions are not judicial in the legal sense of the term. The action of the commissioner in the grant and the issue of letters-patent which manifest the approval of the Secretary by his signature, is final and conclusive only in regard to the sufficiency and competency of the *formal* acts and proofs, which the statute provides shall be prerequisite to the issuing of the patent.

U. S. Rifle Co. *v.* Whitney Arms Co., 14 Blatch 94.
Planing Machine Co. *v.* Keith, 101 U. S. 483.

The allowance and issue of a patent creates a *prima facie* right *only*, and upon all the questions involved, its validity is subject to examination.

Reckendorfer *v.* Faber, 92 U. S. 347.

Even where an "Interference" has been had, the decision is not then conclusive upon the parties to that proceeding.

Union Paper Bag Machine Co. *v.* Crane 1 Holmes 429.

And to avoid all possibility of misconception arising out the right of appeal to the Chief Justice of the Circuit Court for the District of Columbia, under the Act of 1839, or either of the assistant judges, under the Act of 1852, or the Supreme Court of the District of Columbia, under the Act of 1870, and as embodied in the Revised Statutes U. S., Sec. 4914, it is expressly provided that no decision, in any such case, shall preclude *any person interested* from the right to contest the validity of such patent in any court where the same may be called in question.

Prior to the act of 1836 no examination into the novelty and utility of an invention was required up on application made for letters-patent. The examination required by that act, and by the subsequent acts, was intended for the protection of the public.

See Burr *v.* Duryee 1 Wall. 577.

It gives no additional force or validity to the patent issued, which, until it has received judicial approval is evidence only of a *prima facie* right.

The authority of the Commissioner of Patents in granting a patent is not in the nature of *jurisdiction* in the common law acceptation of the term.

Wilder *v.* McCormic 2 Blatch 31.

He adjudicates nothing judicially, and therefore nothing finally. His decision is nothing more than the exercise of the executive function. It would be a strange anomaly that his decision upon the question of the right to the patent should be final and conclusive upon the Secretary of the Interior, when the patent itself is conclusive of that right upon no one.

If the decision of the Commissioner is not a judicial act, then, under his statutory relations to the Secretary of the Interior, and the evident intention and policy of the law, and in view of the decisions of this court in questions involving the construction of the laws relating to the powers of the Secretary of the Interior, and the Commissioner of the Land Office, cited in this brief, it must be subject to revision, and therefore reversal by the Secretary.

The provisions of the "system," so called are not inconsistent with this. No appeal in Interference cases to the Supreme Court of the District of Columbia is anthorized. In *ex parte* applications, an appeal is given to that Court from the decision of the commissioner refusing a patent, but that is perfectly consistent with the supervisory and directory power over his acts claimed for the Secretary of the Interior. If this power has been invoked, the commissioner acts, it may be, upon the expressed direction of the Secretary; if not invoked, this direction is implied. and in either event, upon the refusal to grant a patent an appeal lies.

It would be a very strained construction of the section giving this right of appeal, to hold, as asserted in the court below, that if the commissioner acts upon the expressed direction of the Secretary in refusing a patent it would not be his decision, and that therefore an appeal

would not lie. It must be observed, also, that the Supreme Court of the District of Columbia, is confined in its action to the case actually made, "to the points set forth in the reasons of appeal," and that its decision must extend, not to ordering a patent to issue, but to the determination of the questions involved in the reasons of rejection; and its decision governs "the further proceedings in the case," only as to those matters involved in the appeal.

There may exist a large discretion outside of those matters, to be exercised before the right to a patent is finally determined.

The law is susceptible of such a construction as will give applicants all of their rights, and, at the same time, conserve to the head of a great executive department all of the supervisory and directory power and control, which he ought to, and it is the evident intention of the law that he should exercise.

This is not a suit against the Secretary of the Interior, and without its concurrence, manifested by his signature to the patent, the act of issuing the writ prayed would be fruitless and unavailing. In the face of this record, showing the adverse action of the Secretary, even admitting that he controls his own action *alone*, it is apparent that the writ, if issued, would necessarily be fruitless, and under such circumstances courts refuse to interfere.

Colonial Life Ins. Co. *v.* Supervisors of N. Y. 24. Barb. 166.

Queen *v.* Norwich Saving Bank, 9 Ad. & E.. 729.

See The Secretary *v.* McGarrahan, 9 Wall, 314.

If this record should be used as the foundation of an application for *mandamus* to compel the Secretary to affix

his signature to a patent prepared and submitted to him for that purpose, as proposed in this proceeding, it is perfectly manifest, that this court, pursuing the line of its own decisions would be compelled to refuse the writ.

Kendall v. *United States*, 14 Peters, 497.
Mississippi v. *Johnson*, 4 Wall, 475, 498, 501.
United States v. *Seamen*, 17 How. 225.
Same v. *Guthrie*, 7 id. 284.
Gaines v. *Thompson*, 7 Wall, 347.
Secretary v. *Mc Garrahan*, 9 Wall 298, 312.

But if there existed no other complete objection to granting the process of mandamus in this cause, the fact that there existed another adequate remedy should have been fatal to the application.

High Ex. Leg. Remedies, Sec. 16.
Hull v. *Commissioner of Patents* 2, Mac A. 69, 107, 108.

This remedy is found in section 4915, Revised Statutes U. S., which is as follows:

"Whenever a patent on application is refused for any reason whatever Act 1836) either by the Commissioner of Patents, or by the Supreme Court of the District of Columbia, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention as specified in his claim, or for any part thereof as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and

otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision be in his favor or not."

By this proceeding by bill in equity, the entire right of the relators can receive judicial investigtaion, adverse and opposing parties can be represented, their rights be protected, and complete justice done to all parties concerned.

It is therefore respectfully submitted that the judgment of the court below should be reversed.

A. C. BRADLEY,

Counsel for Scott.

112-50

IN THE SUPREME COURT OF THE UNITED STATES.

BENJAMIN BUTTERWORTH, COMMISSIONER OF PATENTS,
Plaintiff in Error,

against

THE UNITED STATES EX REL. RICHARD M. HOE ET AL. AND GEORGE C. GILL,
Defendants in Error.

BRIEF AND ARGUMENT FOR DEFENDANTS IN ERROR.

A. J. WILLARD,
WASHINGTON, D. C.,
Attorney for Defendants in Error.

C. G. BURGOYNE'S "Quick" Print, 146-150 Centre St., N. Y.

Supreme Court of the United States

BENJAMIN BUTTERWORTH, Commissmissioner of Patents,
Plaintiff in Error,

AGAINST

THE UNITED STATES EX REL., RICHARD M. HOE, ET AL. and GEORGE C. GILL.

Argument of Defendant in Error.

The judgment of the Supreme Court of the District of Columbia, in which error is here alleged, allowed to the relators a peremptory mandamus, ordering the plaintiff in error, the Commissioner of Patents, to accept from the relators the final fee and to prepare letters patent of the United States and seal the same, and to present the same to the Hon. H. M. Teller, Secretary of the Interior, for his signature thereto, upon the application of George C. Gill for new and useful improvements in printing machines, No. 28,100.

The petition and mandamus recite the grounds upon which the relator, George C. Gill, as the inventor, and the relators, Hoe and others, as his assignees, claim the letters of patent in question. The only portion of the relators' claim that is brought into question by the errors assigned, is as to the finality of the decision of the Commissioner of Patents upon appeal, from the decision of the examiners in chief affirming a decision made by

the Examiner of Interferences in the matter of an interference declared between the unexpired patent of Walter Scott, No. 238,720, granted March 8, 1881, and the application of George C. Gill, made March 12, 1881.

The decision of the Commissioner reversed that of the examiners-in-chief and established the right of the relator Gill to the patent applied for by him. The relators claim that this decision was final and conclusive, as no proceedings have been instituted before the Commissioner or are desired by that officer for any further examination into the case. On the other hand, Walter Scott assumed to take an appeal from such decision to the Secretary of the Interior, who entertained such proceeding and assumed to revise the decision of the Commissioner, and to establish the right of said Walter Scott as against the claim of the relators. The whole matter in controversy is thus: The validity of the proceedings before the Secretary of the Interior, and the effect of the decision rendered by that officer upon such proceeding. The position of the relators is that the Secretary of the Interior possessed no authority to revise the decision of the Commissioner in the premises, while the plaintiff in error controverts that position.

The position in this case occupied by the Commissioner of Patents is fully explained in the return of that officer to the relators' petition and rule (Case, folio 14). It is evident from that return that the Commissioner deemed it his duty to submit the case fully to the Supreme Court of the District of Columbia for its decision, in view of the gravity of the question, and the importance that it should receive final adjudication, and conceived himself specially bound to seek the direction of the Court, in view of the fact that the assumption of such appellate authority by the Secretary of the Interior, will have the effect to change the method of administering the duties of the office which

has always prevailed from the first institution of the Patent Office down to a recent period. In order to divest the question intended to be presented to the courts of complication, the Commissioner sets forth that he does not desire to make any further examination of the case, and the only reason for his refusal to comply with the demands of the relators is the fact of the appeal to the Secretary of the Interior, and the action taken upon such appeal.

The questions thus presented to this Court are: First. Whether the Secretary of the Interior possessed authority to revise and reverse the decision of the Commissioner of Patents upon a question of priority of invention, as between parties to an interference duly declared. Second. If such authority does not exist on the part of the Secretary of the Interior, whether the rights of a party disturbed by the assumption of such an authority are capable of being protected and enforced by mandamus.

As the office and powers of the Secretary of the Interior are created and defined by statute, the question so far as it involves those powers is one of statute construction. The existing statutes having a possible bearing on the question at issue are the following sections of the R. S., 441, 481, 483 and 487. These sections contain all the provisions of law conferring upon the Secretary of the Interior either general authority, as it regards matters pending before the Patent Office, or authority in special matters there pending.

Section 441 confers the general authority of the Secretary of the Interior, and is as follows: "The Secretary of the Interior is charged with the supervision of the public business relating to the following subjects: * * *

"Fifth. Patents for inventions."

The other sections enumerated above define the powers of the Secretary of the Interior in certain specific cases in an indirect manner by limitations imposed

upon the powers of the Commissioner of Patents; section 481 is as follows: "The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines and other things belonging to the Patent Office."

Section 483 declares: "The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

Section 487 provides, "for gross misconduct, the Commissioner of Patents may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior."

If the question of the nature and limits of the authority of the Secretary of the Interior depended wholly upon the language of section 441, the question here presented would be simply solved. The character of the powers there conferred is described by the terms "supervisory," that, in its application to judicial acts, such as we contend were the official acts sought to be reviewed by the Secretary of the Interior, carries a well-understood sense. The supervisory authority of the Superior Courts over the judgments and proceedings of inferior courts, is well recognized by our law as not extending to the reversing of the judgments of such inferior courts, as to matters of fact and law submitted to them, except where a writ of error will lie, either at common law or by statute, and where statute authority is conferred for that purpose, by way of appeal or otherwise. This general exclusion of the Superior Courts from revising the judgments of inferior courts evidently arises from the nature of ju-

dicial powers, and so it has always been considered by the courts. It would, then, be a necessary inference, from the language of that section, that, as it regards judicial acts performed by the Commissioner of Patents, the supervisory authority of the Secretary would merely extend to see that the action of the Commissioner was within the scope of his authority, and conformable to the law governing his procedure, and not to the revision of his adjudication of the rights of the parties in matters pending before him of a judicial nature. The question whether the matters decided by the Commissioner, in the present case, were of a judicial character, will be presented hereafter.

It is contended by the plaintiff in error, that section 481 contains a general grant of authority to the Secretary of the Interior to direct the Commissioner of Patents in the discharge of all duties relating to the granting and issuing of patents; that section provides that: "The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law." It must be considered that if this section is read as intending to subject to the directing power of the Secretary of the Interior all duties performed by or under the authority of the Commissioner of Patents, as it regards matters to which the authority to grant and issue letters patent for invention extends, and if the term "direction" is to be taken in its full sense, the Secretary of the Interior has not only authority to revise the action of the Commissioner of Patents, in the performance of all duties of that class, but may give directions in any particular case, or in cases generally, how those duties shall be performed, and thus reduce the office of Commissioner of Patents to a mere clerical office. The term *revision* implies an act performed by one authority to be re-examined and corrected by another, but *direction* implies control over the primary performance

of the act. That Congress did not intend to commit the administration of the rights of individuals under the patent laws to so unsuited a system as that which would result from the interpretation just indicated, is obvious without comment. It is presumable that Congress intended to create a systematic means of securing the rights of property intended to be created by the patent laws, and a construction that would place in the political head of a department unlimited authority in such cases would absolutely destroy the systematic character of that administration. This Court has uniformly regarded the Commissioner of Patents as possessing a certain independence of discretion in the exercise of his functions, and such a condition would be impossible under the broad construction just considered.

It is evident then that the language of section 481 needs constructive consideration, and that implies the examination of the principles involved, the origin and development of the public powers concerned in a historic sense, and the objects intended to be secured by the legislation in question; through these instrumentalities the proper interpretation of the language under consideration can alone be fixed. As the powers of the Commissioner of Patents form part of the administrative system of the government, they are necessarily amenable to the principles that are fundamental to all public functions and powers. These principles and their proper consequences must be regarded as the substratum of the intention of Congress in lodging for exercise and formulating the public powers; and, therefore, of the section under consideration, that performs that office.

Our political and legal institutions are based on the idea that the distribution and limitation of public powers are necessary to maintain a proper balance between the governmental tendencies and the liberty of the individual. The principles of the law have become

adjusted in our legal system to this governmental idea, not merely through the experience gained under republican forms of government, but through the operation of causes acting upon the English common law connected with the establishment of parliamentary independence. Where constitutions of government are formulated by popular methods, as in the States of this Union, the function of distributing and limiting the powers of government is largely performed by such means, but under such political condition the embodiment of the principle in question in the administrative system demands the action of the ordinary legislative bodies.

The Constitution of the United States has left the application of the principle of distributing and limiting public power almost wholly to Congress, and it is a necessity of the rules of construction that the action of that body should be interpreted from the assumption that it intended to give efficacy to those principles.

That which is implied in the idea of the distribution and limitation of public powers is best recognized by contrasting that idea with its opposite, as embodied in highly centralized forms of government. In the latter class of governments the absolute dependence of inferiors in authority upon their superiors is a necessary condition and an historic fact. This relation among those exercising public authority is a necessity and a fact of military organization, and doubtless found its way into civil institutions from that historic source. Such governments represent the idea of lodging all authority and discretion in the personal sovereign, and reducing all governmental authority inferior to that to the condition of an agency under responsibility absolute, and solely to that head.

In contrast with the principle of centralized public authority we find systems in which an independent judiciary, and an independent legislative body exercise a different part of public functions without responsibility

to the executive head, and finally we find the function of forming the fundamental constitution of government as a prerogative of certain popular institutions. Such dispositions of the public authority refer the idea of sovereignty to the body of the nation, or strictly speaking, to the electoral body established under its laws, and transfer the responsibility of public agents to the aggregate sovereignty, to be administered by means of laws and constitutions of government. A government thus conditioned is familiarly termed a government of laws, as contrasted with one that depends upon the personal superiorities. As our Government is built upon the principles of distribution and limitation of public powers, it is manifest that our legal system is adjusted to that conception, thus these principles must be regarded as means of interpreting the legislative declarations.

If we examine the actual systems of administration prevailing in the National Government and in the several States, we find, as it regards the officers constituting together the executive function, that in certain respects they are independent of each other, having duties and authority prescribed by law, and responsibilities independent of any superior executive authority, while in other respects they are grouped in systems, in reference to executive superiorities and inferiorities. We find that officers charged with duties affecting the proprietary and fiscal interests of government, largely subjected to some central executive authority; that those who exercise judicial functions, are in the largest degree, independent, being wholly independent of the executive authority, and only subject to revisory action of a judicial nature where made so by law; and that those of officers that are created for the administration of the rights of individuals, such as sheriffs and marshals, as it regards the most important part of their business, registers and recorders of deeds, wills and the like, and notaries,

many others are almost wholly independent of supervisory executive control. We also find that where duties of these different classes are united in the same officer, his responsibilities differ as to the different classes. Thus a marshal of the United States in the performance of a judicial duty is independent of executive supervision, while as it regards his accountability for public property and money, he is subjected to such supervision; in the service of civil process he acts in the interests of those intended to be benefited by such process, and is only subjected to judicial authority; while in his action in criminal cases, he may in some instances be bound by the directions of the public prosecutor. It is unnecessary to instance the many cases of public office and duty to which what has just been said is applicable as common as well as judicial experience extend to familiarity with such facts.

It is obvious that these facts of governmental organization illustrate the principles of our legal system, and hence important inferences may be drawn from them bearing on the construction of statutes conferring and regulating the public authority, it is to this source that we naturally look for the fundamental presumptions that are the basis of such construction. It is consistent with the practice of government, as already indicated, that judicial authority should be regarded as in its nature exempt from executive supervision, as would be inferred from the fact that judicial and executive methods of administration differ in substance as well as in form. The inference would then be that where judicial authority and discretion is conferred by statute on any public officer all supervision of an executive nature would be excluded under a presumption arising from the nature of such authority, and this would be equally true where duties of judicial character are imposed upon officers whose general duties are of an executive character as well as where imposed upon strictly judicial officers, for it is the nature of the

particular duty that excludes executive supervision, and not merely the nature of the office concerned.

Following the principles just indicated if duties are imposed of an administrative character, and concerning public interests alone or principally, the presumption would be that if such duties were imposed upon a subordinate officer of a department of Government that such duties were intended to be performed under executive supervision, especially where questions of public property and fiscal matters are concerned. The means by which such a presumption may be rebutted will be considered hereafter.

It would also follow from the incidents cited that where public functions are devoted by law to ascertaining and establishing the rights of private citizens, the government having only an indirect interest as concerned to see that its subjects get the full benefit of that which is intended for them by the laws, the exercise of such function would be presumably exempt from executive supervision, and under responsibity in a direct sense to the judicial authority, as that authority is instituted to ascertain and establish the rights of individuals under the law.

It is upon this basis that the jurisdiction by mandamus at the suit of a private relator rest, the authority there exercised being regarded as supervisory in its nature.

It would then appear in a general form of statement that where official duties concern the public interests alone, and are of an administrative character they are presumably subject to executive supervision by the appropriate central executive authority, and where such duties relate to the administration of justice or in other respects concern principally the rights and interest of the citizen, the presumption is that they are free from executive supervision.

If we are permitted to describe the classes of powers indicated above as administrative, judicial and minis-

terial, which we submit is the true classification, it would then be proper to say that administrative duties are, presumably, subject to central executive control, while judicial and ministerial duties are not. But there would appear to be a difference in the nature of the respective presumptions in the cases of the judicial and ministerial duties, that difference consisting in the means by which they may be respectively rebutted.

If it was the intention of Congress to subject the performance of a judicial duty to executive supervision, it would be necessary that such intention should be expressly declared, or arise as a necessary implication from such declaration, in order to overcome the presumption against such an intention arising from the nature of judicial authority. If, on the other hand, it was intended that the exercise of public authority for the benefit of individuals alone should be made the subject to executive supervision, it is possible that such intention might be gathered as a reasonable inference from the law so as to overcome the presumption against such an intention.

It remains to be considered whether the principles thus indicated by our political institutions have received judicial recognition. That the view that has been presented of the judicial powers is that recognized by the courts is a matter of familiar observation, and needs no comment. The principle is universally recognized that where judicial discretion is lodged in any judicial officer, revisory power is excluded, except where conferred by statute, unless in cases to which the right of the superior courts to review by writ of error or appeal applies, that right being circumscribed by common law and by statute. The exclusion of such revisory power does not, however, preclude limited supervision by the superior courts intended merely to confine inferior courts to their proper jurisdiction, and to proceeding in a manner conformable to law.

The remedies that are afforded to individuals, where their legal rights are impaired, by the failure to perform ministerial duties, or by negligence in such performance, are in harmony with these principles. Where an officer, charged with public duties intended by law for the benefit of individuals, as means of ascertaining, establishing or securing their rights, and prescribed by law, fails to perform such duties, or negligently performs them, whereby the intended benefits of the laws are wholly or partially lost, the individual sustaining such loss may maintain an action for the wrong and injury incurred against the officer chargeable with such misconduct. As such redress would not always be adequate, and is, as a general rule, presumably inadequate, the courts having the proper jurisdiction compel the performance of such acts by *mandamus*. This judicial authority, although limited so as not to interfere with the exercise of any discretion, political, judicial, ministerial or administrative, that the officer may be entitled to exercise, implies that the proper supervision of such duties is with the judicial authorities, and this would exclude executive interference in such cases. Where, however, the statutes subject the performance of ministerial duties to executive supervision, the Courts refuse to interfere by mandamus to control the action of the subordinate officers, as occurs in the administration of the land laws of the United States as affecting the relations between the Commissioner of the General Land Office and the Secretary of the Interior.

It is not material to our case to demonstrate that in the case of purely administrative duties to be performed by subordinate officers of one executive department a presumption prevails that such duties are subject to supervision by the chief executive head, but if that necessity existed, such a demonstration could be readily afforded. The plaintiff in error is under necessity to establish such a proposition in much less qualified

terms than are here expressed in order to lay a foundation in reason for the objection offered to the judgment of the Supreme Court of the District of Columbia.

Assuming that such a presumption existed in the case of purely administrative duties in which public interests are alone, or principally concerned, there is an important exception to that rule recognized by judicial authority, and followed by the best practice of the departments of the Government.

Justice STORY states the ground of this exception in Martin vs. Mott (12 Wheat., 31), in the following language: "Whenever the statute gives a discretionary power to any person to be exercised by him upon his own judgment of certain facts, it is a sound rule of construction that the statute constitutes him the sole and exclusive judge of the existence of these facts." Whatever differences may exist as to the application of this language, it must be agreed that it contains the broad principle that where legislative authority designates a particular person, or the incumbent of a particular office, for the exercise of a certain authority or discretion, such designation must be regarded as presumably intending to localize that authority and discretion in a particular agency, and excluding their exercise elsewhere. It is as affecting the relations between official superiors and inferiors that this general proposition has its peculiar application. If authority and discretion are conferred upon an officer having subordinate officers acting under him, the principle in question would not exclude such subordinates from exercising, under delegation from their official head, such authority and discretion so long as the ultimate control over their exercise rests with the officer in whose name it is granted. In other words, the principle that localizes public authority in an exclusive sense, is consistent with the principle that administrative authority is capable of being delegated, provided

a directory and revising authority remains in the proper person designated for the exercise of such authority. If then it was the intention of the Legislature to subject all authority or discretion exercised by a subordinate officer of a department to the official head of such department, the natural and simple mode of expressing such intention would be to confer such authority or discretion on the head of the department or upon the department generally, and in that case, while its actual exercise might be by a subordinate, under delegation from his chief, full directing and revising power would remain in such chief. If then the Legislature departs from this general mode of communicating public authority, it must be regarded as having specific purposes in view as where a subordinate officer is named for the exercise of a particular authority and discretion, and that purpose is to be interpreted by the principle in question. In that case, the intention to localize such authority and discretion in an exclusive sense would be the proper consequence stated by Justice STORY, and the proper consequence of the broader principles, that it is by means of distribution and limitation of public powers that exact and responsible administration is to be attained.

The same principles are clearly involved in the judicial action enforcing the responsibilities of administrative officers. The remedies afforded in such cases show that the more limited the powers of a public officer and the more exact the definition of his duties, the more complete is the judicial authority over him in restraining excesses of authority in compelling the performance of duties, and in compensating the injuries done to the Government and to individuals by the abuse and neglect of such powers.

On the other hand, officers having the highest executive authority are clothed with such extended discretion, both of an administrative and a political character, that they are pratically uncontrolable by the

Courts. Where the exercise of public authority tends directly to interfere with or encroach upon, or is intended for the benefit of individual rights, it is obvious that good government demands that enlarged judicial supervision should replace political supervision, and this is a fact illustrated by the history of the growth of individual liberty. Where the interest of the community as an aggregate unity are alone concerned it is equally clear that responsibility to the chief political authority is consistent with good government, although responsibility to the judicial authority is in such cases largely practicable and desirable, as evidenced by the increasing tendency of legislation to secure such responsibility.' In view of these considerations the grounds of the proposition advanced by Justice STORY are apparent. By assuming that where the legislative authority designates a particular person or officer for the discharge of a particular public duty the strict localization of that authority was intended, force is given to the principles of distributing and limiting public authority so as to replace political by judicial supervision and thus to secure good government and the liberty and rights of the individual, while due respect is given to the plain declaration of the statute.

If it is reasonable to assume that the practice of the Government in its executive departments has been conformed to the opinions rendered by the Attorneys-General for the government of the departments then it may be readily shown that the principle propounded by Justice STORY, as above stated, and the construction that is here put upon his utterances has had a controlling influence over the course of administration. The construction of the act creating the authority of the accounting officers of the Treasury Department brought this general question before the Attorneys-General and elicited contradictory opinions. The law declared that the action of the accounting officer should be final and conclusive. As early as 1823 Attorney-General Wirt,

held that the action of the accounting officers bound the President. The proposition submitted by him (1 Opinions Attorney-General, 624) was as follows: "If the laws then require a particular officer by name to perform a duty, not only is that officer bound to perform it, but no other officer can perform it without a violation of the law, and were the President to perform it he would not only be not taking care that the laws were faithfully enforced, but he would be violating them himself." This was holding that the constitutional requirement that the President should take care that the laws were faithfully enforced, was consistent with the principle that Congress has authority to confer upon public officers powers of so exclusive a nature that even the President cannot control their exercise, and is to be presumed to have so intended where an officer is named for the exercise of such powers. That the practice of the Government has been conformed to this view, at least, since that date is presumable from the fact that none of the later opinions of Attorneys-General have called it in question, but on the contrary have assented readily to its correctness. Attorney-General Taney, in 1832 (2 O. A. G., 507) sustains the same conclusion, holding that the decision of the accounting officers were conclusive as it regarded the executive departments, thus applying to the heads of departments the same principles that had been applied by Wirt to the President. It would seem that if the Constitutional powers of the President formed no exception to the operation of the principle in question that the heads of departments would be affected as it regards their power to revise the action of officers designated by law as the proper ones to perform particular official acts, and yet Attorney-General Crittenden held in 1852 (5 O. A. G., 630), that the powers conferred upon the accounting officers were subject to revision by the several secretaries in their respective departments, while assenting to the conclu-

sions of Attorney-General Wirt that the President was excluded from such authority under like circumstances. The argument in favor of this conclusion was based on the idea that it was essential to good government that all the executive authority and discretion of the Government should be assigned for ultimate exercise in the heads of departments, otherwise the undignified spectacle would be presented of a superior in authority bound by the action of his subordinate, forgetting that that argument would apply with still greater force where the President was denied an authority that was recognized as existing in his constitutional advises.

The conclusions of Attorney-General Crittenden followed by several of his successors were reversed by Attorney-General Browning in 1868, who held the contrary, stating as the reason of this change of practice, that it had been rendered necessary by recent judicial decision. That judicial decision has not been found, but in the same year an act was passed (15 Stat. 54) declaring the interpretation intended by the former act in conformity with the construction put upon it by Attorneys-General Wirt and Taney, indeed in the language of their opinions.

We submit that section 481 should be interpreted and construed with the legislation fixing the powers and duties of the Commissioner of Patents and the appellate tribunal in harmony with the presumptions that have been stated. The result of the application of these presumptions to this construction would be:

FIRST. That wherever duties involving the exercise of judicial powers are imposed by statute upon the Commissioner of Patents the directing power conferred upon the Secretary of the Interior should be excluded as inconsistent with the nature of such powers, and that the presumption upon which that exclusion rests cannot be overcome, unless elsewhere in the statute appears a declaration to the contrary, or unless its neces-

sary inference is that such directing power should exist.

SECOND. That wherever duties are imposed upon the Commissioner of Patents intended to ascertain, establish or secure the rights of individuals under the patent laws such directing authority should be excluded, unless the contrary appears as the fair and reasonable construction of other parts of the statute.

THIRD. That wherever duties of an administrative character are imposed upon the Commissioner of Patents by the name of his office that such directing authority of the Secretary is excluded, unless in other respects the contrary appears to be the fair and reasonable intention of the statute.

The proper consequences of these propositions apply only to official acts performed by the Commissioner of Patents within the scope of his authority, and in a manner conformable to law, for if any act is performed by him without authority of law it is beyond the protection of the principles that only confer immunities upon official action where proceeding from the authority of the statutes.

Section 481 of the Revised Statutes is a re-enactment, in substance, and to a large extent in form, of the first section of the Act of July 4, 1836 (5 Statutes, 117), it is important that its intended force should be traced in that act. The language of section 1 of the Act of 1836 is as follows: After establishing the office of the Commissioner of Patents, this section provides "whose duty it shall be, under the direction of the Secretary of State, to superintend, execute and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions and improvements as are herein provided for, or shall hereafter be by law directed to be done and performed, and shall have charge and custody of all the books, records, papers, models, machines and all other things belonging to said office."

Section 7 of the Act of 1836 specifies the duties of the Commissioner of Patents as follows: "The Commissioner shall make or cause to be made an examination of the alleged new invention or discovery; and if on any such examination it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor." This section then makes it the duty of the Commissioner to give to the applicant notice, with references, where he holds that the applicant is not the original and first inventor, or where any part of that claimed as new had been published or described in any printed publication in any country, or where the description is defective or insufficient. It then permits the applicant to withdraw his application or to amend. The section then provides as follows: "And if the specification and claim shall not have been so modified as in the opinion of the Commissioner shall entitle the applicant to a patent, he may on appeal, and upon request in writing, have the decision of a Board of Examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom, at least, to be selected, if convenient and practicable, for his knowledge and skill in the particular art, manufacture or branch of science to which the alleged invention appertains." The board is required to be under oath "for the faithful and impartial" performance of the duty imposed upon them by the appointment. They are to have before them the decision of the Commissioner, stating "the particular grounds of his objection and the part or parts of the

invention which he considers as not entitled to be patented." They are to give notice to the applicant and to the Commissioner, "that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision." The board, or a majority of them, may revise the decision of the Commissioner in whole or in part, and their opinion being notified to the Commissioner he shall be "governed thereby" in further proceedings.

It is observed that all the duties relating to the ascertainment and establishment of the rights of individuals under the patent laws are here imposed, personally, upon the Commissioner, to be performed by him or by persons under his direction and control. The duties of examining, deciding and issuing patents are thus imposed upon the Commissioner by name. The authority to revise the decisions of the Commissioner is imposed upon a board appointed by the Secretary of State. The functions of the board are clearly judicial; *first*, as a consequence of the peculiar organization given to it by the statute, according to which it is bound to hear and decide according to the allegations and proofs of the parties, such parties being the applicant on the one hand and the Commissioner on the other; and, *second*, in consequence of the nature of its duties, which were to ascertain and establish the rights of applicants to patents under the patent laws by ascertaining the existence of the conditions upon which such rights legally depended.

As section 1 must be read with section 7, the directing authority of the Secretary of State conferred by the former must be reconciled with the specific authority conferred upon the Commissioner and the jurisdiction of the Board of Examiners. As the directory power of the Secretary of State is conceived in general terms and the authority of the Commissioner and of the board is conferred in specific terms, the former must give way if an inconsistency appears between

them. It is obvious that the functions of the board would be senseless if its conclusions were liable to be set aside by the Secretary of State, and the appointing power of the Secretary of State was conferred on the assumption that, being impartial himself as to the merits of applications, he would be apt to constitute an impartial tribunal. If, however, the Secretary of State could direct the Commissioner as to the performance of duties that might come before the Board for revision, his control over the organization of the board would render the whole system unbalanced and senseless. It is clear that the whole power of revision, as it regarded the decisions of the Commissioner upon the merits of applications for inventions, was exhaustively lodged in the Board of Examiners, and that the existence of such means of revision was inconsistent with the right of the Secretary of State to direct the Commissioner in what manner his duties should be performed or to revise his action.

Although under the existing laws the Board of Examiners, as a tribunal superior to the Commissioner, is abolished, and the appellate authority in such cases is that of the Supreme Court of the district, the force of what has been drawn from the Act of 1836, is not diminished by the allowance of an appeal to the Court from the Commissioner, as a declaration that the decisions of the Commissioner should receive judicial revision, necessarily displaces executive supervision.

Having noticed the origin of the provisions of section 481, it is important to consider the objects that were contemplated by it, and such objects are intimately connected with those that run throughout the whole scheme of the patent laws, so that the general purposes and specific features of that system need some consideration.

Section 483 gives a key to the most important object of the provisions of Sec. 481, and is as follows: "The Commissioner of Patents, subject to the approval of

the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office." This section confers upon the Secretary of the Interior authority of a directing nature, although of a limited character. Inasmuch as *revision* is a specific limitation of the generic term *direction*, the authority conferred is distinctly directory. It is limited specifically, inasmuch as it is confined to the revision of that which the Commissioner has the authority to perform in the first instance, and to revise in the limited form of approval or disapproval. The regulations derive their authority from the Commissioner of Patents, who is authorized to *establish* them, although force may be denied to them through an act of disapproval on the part of the Secretary. Important inferences are to be drawn from this arrangement of the relative authority of the Secretary and the Commissioner.

The directory power is naturally both authority to make regulations for the government of all cases or of certain classes of cases, and to ultimately dispose of individual cases. The power to adjudicate particular cases implies that of making regulations affecting classes, but the power to make general regulations, specifically granted, does not imply authority over particular cases. If the statute intended that the secretary should exercise the whole authority and discretion involved in the duties imposed by the patent laws it would doubtless have given him the full power to frame the regulations under which such power should be exercised. In conferring that power upon the Commissioner as an original power, and confining the action of the Secretary to the mere approval or disapproval of that performed by the Commissioner, it has afforded clear proofs of an intention to deny to the Secretary that which is here claimed as the proper measure of his authority under section 481.

We submit that the object of section 481 as it re-

gards the power intended to be exercised by the Secretary is made clear by section 483 and section 4883, that requires all patents for inventions to be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents. Under the authority to approve or disapprove regulations affecting the conduct of the officers of the Patent Office, and applicants having business before that office a substantial control is secured to the Secretary over the general course of administration, and through the fact that the action of the Commissioner in issuing patents depends for its efficiency upon the signature of the Secretary, that may be withheld, the means are afforded to the Secretary of arresting any proceeding that in his judgment is violative of the law. This is all the control over proceedings involving the rights of individuals under the conditions of the patent laws that should, in the nature of things, be lodged in an officer clothed with large discretionary powers of a political character, so as to be beyond the reach of the authority of the Courts, except in a very limited degree.

The view just stated renders it possible to account for the provisions of section 487. That section gives the Secretary appellate power in the case of a decision of the Commissioner depriving a person of a right to practice in the Patent Office as an agent or attorney. If the statute had intended to repose general authority or revisory power in the Secretary, and especially if it had intended to confer a directory power over all the actions of the Commissioner, this section would not only have been meaningless, but as it tended to imperil the proper interpretation of the text, absolutely hurtful. If the view is adopted that the authority of the Secretary was intended to be limited, as it regards a general control over the course of business to disapproving the regulations established by the Commissioner, and as it regarded action in individual cases by withholding the signature from patents, then this

section has a distinct and important function in creating an exception to that state of authority in the instance to which that section relates by conferring on the Secretary appellate power over judgments denying to persons the right to practice in the Patent Office as agents or attorneys.

As clear as it appears from the sections that specifically relate to the Secretary of the Interior that his powers are limited in the manner already stated, it will appear still more clearly when the nature and measures of authority conferred by the statutes upon the Commissioner and the Supreme Court of the District are considered.

Sec. 4886 confers upon inventors and discoverers of matters related to the arts the right to a property in their inventions for a limited term of years upon certain conditions fixed by the statutes; and the right of letters patent evidencing such proprietary right. The conditions upon which this right depends are such that their existence is properly ascertainable by proofs general and special. To ascertain the rights of an individual under law and upon evidence is a judicial act.

Authority to perform this judicial act is conferred upon the Commissioner of Patents by his name of office; he is required to examine and ascertain whether the applicant is "justly entitled to a patent under the law." It is obvious that the Commissioner is required to construe the law and determine all questions of fact arising under it, upon proper proofs, under the ordinary rules governing evidence, and this exhibits the judicial nature of his action.

Sec. 4905 authorizes the Commissioner to "establish rules for taking affidavits and depositions in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the

Courts of the United States or of the State where the officer resides."

Secs. 4906, 4907 and 4908 provide for subpœnas, the fees of witnesses, the mode of service, attendance and testifying and for contempts for disobedience of subpœna.

The sections enumerated, and various others, indicate a mode of procedure that is recognizable as judicial. We submit that the powers of the Commissioner, of which the defendants in error here claim the benefit, are of a judicial nature, and, as such, they are inconsistent with the existence of any supervisory control over them under the general authority of the Secretary of the Interior.

While in its general scope the office of the Commissioner of Patents is of a ministerial character the functions of that office in determining the right of an individual to a property in his invention are essentially of a judicial nature as involving the ascertainment on proofs general or special, of the existence of the conditions on which such right depends; and although the proceeding is, in its most general character, *ex parte*, it is not thereby deprived of its judicial character, proceeding, as it does, according to allegations and proofs under the commonly received forensic rules. Such a function, by its nature, excludes all supervision except that in the appellate form, and excludes appeal unless given specifically by the statute.

If the judicial character of the question presented by *ex parte* cases, in the Patent Office, is recognized, much more clearly must that judicial character appear when, as in the present case, the question was that of interference between an unexpired patent and an application claiming for the same invention. The question of the priority of invention, presented in such a case, involves a conflict of individual claims to the right of property merely. The declaration of an interference implies that the Commissioner is prepared to issue a

patent whenever the relative merits of the claims of the opposing parties are adjudicated and thus that an adjudication in interference is the adjudication of the relative rights of individuals apart from any question of disputed public authority or public interest. It is clear that such a question is judicial in its nature.

We do not deem it necessary to invite the attention of this Court to the many instances in which it has by its declaration and action characterized such questions as judicial, for the general fact that the decisions of the Patent Office upon the rights of the inventors are re-examinable in the Courts shows that they are of a judicial nature, and a vast and valuable body of law depends upon such fact.

The nature and measure of the appellate power conferred upon the Supreme Court of the District of Columbia in cases originating in the Patent Office show that the limitations of the authority of the Secretary of the Interior, are within the intention of the statute. That appellate power is commensurate with all the decisions of the Commissioner affecting the rights of individuals to patents for inventions, is of a judicial nature, thus excluding executive supervision, and is constituted as systematic means of revising the action of the Commissioner where individual rights are involved, that is inconsistent with the exercise of directive power of the Secretary even in the limited form of revision.

The first proposition to be examined is that the appellate authority of the Supreme Court of the District includes all decisions affecting individual rights made by the Commissioner, and this includes the decision which it is alleged in this case, the Secretary has sought to revise upon appeal.

Sec. 4911 gives, in all *ex parte* cases to an applicant who has by the decision of the Commissioner been denied a patent, the right of appeal to the Supreme Court of the District. This right of appeal is by the

same section denied to a party to an interference. A judicial remedy is afforded by a bill in equity to all applicants whose claims are denied by the Commissioner or the Supreme Court of the District under the provisions of Sec. 4915, which provides that on refusal of a patent either by the Commissioner or by the Supreme Court of the District, a bill in equity may be filed "and the Court, having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts of the case may appear." It also provides that such decree shall "authorize the Commissioner to issue such patent" on the filing of such adjudication.

In this section no exception is made in the case of parties to interference, and the general language of the section embraces such cases. As such questions are those of contested individual right the reason for sending them to a tribunal possessed of full judicial power, in the first instance, is obvious. In *ex parte* cases where only the government and the applicant are the contesting parties, the limited means afforded by appeal to the Supreme Court of the District are amply sufficient, but when the contest is between individuals and rests upon complicated proofs, the propriety of referring it to a Court of such general power is obvious.

It is apparent that the proceedings in equity authorized by section 4915 are in the nature of an appeal from the Commissioner to the Supreme Court revising his decision. The Court merely determines the right of the applicant to a patent, and its decision has no other effect than furnishing authority to the Commissioner for the issuing of a patent; as this jurisdiction merely guides the functions of the Commissioner, it must be regarded as part of the means for establishing the rights of parties under the patent

laws to the evidences of right intended to be afforded by those laws, and is thus a revisory action under those laws.

Section 780 of the Revised Statutes relating to the District of Columbia describes the jurisdiction afforded by Sec. 4915 as appellate. The language is: "The Supreme Court shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents in accordance with the provisions of Sec. 491 to Sec. 4915 inclusive." As no appellate proceedings are mentioned in Sec. 4915, other than such as are afforded by bill in equity, as above stated, it was clearly the intention of the language cited to include that jurisdiction among the modes of appeal from the decisions of the Commissioner.

It appears, then, that the statute has supplied a judicial remedy co-extensive with the right of the Commissioner of Patents to hear and determine the rights of applicants under the patent laws, and has thus indicated a purpose to exclude executive supervision and direction in such cases, as inconsistent with both the nature of judicial powers and the functions of an appellate judicial tribunal.

It is evident that the specific means afforded by the patent laws for the revision of the decisions of the Commissioner in the Courts were intended to form a system full and complete in itself, by means of which the errors of the Commissioner might be corrected, and the existence of such a system of remedies excludes all other remedies and especially those of a nature opposite to judicial remedies, such as executive revision. If the Secretary of the Interior possessed the revisory power contended for, it would have to be regarded as a general remedy, inasmuch as it is unlimited both as it regards cases falling under it and the mode of proceedure demanded by its exercise; on the other hand the appellate means afforded by the statute are limited and

adjusted to the respective classes of cases to be provided for and are thus specific remedies. Under the principles laid down by the Court in Nicholls vs. U. S. (7 Wall., 122), such specific remedies have the effect to exclude general remedies pending upon different conditions.

It will be observed that in sections 4911 and 4915, granting appeals in patent cases, as well as in Sec. 780 of the statutes relating to the district, regulating the appellate powers of the Supreme Court of the District, such appeals are only granted from the decisions of the Commissioner and of the Supreme Court of the District, and no mention is made, or provision furnished, for the case of a decision made by the Secretary of the Interior. It is to be concluded that it was not intended by the statute that the Secretary should exercise revisory power, at all events, as it regarded the cases supplied with remedies in the Courts by means of direct appeal or bill in the nature of an appeal. If the effect of the statute had been to leave in the hands of the Secretary full power to revise and modify the decisions of the Commissioner, then as no appeal from the Secretary is supplied, it would have to be concluded that both modes of revision were intended to exist together, but that is impossible as contradictory of first principles, inasmuch as one system appertains to the judicial power and the other to the political power, that habitually act from different principles and according to different methods.

Looking at the system established by the patent laws as a whole, as well as its several parts, conclusions must, we submit, be drawn fatal to the claims of the plaintiff in error. It is evident that the idea of those laws was to create a certain kind of property in certain persons under certain conditions, and to afford official means of ascertaining the existence of such rights under the laws and affording evidences of such right capable of vesting in the persons to

whom they are allowed a presumptive title to such right of property. The power of ascertaining officially the existence of such rights was moulded to express a judicial nature and surrounded by the checks characteristic of judicial procedure. This idea of a special judicial procedure has become embodied in the actual working operations of the Patent Office, and constitutes its most valuable feature; and in the degree that this idea has prevailed in practice has the system advanced toward perfection. The judicial feature of the patent system of the United States renders it as impartial as the systems that allow to the inventor a patent for whatever claim he may support by his oath, while possessing superior advantages over the last named systems, both as enhancing the value of patent property and affording security to the public against unjustifiable claims by inventors. The official scrutiny that claims to patents undergo, both enables the inventor to shape his claims by the light thrown upon them by the labors of a skilled and learned class of experts and brings to light that which is needful for the protection of the public, while the judicial form of the investigation assures that impartiality that is due to both the inventor and the public. This institution to which our country is largely indebted for the measure of its industrial and scientific progress, and which has done much to solve the problem of harmonizing the conditions of skilled and educated labor with the conditions of successful competition with countries where an inferior class of labor exists, and promises aid to the full solution of that question in the near future, should receive protection in its most valuable feature. The judicial administration of the patent laws is its most valuable feature.

Until a recent period the political authority of this country has not attempted to disturb the operations of this judicial system. As late as 1876 Secretary Chandler declined to interfere with the orderly operations

of the Patent Office by assuming a revisory authority over the decisions of the Commissioner (Decisions of the Secretary of the Interior in Edison vs. Harrington, March 8, 1876) and assigned as a reason for his action the established practice of the Department and the unsuitable character of that mode of revision. The first claim made by the Secretary of the Interior to the exercise of such a jurisdiction was made in the year 1881. So far, then, as the practice of the office can add weight to the present argument, it is entitled to all the force that long practice can afford.

The Secretary of the Interior is a high political officer of the Government, made by the Constitution an advisor of the President in all matters of executive policy (Const. U. S., Art. II., Sec. 2). His administrative capacity comes from the Acts of Congress. He can possess no judicial authority unless conferred upon him by Acts of Congress, as such authority is not implied in his constitutional character of an adviser of the President. No attempt has been made in behalf of the plaintiff in error to point out any grant to the Secretary of judicial authority relative to the disposition of matters arising in the Patent Office, and none of that character exist. What is claimed for him is executive power of the directive character. His office differs from that of the Commissioner of Patents by the fact that the former is chiefly concerned with matters touching the public interest, while that of the Commissioner has to deal with the rights of individuals, either judicially or ministerially. To allow the decisions of the Commissioner to be unsettled by authority of the Secretary is to commit individual rights to the protection of the political authority. The personal character of the Secretaries is no safeguard against the evils of such a system. Its principles being bad, its fruits must correspond. In the Patent Office a well balanced system under the control of trained, scientific and judicial

minds, is applied to the solution of such questions. In the office of the Secretary no such system does or can prevail. Officers dealing with all the complicated questions presented to that department, including those relating to the public lands, the Indian tribes, the pensions and the administration of different classes and kinds of public institutions, must find such leisure as they can to revise the action of the Patent Office. To cast the elaborate decisions of the Patent Office into the troubled sea of a great political office, with the expectation that they will emerge better in substance and form, is a vain imagination. However much the Secretaries may try to prevent this result, the necessary consequence of the system would be that the most influential and wealthy class of inventors would derive all the profit to be obtained from it, and the poor inventor would in the end be the loser.

But even if the Secretary should succeed in neutralizing the evils of a subverted system by the weight of personal qualities, the volume of business transacted in the Patent Office would overwhelm the revisory authority and destroy the system. Unless Congress should duplicate the Patent Office system, placing one of its branches in the office of the Secretary of the Interior, or create a judicial tribunal within that office, the evils that have been pointed out could not be averted.

But apart from the fact that the duties of the Commissioner brought into view by the present case are of a judicial character, there are other reasons, already noted, why such revisory authority as is contended for in behalf of the Secretary of the Interior should not exist. In view of these reasons we submit that the nature of the functions of the Commissioner implies an independent authority and discretion, as it regards that class of his duties that consists in the establishment of individual rights in inventions.

The powers and duties conferred upon him were

primarily intended to constitute means by which individuals might acquire a property in their inventions by affording them a jurisdiction capable of hearing and determining the existence of the conditions upon which the acquisition of such rights depend, and thus characterize such office as ministerial in its general nature; and although administrative functions, in which the public are directly concerned, are superadded to those of the ministerial class, they must be regarded as incidents of a function of a general ministerial character.

So far as the functions of the Commissioner of Patents relate to the ascertainment and establishment of the rights of individuals under the patent laws, and are thus of a ministerial nature, they are beyond the sphere to which the supervisory powers of the Secretary of the Interior were extended by the statute as not involving the administration of direct public interests, and can only be subjected to the authority of that officer by the specific provisions of the statute.

To this we would add a proposition already considered that the statute having conferred upon the Commissioner of Patents by the name of his office, specific duties and jurisdictions, it is to be presumed that the intention was to limit the general supervisory authority of the Secretary of the Interior by the creation, in the Commissioner, of an independent authority and discretion, unless it appears that the statute has elsewhere subjected such authority and discretion to the control of such directing or supervisory authority.

We submit that it must be concluded that the attempt of the Secretary of the Interior in the present case to exercise revisory authority over the decision of the Commissioner upon the matter of interference between Gill and Scott, was without authority of law, and the decision of the Commissioner was final and conclusive of the matters in controversy.

It remains to consider whether the right of Gill and

his assignees to receive the patent, as established by the decision of the Commissioner, was in a condition that authorized the Supreme Court of the District to issue its writ of mandamus to compel the performance of the acts necessary to the issuing of a patent. The precise question is that made by the petition, rule to show cause, and the return of the Commissioner. We submit that the view taken of the return in the elaborate opinion of the Supreme Court of the District is well warranted. [See copy appended.] That court concluded, as the effect of the return, that the Commissioner, out of deference to the opinion and action of the head of his department, and for no other reason, had declined to issue the patent as demanded by the assignees of Gill; that inasmuch as no such authority legally existed as that attempted to be exercised by the Secretary in arresting the action of the Patent Office on Gill's application, the reason assigned for withholding Gill's patent was not valid. The return is in effect, and indeed in form, a submission of an important question of jurisdiction about which difference has arisen between two important officials to the only authority capable of finally adjudicating the matter. The Commissioner in his return seeks to remove all technical difficulties that could by possibility interfere with the solution of the question upon the relators' demand for a mandamus. He negates the idea that the application is held for further examination or advisement, and by language as clear as could be employed, making the validity of his refusal to issue the patent to the relators to depend upon the legality of the jurisdiction assumed by the Secretary of the Interior. It appears, then, by the record, that a ministerial act has been withheld in a case where it should have been performed—the reason of its non-performance appearing distinctly insufficient in law.

It would seem that the propriety of issuing the mandamus was undoubted; but it has been argued that in no instance can a mandamus issue against the Com-

missioner of Patents to compel the steps necessary for the issuing of a patent, for the reason that the Commissioner has the right, at any moment before actually issuing the patent, to institute proceedings for the further examination of the claim of the applicant; and therefore it can never be said, at any moment before the issuing of a patent, that the discretion of the Commissioner is exhausted. While we do not dispute the authority of the Commissioner to institute a reëxamination of the right of an applicant at any moment before the actual issuing of a patent, we submit that the naked fact that he possesses such a right is not a sufficient excuse in law for refusing to issue a patent where the right of an applicant has been established by the full use of all the statutory means pointed out for the ascertainment of such right; we contend that to make that right of revision by the Commissioner available, after all the usual steps have been taken and the decision of the Commissioner rendered in behalf of the applicant, it must appear that the right of reëxamination has been exercised with the effect of ascertaining that the right of the applicant does not exist, or that it is in course of exercise, or at the very least that the Commissioner believes that good ground exists for such reëxamination and that he intends to exercise such right of reëxamination. The effect of this position would be that where a decision in the ordinary course has been rendered in the final form in behalf of an applicant, and the patent is withheld without other just reason than that under consideration, an applicant may have his rule to show cause by mandamus putting the Commissioner to his return. In that case, unless the Commissioner sets forth in an available form his right to reëxamine in the case, a peremptory mandamus should issue. If the Commissioner refuses to either issue a patent or reëxamine, the Court could compel him to proceed, while it could not control or revise the exercise of his discre-

tion in accordance with principles familiar to the practice of the Courts in such cases. As the results of such a reëxamination are appealable in the usual manner to the Supreme Court of the District, it is the right of the applicant to have the case proceed to a final decision before the Commissioner, and for that end to apply for a mandamus to compel such procedure. When the Commissioner merely remains inactive after a final decision in favor of the applicant the only practicable means of securing judicial aid to compel action is by a mandamus to compel the issuing of the patent. If in such a case where the Commissioner had not in any way indicated an intention to reëxamine the case, the applicant should demand a mandamus to compel proceedings, by way of reëxamination, the Court would necessarily refuse the writ upon the ground that the Commissioner had full discretion to determine whether he would or would not proceed to reëxamine. If on the other hand the issuing of a patent is sought to be compelled by mandamus, the Commissioner would be put to his return, and thus compelled to indicate his intentions. When by the return of the Commissioner it appears that he intends to reëxamine, such record evidence would afford ground, in a subsequent proceeding, to compel the reëxamination to proceed in what might be judged to be a reasonable time. The convenience of the practice indicated is manifest, and it remains to be seen whether it rests on a sufficient basis in the law.

The power to reëxamine a case after a final decision by the Commissioner is nowhere given by the statutes in express terms, and if it exists is the result of an inference drawn from the act, not as a necessity of its effectiveness, but as a reasonable conclusion from its provisions. If the existence of such authority depends upon reasonable implication then there are no difficulties in the way of subjecting it to such conditions as are essential to its proper exercise. It is clear that

the power of reëxamination is not unlimited. If the decision of the Commissioner has been examined on appeal by the Supreme Court of the District, or by bill in equity, and the right of the applicant fixed as to certain grounds of claim, reëxamination for the purpose of changing that result cannot be claimed as a reasonable implication from the statute. It certainly would be a reasonable construction of the right of reëxamination to hold that the legal right of an applicant to a patent, after final decision in the ordinary course, in his favor, could not be taken away until the Commissioner had exercised his discretion in the matter to the extent, at least, of determining that the case demanded reëxamination.

The statute contemplates in express terms only a single examination by the Commissioner, at the end of which, if he decides in favor of the applicant, the patent must issue, while if he decides against the right of the applicant the case may go from him to an appellate jurisdiction to be finally decided. Although that examination should, in certain instances, embrace two rejections of the applicant's claims, it is none the less a single examination although affected by the applicant's power of amendment. The right to reëxamine is derived by analogy to the right of certain Courts to grant new trials. Clearly, a Court having rendered a judgment, and possessing authority to intercept that judgment by an order for a new trial, is bound by law to grant either execution upon its judgment, or a new trial, and if it is subject to a competent jurisdiction it may be compelled by mandamus so to do; there is no reason why the analogous right of the Commissioner, assuming it to exist, should not be subjected to the same reasonable limitation.

The conclusions already stated are equally clear when considered from the standpoint of the rules governing the remedy of mandamus. That remedy when

prosecuted by a private relator is intended to apply to all cases where an act of public authority is required by law to be performed for the benefit of an individual, as appears by the comprehensive and clear definition in the case of the Board of Liquidation vs. McComb (72 U. S., 531). The duty of the Commissioner of Patents to take steps for the issuing of a patent after the right of the applicant is ascertained is a duty due to the right of the applicant, and as such is the proper subject for the writ of mandamus. It is true that the Courts cannot control the exercise of any discretion properly exercisable by the Commissioner, but when that discretion has been fully exercised nothing remains but the ministerial duty of issuing the patent. Assuming that the Commissioner has authority to determine at any stage of the proceedings whether reexamination is demanded, it is inconsistent with the whole theory of the remedy by mandamus that that right should, without any exercise, stand as a perpetual bar to any remedy to compel action, and thus have the effect of permitting the Commissioner to remain permanently inactive. It is a view of the case more consistent with the idea of right to the applicant that unless the Commissioner chooses to exercise the right of reëxamination he should stand charged with the ministerial duty of issuing a patent, and, if he enters upon such reëxamination, that he should be responsible to the courts for proceeding in its exercise in a reasonable manner. As the remedy by mandamus at the suit of a private relator implies the right of individuals to judicial means of compelling the performance of public duties intended by law for their benefit, the conclusions that have been stated are clearly deducible from the practice relating to mandamus.

We submit that the judgment of the Supreme Court of the District of Columbia brought here by writ of

error in this case is free from error and should be affirmed.

Appended hereto is an argument made by my colleague, M. B. Philipp, in the Court below, which is herewith submitted for the consideration of this Court.

A. J. WILLARD.

Supreme Court

OF THE DISTRICT OF COLUMBIA.

THE UNITED STATES OF AMERICA, EX REL. RICHARD M. HOE ET AL.,

AGAINST

BENJAMIN BUTTERWORTH, Commissioner of Patents.

Argument of M. B. Philipp for Relators, on Motion for Writ of Mandamus.

MAY IT PLEASE THE COURT:

There are two suggestions made by the opposing counsel outside of the question at issue here, which I desire to answer before going into an argument as to the construction of the *lex scripta* to be considered here.

The first is as to the desire of the Secretary of the Interior to have the question involved in this proceeding decided, and his relations toward the Commissioner of Patents. Believing from what was intimated yesterday that something would be said as was said here to-day respecting this matter, I called with the Commissioner of Patents, upon the Secretary of the Interior this morning, and questioned him regarding the same. He said that he had never looked into the question himself, but had simply read the opinion of the Attorney-General

given to Secretary Kirkwood, and had followed the action of the latter; that he desired very much to have his question considered and determined by this Court; that the novel spectacle had been presented to him, since he had become secretary, of attorneys appearing before him contending for the jurisdiction here in question, in one case; and the same attorneys in another case arguing that he had no such jurisdiction; that there was no controversy between himself and the Commissioner of Patents about this matter.

The second suggestion is as to the character of the decision of the Commissioner of Patents adjudging Gill, one of the relators, to be the first inventor as against Scott in the interference between them.

I had no idea that this subject could, or would, be gone into in this proceeding, as the records of the two parties are not here, and its discussion would be entirely outside of any question raised by the petition for the writ of mandamus and the return.

To remove from your Honors' minds any impression that may have been made by what the opposing counsel has stated as to the decision of the Commissioner of Patents in favor of Gill, being unwarranted by the law, I desire briefly to consider the matter. The facts are these: Gill made the invention in that interference early in the year 1880, and at once embodied it in practical working machines of costly construction, some fifteen of which were introduced to the public and sold in New York City before December 21st, 1880. Scott, with whom Gill was in interference, in January, 1881, after these machines were publicly made and sold in New York City, where he was then employed, applied for a patent to cover the devices of these machines, and obtained it while the relators were building these machines. Scott's patent was granted March 8, 1881, and within four days thereafter Gill's application was filed for the same invention. On behalf of Scott, a drawing made by him in 1874, illustrating the invention, was relied upon to prove that he was the first inventor.

He had, however, done nothing between 1874 and January, 1881, in the way of making a machine containing this invention, although employed by a printing establishment where such machines were used, and by manufacturers of such printing machines. He rested solely upon the making of this drawing in 1874.

These are substantially the facts that the Commissioner of Patents had before him when he was called upon and did decide the question of priority of invention in favor of Gill. The question on these facts was, whether Gill or Scott was the first inventor.

Your Honors will recollect section 4920 of the Revised Statutes, with reference to what may be set up as special matter under the general issue, which is as follows:

"That he (the patentee) had surreptitiously or unjustly obtained a patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same."

This language was also used in section 15 of the Act of 1836.

Under this law many controversies have arisen respecting the question of priority of invention. Judge Story, as far back as 1841, in the case of Reed against Cutter, reported in 1 Story, page 590, laid down the principle derived from this law in relation to the relative rights of two inventors under the circumstances that existed in this interference, where the question of priority was to be determined, as follows:

"In a race of diligence betwen two independent inventors, he who first reduces his invention to a fixed positive and practical form would seem to be entitled to a priority of right to a patent therefor. The clause of the fifteenth section, now under consideration, seems to qualify that right by providing that in such cases he who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has, in fact, first perfected the same and reduced the same to practice in a positive form."

In the case of Reeves against The Keystone Bridge Company *et al.*, reported in 5th Fisher's Patent Cases, page 456, it became necessary for the Court to determine whether the illustration by a drawing of an invention was a reduction of such invention to practice

in a positive form, such as the law required and such as Judge STORY referred to in the language I have quoted. The Court, after referring to the decision of Judge STORY, said:

"'Can an invention be considered as 'perfected and adapted' which has reached only the maturity of an illustration on paper? In White vs. Allen, 2 Fisher, 446, Judge CLIFFORD says: 'Original and first inventors are entitled to the benefit of their inventions if they reduce them to practice and seasonably comply with the requirements of the patent laws in procuring letters patent for the protection of their exclusive rights. While the suggested improvement, however, rests merely in the mind of the originator of the idea, the invention is not completed within the meaning of the patent laws; nor are crude and imperfect experiments sufficient to confer a right to a patent; but, in order to constitute an invention in the sense in which that word is employed in the patent act, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. (Gaylor vs. Wilder, 10 How., 498; Parkhurst vs. Kinsman, 1 Blatch., 494; Curtis on Patents, Sec. 43). Mere discovery of an improvement does not constitute it the subject matter of a patent, although the idea which it involves may be new; but the new set of ideas, in order to become patentable, must be embodied into working machinery and adapted to practical use (Sickles vs. Borden, 3 Blatch., 535).'

"And in Ellithrope vs. Robertson, Law's Dig., 428, section 48; 2 Fisher, 83, Judge INGERSOLL said:

"'The making of drawings of conceived ideas is not such an embodiment of such conceived ideas into practical and useful form as will defeat a patent which has been granted.'

"Equally strong is the language of Mr. Justice NELSON in Winans vs. Harlem R. R. Co., Franklin Journal, 3 Ser., Vol. 61, p. 322, where he says:

"'The circumstance that a person has had an idea of an improvement in his head, or has sketched it on paper, has drawn it and then gives it up, neglects it, does not in judgment of law constitute or have the effect to constitute him a first and original inventor.'

"Numerous other cases affirm the same doctrine; and it must therefore be considered as an established rule that illustrative drawings of conceived ideas do not constitute an invention, and that unless they are followed up by a reasonable observance of the requirements of the patent laws, they can have no effect upon a subsequently granted patent to another."

The Court then applies these rules to the particular facts of that case which it was necessary to pass on. These decisions have been followed in numerous cases. The most recent, and one bearing directly upon this interference, being Railroad Signal Company vs. Railroad Signal Company, 6th Federal Reporter, p.

603. The rules stated in these decisions are directly applicable to the interference between Gill and Scott.

Thus Gill was the first to reduce his inventions to a fixed, positive and practicable form in actual working machines, some fifteen in number, before Scott applied for his patent. On the other hand, Scott, in 1874, had made a drawing of his ideas, which drawing, under the decision I have referred to, was not a reduction to practice of the invention, but had done nothing after making such drawing in 1874 in reducing the same to practice, in a fixed, positive and practical form in a machine, before he applied for his patent in January, 1881, nor has he ever done so.

The Commissioner had before him a question of law upon the facts, and one that has very frequently arisen in interference cases, which was: Did Scott, who had first made a drawing in 1874, use reasonable diligence in adapting and perfecting the invention which he had conceived, as shown by such drawing, so as to entitle him to an award of priority of invention as against Gill, or did his delay of seven years, during which time he could have adapted and perfected the same, operate as an abandonment of such conception?

The Commissioner decided that question according to his best judgment under the law, against Scott, and in favor of Gill.

The drawing of Scott in 1874 was not, under the decisions I have quoted, evidence of a perfected invention, and he did not use reasonable diligence in adapting and perfecting the conception of such invention proved by such drawing, but, on the other hand, delayed seven years without doing anything, which, under the circumstances of the case, was evidence of an abandonment of the conception shown by the drawing. So that the Commissioner of Patents, instead of wrongfully deciding this interference, contrary to the law, rightfully decided it in accordance with the law.

The question involved in this interference was an entirely different one from that involved in the Bigelow case, which has been cited here, for in that case

the abandonment, if any, was one arising from two years' public use of a machine containing the invention perfected, prior to the application for the patent, while in this interference the abandonment was not that of an invention reduced to practice in a machine, but of a tentative effort towards making an invention by illustrating it in a drawing.

Upon the second suggestion, therefore, of the opposing counsel as to the Commissioner of Patents deciding contrary to the law in favor of Gill, I shall not further argue. I need only state in closing this discussion that it is not charged nor intimated here that this judgment of the Commissioner of Patents, in favor of Gill, was a dishonest one, or was obtained by fraud or corruption or on account of an antipathy to Scott. It stands like the judgment of any Court, honestly rendered as a decision under the law.*

I come now to the real question involved in this proceeding, and that is, whether the Secretary of the Interior has power or jurisdiction to entertain and decide appeals from the judicial decisions of the Commissioner of Patents, where, under the law, the latter is specially named to make such decisions, and from which decisions an appeal or a bill in equity lies to this Court to review the same.

In discussing this question I shall devote myself mainly to the dry details of the different statutes, and decisions referring to the same, as an argument upon the general principles of the law and those derived from the action of other departments in respect to similar questions has been already fully made by my colleague.

Your Honors have heard read the opinion of Attorney-General MacVeagh under which Secretaries Kirkwood and Teller have acted. I take that to be a full exposition of the position of the Secretary of the Interior, and the Commissioner of Patents as the

*This decision is reported in the 23d O. G., p. 2511.

defendant in this proceeding, in regard to this question.

The authority from which the Secretary is advised by this opinion of the Attorney-General he derives the power or jurisdiction to hear and decide appeals from the judicial decisions of the Commissioner of Patents, are Sections 441, 481 and 4883, which are as follows:

Section 441 provides that:

The Secretary of the Interior is charged with the supervision of public business relating to the following subjects:

1st. The census when directed by law.
2d. The public lands, including mines.
3d. The Indians.
4th. Pensions and bounty lands.
5th. Patents for inventions.
6th. The custody and distribution of publications.
7th. Education.
8th. Government hospital for the insane.
9th. Columbia Asylum for the deaf and dumb.

Section 481 provides that:

The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

Section 4883 provides that:

All patents shall be issued in the name of the United States of America under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose.

The Attorney-General in his opinion, in order to give the Secretary of the Interior this jurisdiction, construes all those sections of the Acts of Congress in which the Commissioner of Patents is the officer named to perform judicial or administrative duties, as if the words "under the direction of the Secretary of the Interior" were inserted in each section.

In answering this position my argument will be four-fold:

FIRST. I shall endeavor to show that it has always been the policy of Congress, from a very early time, to designate certain officers to perform certain judicial

duties regarding the granting and issuing of patents, whose decisions were to be final, unless reviewed on proper proceedings by a tribunal, independent of such officers and of the head of the department, having power to pass upon and decide the question of right in an invention, after an adverse decision by such officers; and that the contemporaneous construction of the Acts of Congress in which this policy is shown, down to the year 1881, has excluded the jurisdiction now undertaken by the head of the department in which such rights are passed upon.

SECONDLY. I shall then argue that the words of the sections I have quoted, when given a natural and not a strained or artificial meaning, exclude this jurisdiction.

THIRDLY. I shall urge the argument of *ab inconvenienti*, which would exclude the performance of the duties which this jurisdiction would impose upon the Secretary of the Interior; and

LASTLY. That in regard to other subject matter, Congress has expressly given the right of appeal to the Secretary of the Interior from subordinate officers, and as no express provision is made for the appeal to him from the judicial decisions of the Commissioner of Patents, that this also excludes this jurisdiction.

In considering the construction of the statutes to which I shall refer, it is unnecessary to quote any authorities to sustain the proposition which was laid down in the case of Edwards Lessee vs. Darby, reported in the 12 Wheaton, p. 206, as follows:

> "In the construction of a doubtful and ambiguous law the contemporaneous construction of those who are called upon to act under the law, and were appointed to carry its provisions into effect is entitled to very great respect."

I shall deem it proper, therefore, to use this principle in my argument.

The history of the legislation in regard to patents for invention is this:

Shortly after the adoption of the Constitution by all the States, Congress passed an act in 1790, the first section of which authorized the Secretary of

State, the Attorney-General and the Secretary of War, or any two of them, to cause a patent upon application to be prepared, which was then to be submitted to the Attorney-General to see that it was in conformity to law, and then was to be submitted to the President of the United States, to be attested and have the seal of the United States affixed thereto by him.

The Act of 1793 empowered the Secretary of State to cause a patent, on application, to be prepared and sent to the Attorney-General, and by him sent to the President for his signature and the seal. Section 9 of this Act erected for the first time a tribunal independent of the Secretary of State to determine questions arising between conflicting applications. It was as follows:

> That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State; and the decision or award of such arbitrators, delivered to the Secretary of State in writing, and subscribed by them, or any two of them, shall be *final* as far as respects the granting of the patent. * * *

The third section of the Act of 1832 empowered the Secretary of State to grant reissues of patents, and was substantially the same as section 4916 of the Revised Statutes, in which this power is given to the Commissioner of Patents. Then came the Act of 1836, which made a radical change in the previous laws, creating the office of Commissioner of Patents, providing for a system of examination and determination of the rights of inventors to a property in their inventions, and a remedy by appeal and by bill in equity from an adverse decision upon such rights by the Commissioner of Patents.

Section 1 of this act was as follows:

> That there shall be established and attached to the Department of State, an office to be denominated the Patent Office, the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute and perform all such acts

and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions and improvements, as are herein provided for, or shall hereafter be by law directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines and all other things belonging to said office.

A comparison of this section with section 481 of the Revised Statutes will show that they are very similar.

Section 5 of this act provided:

That all patents issued from said office shall be issued in the name of the United States, under the seal of the Patent Office, and be signed by the Secretary of State, and countersigned by the Commissioner of the said office, and shall be recorded, together with the descriptions, specifications and drawings, in the said office, in books to be kept for that purpose.

A comparison of this section with section 4883 of the Revised Statutes will show that they are substantially the same.

Section 7 of this act empowered the Commissioner of Patents to make or cause to be made an examination of the invention for which an application was made for a patent, and to decide upon such examination whether it had been previously invented, patented or described in any printed publication, or had been in public use, or on sale with the applicant's consent prior to his application, and whether it was sufficiently useful and important. And if his decision was in favor of the applicant, the act said:

It shall be his duty to issue a patent therefor.

A comparison of this section empowering the Commissioner of Patents to decide these questions, and if his decision was favorable to issue the patent, with sections 4886 and 4893 of the Revised Statutes will show that this section is substantially the same as the two of the Revised Statutes.

Section 13 of the Act of 1836 took away the power from the Secretary of State given him by section 3 of the Act of 1832, to grant reissues in proper cases, and lodged it in the Commissioner of Patents. It is substantially the same as section 4916 of the Revised Statutes.

Section 8 of this Act empowered the Commissioner of Patents to decide who had the right to the patent in interference cases between two applications or an application and an unexpired patent.

Sections 4904 and 4910 of the Revised Statutes grant powers similar to this section.

Section 1 of the Act of 1848 conferred upon the Commissioner of Patents the power to grant or refuse the extension of a patent, taking this power away from a board composed of the Secretary of State, Commissioner of Patents and Solicitor of the Treasury, who had previously exercised it under the eighteenth section of the Act of 1836. This section of the Act of 1848 is substantially the same as sections 4924 to 4928 of the Revised Statutes.

Section 12 of the Act of 1861 conferred upon the Commissioner of Patents the power to decide whether a delay of more than two years in completing and preparing an application for examination was unavoidable or not. This section is substantially the same as section 4894 of the Revised Statutes.

A number of the sections of these old acts to which I have referred took away the power which had been exercised by the Secretary of State and other officers higher than the Commissioner of Patents and conferred it upon him. In every one of them, from the passage of the Act of 1836, the Commissioner of Patents was named to perform certain judicial duties, as he is in the corresponding sections of the Revised Statutes.

The Courts in a number of cases arising under several of these sections have regarded his decisions under them as judicial, and when they have been in favor of the applicant they have unequivocally stated them to be final and beyond review.

I shall only refer to a few of them: There have been a large number of decisions rendered under the thirteenth section of the Act of 1836 authorizing the Commissioner of Patents to grant reissues, one of which, as a fair example of the rulings of the Courts as to this section, upon the final decision of the Commis-

sioner of Patents, in the case of Parham vs. The American Button-hole Over-seaming and Sewing Machine Company, reported in 4 Fisher, p. 468. One question in this case was as to whether the Commissioner of Patents rightfully granted the reissue there in suit, or whether he had exceeded his authority under the statute. The Court, in referring to this Act of 1836, said:

> The power of accepting the surrender of the original patent and of granting a reissue of it is here confided exclusively to the Commissioner and is to be exercised judicially by him.

It then cites in support of this doctrine, among other cases, that of Seymour against Osborne, 11 Wallace, 516. In that case one of the issues was the same as in the case just referred to. Upon this issue the Supreme Court said:

> Where the Commissioner accepts the surrender of an original patent, and grants a new patent, his decision in the premises, in a suit for infringement, is final and conclusive, and is not re-examinable in such suit in the Circuit Court unless it is apparent upon the face of the patent that he has exceeded his authority; that there is such a repugnancy between the old and new patents that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original patent.

Under the Act of 1848 a great many extensions were granted by the Commissioner of Patents, among which was the extension of one of the Goodyear Rubber patents. In a case arising upon the extended term of this patent, that of Rubber Company vs. Goodyear, 9 Wallace, 788, where it was contended that the Commissioner of Patents wrongfully granted this extension, the Court said:

> The extension was granted by the Commissioner pursuant to the First section of the Act of 1848, and the Eighteenth section of the Act of 1836. The latter declares that upon the making and recording of the certificate of extension the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. The law made it the duty of the Commissioner to examine and decide; he had full jurisdiction; the function he performed was judicial in its character. No provision is made for appeal or review. His decision must be held conclusive until the patent is impeached in a proceeding had directly for that purpose ac-

cording to the rules which define the remedy as shown by the precedents and authorities upon the subject.

Under the twelfth section of the Act of 1861 several cases have arisen in the Courts where a patent was granted after a delay of more than two years in prosecuting the application. I shall refer to but one, that of McMillan against Barclay, reported in 5th Fisher, p. 189. One of the defenses in this case was that the application on which one of the patents was granted had been abandoned by failure to prosecute the same within two years.

The Court, after quoting the section to which I have referred, said :

"The act does not interpose an absolute bar to the granting of a patent, where the application has not been completed and prepared for examination within two years. The delay may be condoned by proof that it was unavoidable. The decision of this fact is committed to the Commissioner of Patents. If it is shown to his satisfaction that the delay was unavoidable, the application is not to be regarded as abandoned. He is invested with the power to grant the patent, and he may exercise it, subject to the duty of determining that the preparation of the application for examination was not unnecessarily delayed after two years. This is the plain meaning of the act, and there can be no doubt about it. Now it must be assumed that there was evidence before the commissioner to show that there was no unavoidable delay in preparing this application for examination after two years from the passage of the act. Its sufficiency was for him, and in the exercise of the judicial function, entrusted to him, he has decided the fact in favor of the patentee. He was the only Judge to be 'satisfied,' and his judgment is conclusive."

That it was the policy of Congress that the decisions of the Commissioner of Patents should be final, unless reversed on appeal or on the filing of a bill in equity in a Court, by a tribunal outside of the department, is also clear from a consideration of the Acts of Congress, granting the right to review the decisions of the Commissioner of Patents.

Section 7 of the Act of 1836 provided for an appeal from an adverse decision of the Commissioner of Patents to a Board of Examiners, who were to be appointed by the Secretary of State, and as the statute says :

"And on an examination and consideration of the matter by such board, it shall be in their power or of a majority of them to reverse

the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner he shall be governed thereby in the further proceedings to be had on such application."

Section 8 of this Act provided for a similar appeal to this board, from the decision of the Commissioner in interference cases, with a similar power, to reverse the decision of the Commissioner of Patents, which decision on appeal should also control him.

Section 16 of the Act of 1836 provided a remedy by a bill in equity to review an adverse decision of this Board of Examiners, where it was grounded on an interference with an unexpired patent, and empowered the Court to make a judgment as to whether this decision should be sustained or reversed. The statute says:

"And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act."

Section 11 of the Act of 1839, abolished the Board of Examiners, and transferred the power, conferred upon them, to hear appeals from the decision of the Commissioner of Patents, to the Chief Justice of this Court, in any case where there was an adverse decision by the Commissioner of Patents; while section 10 of this act extended the remedy by bill in equity to review the decision of either the Commissioner, or the Chief Justice, where the latter had decided upon appeals of any nature from the decision of the Commissioner.

On comparison it will be seen that section 11 of the Act of 1839, amending section 7 of the Act of 1836, is substantially the same as section 4911 of the Revised Statutes; while section 10 of this act, amending section 16 of the Act of 1836, is substantially the same as section 4915 of the Revised Statutes.

It is strange that Congress should have made such ample and specific provisions to review the judicial decisions of the Commissioner of Patents by tribunals outside and independent of the department, if it had

intended that the head of the department should have this power of review; and these provisions negative the idea that such head had such power.

The reason why such jurisdiction was not conferred upon the head of the department that suggests itself, was, that Congress regarded the right of property in an invention so important as to give the inventor redress against an adverse decision of the Patent Office, before a tribunal free from suspicion of being influenced by political considerations.

The Act of 1849 provided that:

> The Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents now exercised by the Secretary of State.

This act created the Interior Department and made the head of it the Secretary of the Interior, and language is employed designating the different subjects matter over which he was to have control. Two constructions can be put upon the section I have quoted. One is: when construed with reference to the various acts to which I have referred that appeals were excluded in all cases where the Commissioner's decision was to be final, unless reviewed on appeal or by a bill in equity by a tribunal outside of the office; in other words, that this language merely meant that the Secretary had the power to hear appeals from the Commissioner of Patents in all adminstrative matters; or perhaps it may have the other construction that it was intended to give jurisdiction to the Secretary of the Interior to reverse any judicial decision of the Commissioner of Patents, on appeal; though this does not seem consonant with the acts giving the right of review by appeal or by bill in equity to a tribunal outside of the Department. It seems never to have had this latter construction given to it, as no case can be found in which the Secretary ever assumed or took jurisdiction to reverse the decision judicially made of the Commissioner of Patents. It remained a dead letter in the statute books until 1870, when it was repealed by the Act of July 8th, of that year.

The view that it did not give this power to the Secretary of the Interior is enforced by the opinion of this Court in the case of Wade against Matthews, decided in the year 1850, found in Vol. I., page 402, of the manuscript decisions of this Court, in the library of the Commissioner of Patents, where the Court said, referring to the Patent Office:

> The proceedings in the office are all under the superintendence and control of the Commissioner, who acts immediately under the law, and who is uncontrolled in the discharge of the duties of his office, except so far as the appeal is expressly allowed.

This view is further supported by the opinion of the Attorney-General, in 1869, reported in Vol. 13, page 28, of the Opinions of the Attorney-General. In this case the President of the United States asked the opinion of the Attorney-General as to whether he had the power to decide upon the rights of an applicant for an extension of a patent. The Attorney-General said:

> The Patent Laws having made ample provisions for reversing the decision of the Commissioner in proper cases by the judiciary, and the executive having no appellate power over questions arising thereunder, the parties should be left to pursue the mode of relief there provided.

This was the first time that an Attorney-General was asked to give an opinion bearing upon the question here under discussion. The President wanted to know whether, under the provision of the Constitution, that he should take care that all the laws be faithfully executed, he could override the Commissioner of Patents in a matter which Congress had confided to his judicial discretion, and the Attorney-General in effect told him that he had no such power.

So far as I have been able to ascertain, an attempt was made for the first time in the year 1875 to get the Secretary of the Interior to assume the jurisdiction here in question. This was in the case of Edison and Harrington against Edison and Prescott, the Western Union Telegraph Company owning the Prescott interest from Edison; while the Atlantic & Pacific Telegraph Company, controlled by Jay Gould, owned the Harrington interest from Edison. The Commissioner

of Patents had decided in favor of the Western Union interest.

The Secretary of the Interior was asked to reverse this decision of the Commissioner of Patents. The then Secretary, Delano, hesitated about it and the responsibility of passing upon this question devolved upon Secretary Chandler shortly after he came into office in 1876. His decision, which will be found at page 403 of the 9th Official Gazette, is as follows:

"On examination of the case I find that on the 20th of March, 1875, Hon. J. M. Thatcher, then Commissioner of Patents, awarded patents for improvements on duplex telegraphs to Thos. A. Edison and George B. Prescott. In this case Edison appears to have been the inventor and to have made two instruments in the nature of assignments of the inventions—one to George B. Prescott and the other to George Harrington.

"Both the assignees were before the Commissioner, and the chief question presented for his decision was whether the patents should issue to Edison and Harrington or to Edison and Prescott. After a full hearing of the parties he decided in favor of the latter, and thereupon remanded the applications to the principal examiner for further proceedings in accordance with the practice of his office.

"On the 29th of the same month Harrington presented a petition to Hon. C. Delano, then Secretary of the Interior, setting forth the contest between Prescott and himself and the decision of the Commissioner therein, complaining that such decision was 'contrary to equity and in violation of the spirit of the law,' in averring that 'the Commissioner of Patents is, in the exercise of his power as such, subject to the direction of the Secretary of the Interior,' and praying that he would direct the proceedings theretofore had before the Commissioner of Patents to be transmitted for the examination and revision of the Secretary, to the end that the patent might be decided to be issued to Harrington and Edison; and on the following day the Secretary addressed a communication to the Commissioner of Patents directing him to transmit all the proceedings in the cases mentioned for his examination and revision.

"This direction was complied with, and the parties to the contest thereafter were heard before the Secretary upon full argument, both as to the jurisdiction of the latter to issue the order and the merits of their respective claims. The record shows no decision by him on either point prior to his resignation.

"On the question of jurisdiction it is contended by Mr. Prescott:

"1st. That the Secretary of the Interior has no power to review the decision of the Commissioner on the merits of any case.

"2d. If such power exists at all its exercise in this case was premature, as it could not yet be known whether any patent would

ever issue under the order of the Commissioner. On the part of Mr. Harrington it is claimed:

"1st. That the statute conferring upon the Secretary powers of supervision and direction over the Commissioner included the power to review any decision of the latter; and

"2d. That he may exercise the power whenever, in his discretion, it may seem proper, and is not bound to wait for the presentation of the patent for his signature.

"I have considered the very able and exhaustive arguments of the learned counsel for the respective parties with great care, and have reached the conclusion that the action of the late Secretary in arresting the proceedings before the Commissioner was premature, in any view of the case, and not consonant with good practice and the orderly conduct of business in your office.

"I might stop at this point and return the papers without considering the principal question, as to the power of the Secretary of the Interior to revise the decisions of the Commissioner of Patents, but, in view of its importance, and the very full argument thereon by counsel for the respective parties, I deem it proper to express my opinion upon this question also.

"No appellate jurisdiction in cases like this is conferred upon my office by any express statute. The grant of power from which it is sought to be inferred is found in Secs. 441, 481 and 4883, R. S. Sec. 441 is as follows:

"'The Secretary of the Interior is charged with the supervision of public business relating to the following subjects: * * * Fifth, patents for inventions.'

"Section 481 provides that 'the Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the issuing or granting of patents directed by law.'

"Section 4883 provides 'that all patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents.'

"That a grant of supervisory power has not been intended by Congress to include appellate power, I think is evident.

"In defining the power of the Secretary of the Interior with respect to the census, it provides that he 'shall exercise supervising and appellate powers in relation to all acts of marshals,' &c., R. S., Sec. 443. So, in section 441, above cited, the same supervision is given of public lands as of patents; yet the right of appeal to the Secretary is expressly granted by Sec. 2273 R. S. in cases of contest for the right of pre-emption.

"And in the Act of March 3, 1849, for the establishment of this department it is provided 'that the Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents now exercised by the Secretary of State.'

"Nor does the statute which provides that the Commissioner of Patents shall superintend or perform all duties respecting the grant-

ing and issuing of patents under the direction of the Secretary of the Interior confer upon the latter office any appellate power. The power to supervise includes the power to direct.

"Supervision is the act of overseeing—of superintendence; is concurrent with and accompanies the official action which is its subject, and is applicable to executive duties.

"To appeal is to remove from a lower to a higher jurisdiction for review of judicial action, and necessarily *follows* such action.

"The provision of the Act of 1849 above cited was repealed by the Act of July 8, 1870; but I am unable to learn that any appellate jurisdiction has ever been exercised or claimed by any Secretary of State or of the Interior Department over the judicial action of the Commissioner of Patents since the creation of the office by Act of July 4, 1836.

"An ample remedy against the consequences of an erroneous decision of the Commissioner is provided by appeal to the Supreme Court of this district or by bill in equity, as the case may be.

"For the reasons above suggested I am of the opinion that no power is vested in me to review the decisions honestly made by the Commissioner of Patents in cases within his jurisdiction, and I return herewith all the papers relating to the applications above mentioned, in order that due legal proceedings may be had thereon in your office.

"Very respectfully,

"Your obedient servant,

"Z. CHANDLER, Secretary.

"To the Commissioner of Patents."

That opinion was evidently written by a man of considerable breadth and strength, whether he were a lawyer or not.

The next case in which the jurisdiction of the Secretary was invoked was also an important one. It is reported in 12 O. G., p. 475, and decided by the Secretary September 13th, 1877. Eminent counsel were engaged on both sides of this case, the subject-matter being an improvement in time locks, an invention then of great value. In this case, James Sargent's application had been in interference with a number of others, among which was that of Burge, and a decision was made in favor of Sargent by the Commissioner of Patents. Burge filed a bill in equity under section 4915, reciting the interference, and praying that he might be adjudged entitled to the patent. A request was made to the Commissioner of Patents to suspend the issue of the patent to Sargent on account

of this equity proceeding, which he granted. An appeal was taken from this action to the Secretary of the Interior,. and the question presented to him, was whether this refusal to issue the patent to Sargent was a ministerial or a judicial one, and whether, if ministerial, he had a right to so refuse under the circumstances. In his opinion, Secretary Schurz says:

> In the discharge of your judicial duties you hear and determine the rights of parties within the statute governed by the same rules as a Court. In the discharge of your administrative duties, whether of a ministerial or directory character, the law must be executed according to its letter and intent. * * * From the decision of the Commissioner of Patents in an interference case, no appeal lies to any other tribunal (Revised Statutes, section 4911. Edison *et al.* against Edison *et al.*, 9 O. G., p. 403). In other words, your decision in such case upon the merits, is final. * * * In this case, your predecessor in person decided that the patent should issue to Mr. Sargent. The correctness of that decision has not been successfully assailed before you, nor attempted, except by interfering applications, which have all been decided in Mr. Sargent's favor. I am, therefore, brought to the conclusion that at the time of making the order of suspension, there was no legal reason why the patent should not have been issued, and that there was no duty to be performed by you except the ministerial duty of preparing and issuing the patent, and that in the performance of those duties, the statute is mandatory.
>
> The second question presented for my consideration is: Have I the legal right to direct you now to issue the patent to Mr. Sargent? * * * If there were any questions affecting the merits of Mr. Sargent's application still pending before you, there could be but one answer to this question, namely, that I have not that right. * * * The duty now to be performed, as before stated, of issuing the patent to Mr. Sargent, is merely ministerial. * * * You are, therefore, hereby directed to prepare for issue the Letters Patent for the improvement in time locks to which Mr. Sargent has been adjudged entitled.

In this opinion, the Secretary clearly draws the line between his right to review the decisions of the Commissioner of Patents, judicially made as in an interference case, and the acts of the Commissioner which are merely administrative, such as preparing the patent for issue after the judicial decision. And he clearly refuses to assume the jurisdiction to reverse the judicial decision of the Commissioner of Patents; while he does contend that he has the right to direct him in mere ministerial duties.

The next case in which this question arose before the Secretary of the Interior, was the Hunt case, decided in the year 1878, reported in 13 O. G., p. 771. In this case the Commissioner of Patents had refused to grant a reissue because he had found a number of references which anticipated the invention. From the refusal to grant this reissue, an appeal was taken to the Secretary of the Interior, who, on this appeal, said:

> The reasons stated for refusing to deliver the reissue patent in this case, viz.: that the claims were not novel nor meritorious, and were manifestly old, are sufficient, in my opinion, to justify the action taken by you. The questions upon which this refusal was based are questions involving the merits of Mr. Hunt's application for a reissue of said patent. Upon such questions the right of appeal, or of a review of your action, does not lie to this department. This question was fully discussed by my predecessor in the case of Edison *et al.* against Edison *et al.*, 9 O. G., p. 403. The same question was passed upon by me in the matter of the application of James Sargent for a revocation of the order of the Commissioner of Patents, dated July 24, 1877, suspending the issue of his letters patent, in which it was held: "The second question presented for my consideration is, Have I the legal right to direct you now to issue a patent to Mr. Sargent? This right is denied by Mr. Burge's counsel. If there were any questions affecting the merits of Mr. Sargent's application still pending before you, there could be but one answer to this question, namely, that I have not that right."

The next case in which this question again came before the Secretary of the Interior was that of McNaught, and his opinion is reported in the 16 O. G., p. 220. It appeared in this case that the Commissioner of Patents, in an interference, had rejected the evidence of the wife of one of the witnesses as not being admissible. His decision on this question was a judicial one. An appeal was taken from this decision to the Secretary of the Interior, and upon this appeal he says:

> In deciding that the testimony of Mrs. McNaught was not properly to be considered in this case, you are acting in your judicial capacity. It was held by my predecessor, and has been twice decided by me, that the decision of the Commissioner of Patents, while acting in his judicial capacity, was not reviewable by this Department. I am not aware that any different ruling has ever been made by any of my predecessors. The rule thus established I think is in accordance with the law, and I must, therefore, decline to consider the other question presented in the case. The application is dismissed. * * *

Here, then, are four decisions of the Secretaries of the Interior, one during each of the years 1876, 1877, 1878 and 1879, in cases of great importance, after full argument and due deliberation, refusing to take the jurisdiction here in question.

The reason of the refusal of the various Secretaries of State and of the Interior to take the jurisdiction here in question, for a period of forty-five years, is found from the various statutes I have considered, in the policy of Congress to confer upon the Commissioner of Patents power to make judicial decisions which were final, unless reviewed on appeal or by bill in equity by a tribunal outside and independent of the State and Interior Department, excluding this power of review from the Secretaries of the State and Interior who were not specifically given the same, by specially naming the Commissioner of Patents and tribunals upon whom power was conferred by these acts.

These judicial decisions of the Commissioner of Patents had to be deliberate and independent upon the facts and the law presented to him.

Each of these sections of the acts to which I have referred, conferring power upon the Commissioner of Patents, name him as the officer who is to judicially decide independently and deliberately, and name the tribunals who by appeal or by bill in equity can reverse his decisions.

The express power conferred by Congress upon the special officer, the Commissioner of Patents, to make such judicial decisions; the express provisions naming special tribunals independent of the Secretaries of State and the Interior to review adverse decisions of the Commissioner of Patents, by appeal and bill in equity; the contemporaneous construction of Acts of Congress substantially the same as those acts here under discussion, for forty-five years, by the Secretaries of the State and the Interior Departments, that they did not have the jurisdiction specially conferred upon these independent tribunals to reverse the judicial decisions of the Commissioner of Patents, would

seem to prevent the construction which Attorney-General McVeagh in 1881 placed upon the sections under which he advised the Secretary of the Interior he had such jurisdiction.

I now come to the second part of my argument which requires a discussion of these sections relied upon by the Attorney-General, and which rests purely upon reason. Whether my reason is good or not, is for your Honors to decide. We have no judicial light whatever, directly upon this subject. It is a matter of great importance in construing ambiguous statutes, for undoubtedly these are ambiguous, without any decisions upon them, to adhere very strictly to the natural interpretation of those sections, and not give an artificial or strained meaning to them, unnecessarily, in order to give them effect.

Before going into this discussion, I shall state briefly the theory of opposite counsel and of the Attorney-General. It is summed up in a very few words.

The Attorney-General says:

> I think the key to the whole question is found in sections 441 and 481 of the Revised Statutes. By the former the "Secretary of the Interior is charged with the supervision of public business relating to the *inter alia* Patents for inventions;" and by the latter it is provided that "the Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend perform all duties respecting the granting and issuing of patents directed by law."
>
> To my mind, every section imposing a duty or conferring a power on the Commissioner of Patents, should be read as if the words "under the direction of the Secretary of the Interior," were inserted."
>
> It is not necessary to the validity of all acts of the Commissioner, that the direction of the Secretary should be expressed. That will always be presumed, except in the cases that require his express approval, to wit: the adoption of regulations (section 483, R. S.); the refusal to recognize a person as patent agent (section 487, R. S.); and the actual granting of a patent (section 4883)."

He then lays some stress upon this latter section, which requires the patent to be signed by the Secretary of the Interior, and further on says:

> "As I have already observed, every act of the Commissioner is presumed to be done with the knowledge and by the direction of the Secretary, until or unless the contrary appears."

From this it will be seen that this theory of the con-

struction of these statutes, is, that all judicial decisions which the Commissioner of Patents is specially named to make in the different sections of the statute, are to be considered as if done by the direction of the Secretary of the Interior.

I shall first consider section 481, and the question is:

What is meant by the Commissioner of Patents superintending or performing all duties respecting the granting and issuing of patents directed by law, under the direction of the Secretary of the Interior?

If I am right in assuming that these different acts of the Commissioner of Patents in deciding upon the novelty, utility, patentability and priority of inventions; in deciding upon the questions arising about reissues, extensions, abandonment and interferences, are judicial in their nature, and I cannot see any escape from this view, let us see whether this construction of the Attorney-General will stand the test of reason.

As I have said, a judicial decfsion must be independent and it must be deliberate, which are of its essence. If the Secretary of the Interior derives the power to reverse a judicial decision of the Commissioner of Patents, it must be form his authority to direct.

He must be able to direct at any time. If he directs before the decision, it is not an independent deliberate one of the Commissioner. If he directs concurrently with the decision of the Commissioner, it is not the decision of the latter, because he is a mere figure-head, or a clerk, in making it. He cannot direct after the decision is made, because the judicial action has been exhausted. It seems to me that this view alone excludes the jurisdiction which he has assumed. The direction before or at the time of the judicial decision takes away the essence of that decision; it is not a judicial decision. He cannot direct afterwards, because the decision has been made.

From another point of view the Attorney-General's construction will appear to be as illogical.

He says that because the Secretary of the Interior

has the power to direct there follows the power of reversing a judicial decision of the Commissioner.

If the theory of the Attorney-General or the argument made here by the opposing counsel is right, that every judicial decision of the Commissioner must be presumed to be made under the direction of the Secretary; then, after he has made such decision and adjudged the patent, as in this case, it is the decision of the Secretary, because it must be presumed to have been made under his direction. Then how does an appeal lie from the Secretary to the Secretary? If the judicial decision of the Commissioner is always presumed to be that of the Secretary, made under his direction, then when he has made it, the Secretary has exhausted his power of direction.

Aside from these dilemmas, "direction," under the Attorney-General's opinion, means something not found in the dictionary. It means appeal; it means the power to reverse a judicial decision; it means the taking of jurisdiction that the statute does not confer; it means that he may decide instead of another officer specially designated in the statute to decide.

There is no dictionary that I know of that defines "direction" in that way. And it means further, that all of these things may be done at any time, which excludes the idea of any proper procedure in a legal forum; upon any record, no matter how incomplete; no matter what it may be; upon anybody's suggestion; and without any hearing.

The construction of the Attorney-General has less support from section 441, if that be possible, than from section 481.

The former section charges the Secretary of the Interior with the supervision of public business relating to nine subjects.

At least four of these subjects require no judicial functions to be exercised in supervising them, while some of the others require judicial decisions in their despatch. It is strange that if Congress had intended to confer upon the Secretary of the Interior the juris-

diction which the Attorney-General draws from this section, that it should have used such inapt and inaccurate words to confer the same, and which are applicable alike, under his view, to affairs which require the exercise of no judicial discretion whatever, and those which require the exercise of judicial discretion pure and simple.

By invoking this section the Attorney-General gets entirely too much authority for his construction. "Supervision" here means a great deal more than "direction" in section 481. If it confers any power it must confer such power to reverse a judicial decision, no matter by whom made, whether by the officers of the Patent Office or by this Court, and this at any time before the patent is delivered, for this word is applied to the subject of patents for invention, without limitation of any kind.

It is impossible to believe that Congress intended by the use of this word in this section, to take away the power which it had plainly and specifically given to the Commissioner of Patents and this Court to judicially decide upon the right of an inventor to the property in his invention.

The Attorney-General did not evidently think that he derived much strength for his construction from this section, for he says very little about it.

The last section upon which he seems to rely somewhat for his construction is number 4883, which requires that all patents shall be signed by the Secretary of the Interior.

The signing of the patent by the President, under the Acts of 1790 and 1793, and by the Secretaries of the State and Interior Departments since the Act of 1836, seems to have been merely as an authentication of the instrument.

If any power is derived from this section of the Act, it must be at the time that it is to be exercised, that is, when the patent is prepared and submitted to the Secretary for his signature. That is at the time a record must be made up and submitted to him for his

authentication. Before this can be done, all judicial discretion must have been exhausted, which excludes the jurisdiction which the Attorney-General has advised him he has, to reverse a judicial decision under this section.

Taking these three sections together, the Attorney-General gets no authority from them to interpolate into other sections words that are found in these.

This is not interpreting statutes, but interpolating! He is attempting to affect what is called judicial legislation, when Courts attempt it. I know of no authority for such a rule of interpretation of statutes.

The third part of my discussion of the question here under consideration, is the argument *ab inconvenienti*.

Although not having usually much weight, it should have some in the construction of doubtful statutes, and especially of the sections here under consideration.

In the year 1837 there were 435 patents granted. The number increased yearly until in the year 1881, when the Attorney-General advised the Secretary of the Interior to take this jurisdiction, there were 26,059 applications for patents, and 16,584 patents were granted. In the year 1883 there were 34,576 applications for patents made, and 22,383 patents were granted.

By giving this jurisdiction to the Secretary of the Interior, there is imposed upon him an enormous amount of labor, which the increase of business in the various bureaus of his department would render him physically impossible of performing.

The Attorney-General, in his opinion, recognizes this difficulty, for he says:

> I am not unaware of the vast amount of labor which must result by your personally reviewing all the acts and decisions, discretionary as well as administrative, of the Commissioner of Patents; indeed, it would be physically impossible for you to do this. The argument *ab inconvenienti*, however, addresses itself to you when you prescribe regulations under section 161, R. S., for the performance of the business of the department.

He then goes on to advise the Secretary that he need not exercise this discretion in every case appealed to him, but can select such cases as he specially desires to hear.

This alone would seem to be an answer to the Attorney-General's construction. If the Secretary has conferred upon him this jurisdiction, he must exercise it in every case where a party is dissatisfied with the judicial decision of the Commissioner, and appeals to him to review the same, which the Attorney-General says it is physically impossible for him to do. If the statute, therefore, can bear any other construction than that of imposing upon a public officer duties that he cannot perform, and which duties it specifically empowers subordinate officers to perform, it should not be given such an unreasonable and strained construction.

The last part of my discussion here under consideration, is that relating to the action of Congress regarding appeals from subordinate officers of other bureaus to the Secretary of the Interior regarding other subject matters.

Section 11 of the Act of 1841 is as follows:

> And be it further enacted, that when two or more persons shall have settled on the same quarter-section of land, the right of pre-emption shall be in him or her who made the first settlement: provided such persons shall conform to the other provisions of this act: and all questions as to the right of pre-emption arising between different settlers, shall be settled by the register and receiver of the district within which the land is situated, subject to an appeal to and a revision by the Secretary of the Treasury of the United States.

That office was transferred to the Interior Department under the Act of 1849. In 1858 another act was passed, enlarging that remedy. It is as follows:

> SECTION 10. And be it further enacted, that the 11th section of the Act of Congress approved September 4, 1841, entitled "An Act to appropriate the proceeds of the public lands, and to grant pre-emption rights," be so amended that appeals from the decisions of the district officers, in cases of contest between different settlers for the right of pre-emption, shall hereafter be decided by the Commissioner of the General Land Office, whose decision shall be final, unless appeal therefrom be taken to the Secretary of the Interior.

Section 2273 of the revised Statutes is as follows:

"When two or more persons settle on the same tract of land the right of pre-emption shall be in him who made the first settlement, provided such person conforms to the other provisions of the law; and all questions as to the right of pre-emption arising between different settlers, shall be determined by the register and receiver of the district within which the land is situated; and appeals from the decision of district officers, in cases of contest for a right of pre-emption, shall be made to the Commissioner of the General Land Office, whose decision shall be final, unless appeal therefrom be taken to the Secretary of the Interior."

Those are the only statutes that I have been able to find that confer a specific right of appeal from the judicial decision of an officer regarding land, which otherwise would be final, to the Secretary of the Interior.

There is another section of the statute giving the right of appeal to the Secretary of the Interior from acts performed in the Census Bureau. It is section 443, as follows:

The Secretary of the Interior shall exercise supervisory and appellate powers in relation to all acts of marshals and others in taking and returning the census of the United States.

Of course the argument upon these Acts of Congress is, that wherever Congress intended that the Secretary of the Interior should perform judicial acts, on appeal from subordinate officers, it did not give it to him by implication, but expressly gave him that authority by express act, and where it did not so expressly give him this power, it did not intend that he should have such power or exercise it.

Leaving the discussion of the construction of these acts, I come now to the question as to whether this petition for writ of mandamus is the proper remedy. The law respecting the right to a writ of mandamus is admirably summed up in a case decided by this Court, reported in the 2d of Mackey. On page 535 the Court says:

Before this Court will award a mandamus against an executive officer it must be made to appear in the proceedings, first, that the party applying has a clear legal right to the relief he claims, which he cannot obtain by any other proceeding; second, that there exists

a clear legal duty on the part of the official against whom the writ is asked, which he refuses to perform; and third, that the duty which is thus claimed and imposed is one ministerial in its character, and in no degree discretionary.

Taking that as the text, let us see whether this petition is not the proper remedy. The judicial functions of the Commissioner of Patents have been exhausted in this case. He has decided that Gill, one of the relators, is entitled to the patent. That was a decision by a former Commissioner of Patents. The rules of the Patent Office, your Honors, in the Knoecklin case, reported in 2d Mackey, p. 12, have decided to be, when not inconsistent with law, as binding as the statute.

Rule 139 of the Patent Office provides:

That cases which have been deliberately decided by one Commissioner will not be reconsidered by his successor, except in accordance with the principles which govern the granting of new trials.

No motion has been made and no proceeding had before him to reopen this judgment of the Commissioner. He was bound by that rule. Now, what does he say in his return:

That it is true, as stated in the petition, that the said George C. Gill did file an application for letters patent, and that the proceedings had and the several steps set forth in said petition were taken to secure the same; he further admits that it is true that the Commissioner of Patents did decide and adjudge that the said George C. Gill was entitled to receive a patent, as set forth by the relator herein, as appears by a copy of said decision hereto annexed, marked A; and that said decision has not been reversed or modified by the Commissioner of Patents.

* * * * * * * *

Your respondent further says that it is true as alleged by the relator * * * that, to wit, on the 4th day of March, 1884, the relator did demand of your respondent that he prepare a patent for issue to the said George C. Gill, in pursuance of the decision of the Commissioner of Patents, made as hereinbefore set forth, and that your respondent *did refuse to prepare said patent, or to take any steps in that behalf.*

Your respondent further says that it is true as alleged by the relator that, subsequently to said demand and refusal, * * * the said relator again demanded that your respondent prepare for issue a patent, in accordance with the judgment of the Commissioner, tendering at the same time the final fee due; *that your respondent refused to accept said fee, and also refused to prepare the said patent, or to do anything or to take any steps in that direction;* that

he so refused, not because he desired to make further inquiry or to be further advised in that behalf, no motion or other proceeding for rehearing or review had been taken or was pending before him in that behalf, but that he based his refusal, and does so still, solely upon the ground that the Honorable the Secretary of the Interior had entertained the appeal, taken to him from said decision, under the rules aforesaid, and had in pursuance of said appeal entered a decision reversing that of the Commissioner of Patents, and awarding priority of invention to Walter Scott.

Your respondent further says that for many years, and until 1881, it was held, in pursuance of decisions and opinions of the Honorable Attorney-General made in that behalf, that the Honorable the Secretary of the Interior had, and therefore has, no legal authority to review on appeal a decision of the Commissioner of Patents, wherein the Commissioner has finally adjudged an applicant to be entitled to a patent, as prayed for in his application; in other words, that the judgment of the Commissioner of Patents upon the right of an applicant to have and receive a patent, is final and conclusive, subject only to review by the Supreme Court of the District of Columbia and such other courts as have jurisdiction in that behalf, and by the Commissioner; and the practice of the Patent Office, and the Honorable the Secretary of the Interior, conformed thereto. This question, however, was again raised in the cases of Nicholson vs. Edison, and Le Roy vs. Hopkins, and the Honorable, the Attorney-General of the United States, to whom the question was again referred, in an opinion signed on the 20th day of August, 1881, held that the Secretary of the Interior had and could on appeal to him exercise the jurisdiction to review the decision of the Commissioner of Patents and control his action in that behalf.

In deference to that opinion, and the action of the Honorable, the Secretary of the Interior, in the case under consideration, your respondent refused, and does refuse, to accede to the demand of the relator. That, in view of the decisions and the uniform practice of the Commissioner of Patents, and the heads of the Department of the Interior, prior to 1881, doubt and uncertainty have arisen, touching the legal obligations devolving upon your respondent in the case under consideration, and those of like character.

Your respondent further says, that *if judgment of the Commissioner of Patents, which is, that the relator is entitled to receive his patent as prayed for*, is final, and if upon such judgment it is the lawful duty of the respondent to accept said final fee and take the necessary proper steps to prepare said patent for issue, then your respondent has improperly refused and does improperly refuse to prepare said patent for issue; but if his decision is subject to review and reversal on appeal to the Honorable, the Secretary of the Interior, then such refusal on the part of your respondent to accept said fee, and prepare said patent for issue, is right and proper.

Now it can hardly be said, in view of these statements, that the Commissioner of Patents has exercised

any judicial function in refusing to accept the fee and to prepare for issue this patent. All the functions that could be exercised of a judicial nature has been exhausted by his decision that Gill is entitled to the patent. The duty he has refused to perform is merely ministerial and is in no way discretionary, as was decided by the Secretary of the Interior in Sargent's case, to which I have referred. If our construction of the statutes is correct, there exists a clear legal duty for him to perform, ministerial and not judicial in character, which he refuses to perform.

A writ of mandamus is always a proper remedy against an executive officer to compel the performance of a ministerial duty, and the only question is whether there is any other adequate remedy existing. Using the language of High on "Extraordinary Remedies," p. 23, 2d Ed., regarding this question:

> It is to be borne in mind, however, in the application of the principle under discussion, that the existing legal remedy relied upon as a bar to interference by mandamus, must not only be an adequate remedy in the general sense of the term, but it must be specific and appropriate to the particular circumstances of the case. That is, it must be such a remedy as affords relief upon the very subject matter of the controversy, and if it is not adequate to afford the party aggrieved the particular right which the law accords him, mandamus will lie, notwithstanding the existence of such other remedy.

The remedy which is supposed to exist to bar this writ is that by section 4915 of the Revised Statutes, whice is as follows:

> SEC. 4915. Whenever a patent on application *is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner*, the applicant may have remedy by bill in equity; and the Court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the Commissioner, and all the expenses of the proceeding shall be paid by the applicant whether the final decision is in his favor or not.

There are two functions performed by the Commissioner of Patents; one is administrative and the other is judicial. The judicial function is performed as to the merits of the case; the administrative, both before the judicial function has been exhausted to enable it to be properly performed, and after it has been performed to carry it into effect, as in the present case, by receiving the fee and preparing the patent and presenting it to the Secretary of the Interior for his signature.

The section of the statute referred to only gives remedy by bill in equity in case the patent is refused either by the Commissioner of Patents or by this Court on appeal from him. This section, when read in connection with the other sections of the act, giving the Commissioner of Patents judicial powers, must be construed to mean where the patent is refused upon the merits on account of abandonment, public use, prior invention, patent or publication or interference. This Court could hardly take jurisdiction of a bill to review the administrative acts of the Commissioner of Patents, which power to review is by statute lodged in the Secretary of the Interior as to such acts. There must be a judicial decision adverse to the applicant before your Honors could review the action of the Commissioner either by bill in equity or by appeal, as provided in section 4911.

This latter section allows an appeal in case of an unfavorable *decision* of the Commissioner of Patents, and as section 4915 allows a bill in equity to be filed to review the decision of this Court on such an appeal, when section 4915 is construed in connection with section 4911 the word "refused," as it is used with reference to the decision of this Court in an appeal under the latter section, must be understood as meaning a refusal on account of a decision of the Commissioner of Patents, which must be on the merits.

There is but one authority which touches at all upon this question, and that is a decision rendered by this Court in *ex parte* Jenny, found in the manuscript decisions of this Court in the Library of the Commis-

sioner of Patents. In this case it appeared that Mr. Ellsworth, a former Commissioner of Patents had twice rejected an application for a patent on references.

Afterwards Mr. Burke became Commissioner of Patents, who, when asked to review this action of Mr. Ellsworth, refused to interfere with the action of his predecessor under the rule still in force as I have shown, or to make any further examination of the application. An appeal was taken from this refusal, on which the Court said:

> The Act of 1839 gives the right of appeal to the Judge only "in cases where an appeal was by the previous act allowed from the decision of the Commissioner to a Board of Examiners," and then only when a patent was refused.
>
> In the present case he has not refused a patent. He decides only that he will not examine the merits of the claim. * * *
>
> This refusal was not a ground for appeal to the examiners under the 7th section of the Act of 1836, and therefore is not a ground of appeal to the Judge.
>
> Whereupon, inasmuch as the decision of the Commissioner from which the appeal is taken neither affirms nor denies the right of the appellant to the patent (which he claims) on the merits of his supposed invention, it is not such a decision as is the subject of appeal under the Act of July 4, 1836, or the Act of March 3, 1839, in addition to that act, and therefore I have not jurisdiction of this appeal, which is therefore hereby dismissed.

Now, it seems to me that this rule is sound and applicable alike to a bill in equity to review such refusal of the Commissioner to act, as to an appeal to this Court from such refusal.

In the present case the Commissioner of Patents refuses to accept the final fee; he refuses to prepare the application for issue by sending it to the printer to have it made up into a record to go to the Secretary for his signature. He does not refuse to adjudge the patent to Gill, but, on the contrary, says:

> The Commissioner of Patents did decide and adjudge that the said George Gill was entitled to receive a patent. "If the judgment of the Commissioner of Patents, which is that the relator is entitled to receive his patent as prayed for * * *"

If we were to file a bill in equity under section 4915, we could only allege that he has refused to do these clearly administrative duties, and your decree, if you should make one, would simply authorize him to issue

the patent, but it could not compel him to do the ministerial acts of accepting the final fee, and sending the application to the printer to have it made up in a record, and to present it to the Secretary of the Interior for his signature. To compel him to do these acts we would have to come into this Court with a petition for a mandamus, such as we have here, and the bill in equity would simply be a futile proceeding, and therefore not adequate to afford the relief which the applicant demands. In fact, it would afford him no relief whatever, as the relators could not thereby get the patent they seek by this proceeding.

If our construction of the law is correct, that the Secretary of the Interior has not the jurisdiction which the Attorney-General has advised him he has, then a petition for mandamus would therefore seem to be the only proper remedy for these relators; because the relators undoubtedly have a clear legal right to the relief prayed for, which cannot be obtained by bill in equity; because there exists a legal duty on the part of the Commissioner of Patents to receive the final fee and to prepare the patent for issue, and to submit the same to the Secretary of the Interior for his signature; and that this duty is ministerial and in no degree discretionary.

And now I leave the case with your Honors, thanking you for your great patience, attention and courtesy during the protracted arguments that have gone over so much ground, and I trust that whether you decide to grant the writ or not, that we may have the light of your opinion upon this question, which would aid the members of the bar throughout the country who have anything to do with patents to determine how to advise their clients on this question.

SUPREME COURT OF THE DISTRICT OF COLUMBIA.

U. S. EX REL. R. HOE & CO. AND GEORGE C. GILL *v.* BENJAMIN BUTTERWORTH, COMMISSIONER OF PATENTS.

Mr. Justice JAMES delivered the opinion of the Court as follows:

This is a petition for a writ of peremptory mandamus to the Commissioner of Patents to receive the final fee and to cause letters patent to the relators, R. Hoe & Co., to be prepared and presented to the Secretary of the Interior for his signature. It sets forth that, on March 12, 1881, the relator Gill made application for letters patent for certain improvements in printing-machines; that on primary examination the Commissioner was of opinion that this application would interfere with an unexpired patent granted to Walter Scott on March 8, 1881; that such proceedings were had that an interference was duly declared, whereupon the Examiner of Interferences decided that Scott was the original and first inventor of said improvements; that upon appeal to the Examiners-in-Chief this decision was affirmed; that upon further appeal to the Commissioner the latter decided that the relator Gill was the original and first inventor, and entitled to a patent for said improvements, and that he finally decided, on June 4, 1883, that such patent should issue; that the relator Gill assigned to the other relators all his title to said invention, and requested the Commissioner to issue the letters patent therefor when granted

to them; that the final fee was tendered to the Commissioner, who refused to accept it, and also refused to cause letters patent to be prepared and presented to the Secretary of the Interior for signature; that the relators were informed by the Commissioner that the only ground of his refusal was the pendency before the Secretary of the Interior of an appeal taken by Scott; that the Commissioner has not denied, and does not deny, that a patent should issue to Gill, unless the Secretary has the right to suspend the issuing thereof by reason of the appeal pending before him, and that the Commissioner has still later informed them that the Secretary has, upon said appeal, reversed his decision and decided that Scott is the original and first inventor of said improvements, and is entitled to a patent therefor.

In the communication last referred to, which is addressed to the relator's counsel, and is made part of the petition, the Commissioner says:

> If the decision of the Commissioner adjudging priority to your client is final, and not subject to review and reversal by the honorable Secretary of the Interior, then your client is entitled, on payment of final fee, to have his patent prepared and issued. But if the honorable Secretary has under the law jurisdiction on appeal to hear and determine the cause, then your client is not so entitled. The decision of the Commissioner of Patents is that your client Gill is entitled to the patent prayed for. On appeal from that decision the honorable Secretary decided that your client is not so entitled. In view of the facts related, I refuse to issue a patent for your client, or to prepare a patent for issue, or to take any steps whatever in that direction. I do this, not because I want further time to consider the case, but because the honorable Secretary has, on hearing the cause, reversed the decision of the Commissioner of Patents, as hereinbefore stated.

In his return the Commissioner says that the statements of the relators as to the applications, appeals, and decision of the Commissioner are true, and that this decision has not been reversed or modified by the Commissioner; that on the 14th of June, 1883, an appeal to the Secretary of the Interior was taken by Scott, and prosecuted under rules prescribed by the

Secretary, and that on March 7, 1884, the Secretary made a decision reversing the decision of the Commissioner and adjudging that Scott was the first inventor and that Gill was not entitled to a patent; that pending that appeal—namely, on the 4th day of March, 1884—the relator did demand of respondent that he prepare a patent for issue to the relator Gill in pursuance of the decision of the Commissioner of Patents, and that respondent refused so to do, or to take any steps in that behalf; that after the decision of the Secretary had been pronounced, the relator again demanded that the respondent prepare for issue a patent in accordance with the judgment of the Commissioner, tendering at the same time the final fee due; that respondent refused to accept said fee, and again refused to prepare said patent; that he so refused, not because he desired to make further inquiry, or to be further advised in that behalf, but that he based his refusal, and does so still, solely upon the ground that the Secretary of the Interior had entertained the appeal taken to him from said decision, and had entered a decision reversing that of the Commissioner of Patents, and awarded priority of invention to Walter Scott.

The return further states that, on the 26th of February, 1884, the Secretary of the Interior advised respondent that, in pursuance of an opinion of the Attorney-General to the effect that he could, on appeal to him, exercise the jurisdiction to review the decision of the Commissioner of Patents, he had exercised that jurisdiction, and that respondent, in deference to that opinion and the action of the Secretary, refused, and does refuse, to accede to the demand of the relator. In conclusion he says:

> Your respondent further says that, if the judgment of the Commissioner of the Patents, *which is, that the relator is entitled to receive his patent, as prayed for*, is final, and if upon such judgment it is the lawful duty of the respondent to accept said final fee and take the necessary and proper steps to prepare said patent for issue, as prayed, then your respondent has improperly refused to prepare said patent for issue; but if his decision is subject to review and re-

versal on appeal to the honorable the Secretary of the Interior, then such refusal on the part of your respondent to accept said fee and prepare said patent for issue is right and proper.

Upon these facts we are asked to require the Commissioner of Patents to accept the final fee tendered by the relators, and to prepare and submit to the Secretary of the Interior, for his signature, letters patent to them for the improvement in printing machines described in the petition. The questions involved have been argued with very noticeable care and ability by counsel for the relators, and counsel appearing, as we understand, in fact, in the interest of Scott, but nominally, as *amicus curiæ*, inasmuch as Scott is not a party to this proceeding. It is claimed by the latter that the relators are not entitled to the remedy of mandamus first, because the Commissioner of Patents has no longer the legal power to do the act which would be commanded by the writ, that power having been superseded and taken away from him by a lawful appeal to the Secretary of the Interior, and a lawful and controlling decision by the latter that the relators are not entitled, and that Walter Scott, the adverse party to the interference, is entitled to a patent for the improvements in question, and, secondly, because, even if it should be held that the appeal to the Secretary of the Interior and his decision in the premises were unauthorized, and therefore, in contemplation of law, a nullity, the writ would do something more than command a merely ministerial act, and would, in fact, control what would still be a matter of executive discretion with the Commissioner himself; and, third, because the patent laws have provided for the relator a different and adequate remedy. Reversing the order of these propositions, we shall first consider whether, assuming that the Commissioner's decision upon a question of interference is final and conclusive as to the matters submitted to him so far as executive action is concerned, and is not subject to review by the Secretary

of the Interior, the writ of mandamus is inapplicable under the circumstances of this case.

We find that the Commissioner has in his return defined the status of the proceedings reached in his own action. He

> admits that it is true that the Commissioner of Patents did decide and adjudge that the said George C. Gill was entitled to receive a patent, as set forth by the relator herein, * * * and that said decision has not been reversed or modified by the Commissioner of Patents.

He then states that when he refused the relator's demand for the issuance of a patent, it was "not because he desired to make further inquiry or to be further advised in that behalf;" and in the conclusion of his return he says:

> If the judgment of the Commissioner of Patents, *which is, that the relator is entitled to receive his patent, as prayed for*, is final, and if upon such judgment it is the lawful duty of the respondent to accept said final fee and take the necessary and proper steps to prepare said patent for issue, as prayed, then your respondent has improperly refused to prepare said patent for issue.

Now, we do not doubt that it is within the executive discretion of the Commissioner, even after making and communicating to an applicant a decision in his favor, and at any time before the issue of a patent for the signature of the Secretary, to reconsider that decision and to make a contrary one. In the ordinary course of business the whole matter rests in executive discretion, at least down to that point, and if nothing more appears the Court will not interfere by the writ of mandamus to compel the issue of a patent as the next and consequent step. The Commissioner could answer a demand of the applicant by the simple statement that he had changed his mind, and had decided that the applicant was not entitled to a patent; and so long as he must be supposed to occupy that position he cannot be treated as if he had ceased to do so. It cannot yet be said that his only remaining duty is ministerial; but the respondent does not in any true and practical sense occupy that position. He has said, substantially, that

the original decision of the Commissioner of Patents, to the effect that the relator was entitled to a patent as prayed for, has not been changed, that he does not even intend to re-examine it, and that it *is now his decision;* and it is important to observe that this was not merely a position taken in his official communications with the relators. It is the position on which he stands in this Court. Now, a position thus assumed in a judicial proceeding may, for the purposes of that proceeding, be treated by the Court as the conclusive legal attitude of the party. The executive decision which he thus presents to us and stands upon must be regarded here as a final fact, which is to determine legal consequences in the case. What, then, is the legal consequence of a fixed decision, or what we must treat as a fixed decison, that an applicant is entitled to a patent? No question could be raised if that decision were final, because the law had declared it to be final as soon as it was made. The legal consequence of that fixed decision would be the ministerial duty to issue the patent. We perceive no principle which should distinguish the Commisioner's duty in the case before us from his duty in the case supposed. On principle, the same duty must accrue whenever his decision to issue a patent must be treated by the Court as a fixed and permanent one. Although the law contemplates that the Commissioner may reverse such a decision, and *thereby* defeat the issuance of a patent, it clearly does not contemplate that he may adhere to and stand upon it in this Court, and yet defeat the issuance of a patent by simply refusing to act in pursuance of that decision. The progress of executive duty may lawfully be reversed by a new and lawful executive action in a contrary direction; but it would be unreasonable that the law should be arrested at a half-finished stage simply by non-completion, and that there should be no remedy to compel its movement. It would be playing with words, substituting phrases for substance, to say that the writ of mandamus must not be affixed in command-

ing the final step to be taken, on the ground that down to the actual issue of the patent the whole matter must still be regarded by us as resting in executive discretion, whether a patent shall issue or not. When an officer stands in Court, by his return upon the ground that he had exhausted the uses of his executive discretion, and refuses to take the ministerial step which follows next where executive discretion has ended, he presents to the Court the very evil which the writ of mandamus is designed to remove—a refusal, namely, to perform a ministerial duty.

But it was suggested, further, that the determination of the Commissioner not to disregard the action of the Secretary was an exercise of executive discretion, and that, whether he was right or wrong in that determination, his executive action in that matter is not to be controlled by mandamus. It must be remembered that we are now considering the applicability of this remedy on the hypothesis that the Commissioner's control of the question before him was final, and that the Secretary was without power in the premises. On that hypothesis the Commissioner's forbearance or refusal to proceed according to this own judgment must be regarded in law as simply an act of deference. It was not a decision as to his own legal duty. However discreet such conduct toward the head of the Department may have been, it did not constitute an exercise of that kind of discretion with which a court must not interfere by mandamus.

It was also suggested that as the statute provides that "The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law," the Commissioner must be held to have construed this provision and to have acted upon that construction in refusing to proceed in pursuance of his own decision after the Secretary had undertaken to review and reverse it.

This, it is claimed, was an exercise of executive power and discretion which the court must not control by mandamus. But it is apparent on the whole face of his return that the Commissioner, in refusing to follow up his own decision, did not, as a matter of fact, act upon any executive construction of his own as to that provision. It is to be gathered from his answer that the question whether that section gave revisory power to the Secretary was the one which he had not undertaken to settle. Instead of informing us, either expressly or inferentially, that his decision upon that question was the rule of his action in refusing to proceed in pursuance of his own original decision, he distinctly submits it as an unsettled question. Deference to the will of the Secretary, so far from being a decision upon this question, constituted an abandonment of any effort to decide it. Plainly he did not attempt to decide executively upon the effect of the provisions referred to. But the important point to be observed is that it is wholly immaterial whether he acted upon a construction of that law. If his decision upon the original question before him was not subject to revision by the Secretary, and if he himself had so acted that only a ministerial duty remained to be performed by him, that ministerial duty would not cease to exist merely by reason of his deciding incorrectly that the whole of his power had been taken away. To interpose that decision would be merely to give a bad reason for refusing to perform his ministerial duty; and to describe it as an exercise of executive discretion, and thus to exclude the remedy of mandamus on the principle that it is never used to control executive discretion, would be to defeat the remedy by a mere misnomer. He had no executive discretion to deny his duty, either directly or by circuity.

It was next objected that this remedy was not applicable, because a different and adequate remedy has been provided for the relators. This objection re-

fers to section 4915 of the Revised Statutes, which provides that—

> Whenever a patent is refused, either by the *Commissioner of Patents*, or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by a bill in equity, and the Court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled according to law to receive a patent for his invention as specified in his claim. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

This objection that the relators have another remedy in this case comes rather inconveniently from the party who makes it. His principal position is that the decision of the Commissioner has been lawfully reversed by the Secretary. If that be true, it is the Secretary, not the Commissioner, who has refused them a patent, and this section does not provide them a remedy by a bill in equity on such refusal. We must consider the objection, however, on the hypothesis that the Secretary's action is a nullity. This section applies to interference cases as well as to applications *ex parte*. When there are adverse parties, notice must be given to them. They are let in as formal parties to the contest, and the contest is upon proofs and the merits of the adverse claims. The case is heard *de novo*. Can it be seriously claimed that the right to try his case in this manner, under the burden of paying all the expenses of the proceeding, is an adequate remedy to a party who *is already entitled* to his patent by the favorable decision of the Commissioner? We conceive that this is one of the cases in which a question is its own answer. Although it may be said that the object, both of the petition for the writ of mandamus and of the bill in equity, is to obtain a patent, the subject of inquiry and the

basis of relief in the two proceedings are wholly different. In the proceeding for mandamus, the inquiry is, whether the right of the petitioner to a patent has already been decided, and in such a way that he is entitled to the fruit of that decision by performance of a merely ministerial duty. In the equity proceeding, the inquiry is, whether he proves originally a right to have a patent. Clearly the right to have the latter inquiry and adjudication is not an adequate remedy to one who already has a sufficient determination of the same question and only asks for execution.

It was insisted at the argument that the objections which we have examined, or any one of them, would forbid the granting of a writ of peremptory mandamus in this case, even if the Court should be of the opinion that the Secretary of the Interior does not possess revisory or appellate control over such decisions of the Commissioner of Patents, and that they should preclude an inquiry into the extent of the Secretary's powers. We have, therefore, considered them attentively, and we hold that if the power of the Commissioners of Patents to adjudicate the question presented to him in the premises was final, so far as executive action was concerned, and was not superseded by a lawful appeal to the Secretary, there is nothing in these objections which precludes the application of the writ of madamus. We proceed, therefore, to consider the question whether the power of the Commissioner to comply with the command prayed for has been taken away from him by a lawful appeal to the Secretary and a lawful decision by the latter reversing the decision of the Commissioner.

The claim of revisory power in the Secretary of the Interior was based, in the argument, upon the following provisions of the Revised Statutes:

SEC. 441. The Secretary of the Interior is charged with the supervision of public business relating to the following subjects: First, the census, when directed by law; second, the public lands, including mines; third, the Indians; fourth, pensions and bounty-lands; fifth, patents for inventions; sixth, the custody and distribu-

tion of publications; seventh, education; eighth, Government Hospital for the Insane; ninth, Columbia Asylum for the Deaf and Dumb.

SEC. 481. The Commissioner of Patents, *under the direction of the Secretary of the Interior*, shall superintend or perform all duties respecting the granting and issuing the patents directed by law.

SEC. 483. The Commissioner of Patents, *subject to the approval of the Secretary of the Interior*, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

SEC. 487. For gross misconduct, the Commissioner of Patents may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be *subject to the approval of the Secretary of the Interior*.

SEC. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be *signed by the Secretary of the Interior* and countersigned by the Commissioner of Patents.

Especial emphasis, of course, was laid upon Section 481, which provides that the Commissioner shall perform his duties under the direction of the Secretary. It is claimed, broadly, that "the power of supervision and direction gives jurisdiction to the Secretary, upon application made to him in any form that he may prescribe, by appeal or otherwise, to affirm, reverse, or modify the action of the Commissioner."

The provisions referred to, and all the provisions of the Revised Statutes which we shall have occasion to consider, were taken from the Act of July 8, 1870, which was entitled "An Act to revise, consolidate, and amend the statutes relating to patents and copyrights." In that work of consolidation Section 481 was taken without any change, except the rejection of redundant words, from the first section of the act of July 4, 1836, by which the office of Commissioner of Patents was first established. It is of some importance, therefore, to examine the extent of the supervisory powers of the Secretary of State as given by this same provision in the original act.

Section 7 of that act provided that the Commissioner

should "make or cause to be made" an examination of every application for a patent, and that if, after certain proceedings had, he should decide that the applicant was not entitled to a patent, an appeal might be taken to a board of examiners, "to be composed of three disinterested persons," appointed for that purpose by the Secretary of State, one of them, at least, to be "selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science" to which the alleged invention appertained. This board might "reverse the decision of the Commissioner in whole or in part," and when their opinion was certified to him he was to be governed by it in the further proceedings to be had. Section 8 related to interference cases, and provided a like appeal, with like effect, from the Commissioner's decision.

The act of 1836 provided, then, that the Commissioner should perform his duties "respecting the granting and issuing of patents" "under the direction of the Secretary of State;" and it also provided that he should make a decision on the question whether an applicant was entitled to a patent; but it provided, further, that these decisions should be revised and controlled by a board of examiners. This revision was part of the regular course of executive administration, and the statute gave the Secretary no control over the board of examiners. It is obvious, then, that the Secretary's control over the Commissioner could not be exercised in the form of revisory power over his decisions. Now, it is nothing to the purpose to suggest here that a revisory tribunal no longer intervenes between the Commissioner and the Secretary's control, and that the decisions of the former are thus brought within the operation of the Secretary's direction. The point to be observed is that the directory power of the Secretary of State and of the Secretary of the Interior was expressed in the same terms, and that that grant of power, as found in the Act of 1836, did not pretend

to give apellate and advisory power over the decisions which the Commissioner was authorized to make. Let us see whether anything in the act of 1870, which is found in the Revised Statutes, requires us to adopt a different rule in construing the same language.

It is important to observe just here that, although Section 481 of the Revised Statutes, which gives the Secretary of the Interior directory power over the duties of the Commissioner of Patents, is found in the Title XI., relating to the organization of the Interior Department, and the sections which we shall consider are found in Title LX., relating to the subject of patents and copyrights. All of them were taken from the Act of July 3, 1870. In that act they formed parts of one system, and were to be construed together as such. It is a settled rule of construction of the Revised Statutes that its contents are to be construed in the light of the original statutes from which they were taken. This section relating to directory power is therefore to be regarded as part of the general system, of which the sections now to be considered are also a part.

The following sections provide a system of appeals by which all applications, whether in interference cases or *ex parte*, may be brought before the Commissioner for his decision:

SEC. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with an unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention; and the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the Board of Examiners-in-Chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

SEC. 4909. Every applicant for a patent, or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference may appeal from the decision of the primary examiner, or of the Examiner in Charge of Interferences in such case, to the Board of Examiners-in-Chief, having once paid the fee for such appeal.

"SEC. 4910. If such party is dissatisfied with the decision of the Examiners-in-Chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person.

These sections, as we have said, provide a regular system of appeals, both in interference and *ex parte* cases, which brings every application to the Commissioner for decision. The statute commands him to decide, and, of course, it intends that he shall apply the usual processes of decision—in other words, the *judgment* of the person deciding. Can it be possible that the Legislature intended, by giving the Secretary directory power, that he might intervene at this point of time and direct the Commissioner what decision he, the Commissioner, was to make? It must be kept in mind that the whole of the Secretary's power must be found within that one word "direction." It hardly seems worth while to reason upon the question whether a general power to direct authorizes the directing officer to dictate to one who is charged by the very same law with the duty and power of hearing the parties to a contest and of deciding between them accordingly what conclusion his mind must reach. Clearly, he cannot, in the exercise of this power, dictate to the Commissioner touching his decision before he makes it or while he is making it. Can it be imagined, then, that the power of "direction," which cannot lawfully be applied to the Commissioner's action while he is deciding, was intended to be applied to the same matter after he had decided? Is it permissible to say that a power of direction which cannot be exercised *as* direction, may be exercised by way of appeal and reversal, and all the time be called "directing"?

We are informed by the pleadings and exhibits that the Secretary of the Interior has acted upon the opinion of a former Attorney-General to the effect that the general provision of directory power controls the meaning of every section which assigns a duty to the Commissioner just as if it had been inserted in each; and that the duty and power of hearing and deciding con-

tested questions of priority of invention, for example, are to be construed as if the statute said they were to be performed under the direction of the Secretary. We hold that precisely the opposite rule of construction must be applied to the statute in order to ascertain correctly the intention of the Legislature. It must be remembered that this provision is general, and that the provisions relating to the duties and powers of the Commissioner are specific. It is the latter which must control. When they are considered together, it must be held that the Commissioner must perform his duties under the direction of the Secretary, except when he is already directed what he must do by the superior directory power of the Legislature. Applying this rule of construction to the Commissioner's decisions in cases of interference, we hold that they are not subject to the directory power of the Secretary either by contemporaneous dictation, or by the circumlocution of appeal and reversal described as direction. We are brought to this conclusion independently of the provisions of the patent laws, which remain to be considered, but we are still further confirmed by these provisions.

Section 4910, as we have seen, provides for an appeal to "the Commissioner in person." Section 4911 then provides that—

> If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting *in banc*.

By section 4913 the Commissioner is required to furnish the Court with "the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal."

Section 4914 confines the revision here to the points set forth in the reasons of appeal, and provides that, after hearing the case, this Court shall return to the Commissioner a certificate of its proceedings and decisions, which shall be entered of record in the Patent Office, "and shall govern the further proceedings in the case."

These sections authorize a revision of the grounds on which the Commissioner refuses a patent on application *ex parte*, and they do not authorize a revision of the grounds on which the Secretary may act. Manifestly, it was the intention of Congress to provide a judicial revision which should be available in every case in which an application *ex parte* is refused—in other words, that refusal should not be made by an officer whose grounds of decision are not subjected to revision by this section.

Section 4915 provides a still further remedy in case of the refusal of a patent for application *ex parte*, and applies the remedy to refusal of an application in interference. It directs that—

> Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity, and the Court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear; and such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the Commissioner, and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not.

This section, and the provisions for appeal to this Court which we have just consideration, provide either a formal appeal or an original proceeding substantially appellate in its character, which seems manifestly intended to cover all cases in which a patent is "refused," whether they be cases of application *ex parte* or in interference. It is to be observed that in both cases a refusal *by the Commissioner* is the basis of the remedy, and that it seems to be thus implied that, so far as the executive department is concerned, the examination of a claim for a patent and the power to decide upon such claim terminate with him.

But another class of decisions was still to be provided for. The provisions which we have considered relate only to cases in which patents were refused, but it might happen that a patent was improperly granted. A remedy for such cases is found in section 4918, which provides that—

> Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee and all parties interested under him, by suit in equity against the owners of the interfering patent; and the Court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

In this review of the patent laws certain facts are prominent. The same statute which provides that the Commissioner of Patents shall "perform all duties respecting the granting and issuing of patents" under the "direction of the Secretary of the Interior" provides expressly and in detail for a regular course of examination; it provides expressly for a regular course of appeals from the primary examiners to the examiners-in-chief, from the examiners-in-chief "to the Commissioner in person," and for a decision by him upon the right of an applicant to receive a patent; it does not provide expressly for an appeal from the Commismissioner's decision to the Secretary of the Interior; but it does provide expressly for an appeal and revision of those decisions by this Court, or for an original judicial proceeding by which relief against those decisions may be had. These provisions of appeal and relief constitute a system, and when the legislature provides such a system we must suppose that it was intended to be complete and sufficient. As no place in that system was assigned to the Secretary of the Interior it cannot have been intended that he should have